Supreme Court, U.S.
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No. 94-

In The

Supreme Court of the United States

October Term, 1994

CHRYSLER CORPORATION,
Petitioner,

v.

ROBERT W. KEARNS,
Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

(1) Does the trial court in a patent infringement case have "discretion" to exclude evidence of prior art, offered by the defendant to construe the scope of the claims at issue, contrary to this Court's express holding in *Westinghouse Co. v. Formica Co.*, 266 U.S. 342 (1924), that even where the alleged infringer is precluded from challenging a patent's validity, such prior art evidence must be used to construe and narrow the claims of the patent so as not to invade the public domain?

(2) Does a trial court in a patent infringement case have any "discretion" to preclude the defendant from showing that the accused device is identical to the prior art in every respect relevant to the application of the patent claims allegedly infringed?

(3) Does Article 1, § 8, of the United States Constitution preclude the trial court in a patent case from permitting the jury to find infringement by construing a patent claim so broadly as to cover what is in the public domain?[1]

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[1] The parties below include the parties named in the title of this petition, and American Motors Corporation, a defendant in the trial court. Petitioner Chrysler Corporation has no parent companies, subsidiaries (except wholly-owned subsidiaries), or affiliates that have issued shares to the public.

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On Petition for a Writ of Certiorari
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PETITION FOR A WRIT OF CERTIORARI

Petitioner Chrysler Corporation respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit, entered on August 11, 1994.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at 32 F.3d 1541 (1994) and is reprinted in Appendix A hereto. That court's September 28, 1994 order denying rehearing is reprinted in Appendix B hereto. The opinion of the district court denying petitioner's motion for judgment as a matter of law or, in the alternative, for new trial is reprinted in Appendix C hereto.

JURISDICTION

The opinion and judgment of the United States Court of Appeals for the Federal Circuit was entered on August 11, 1994. The Court of Appeals issued an order denying the petition for rehearing and declining the suggestion for rehearing *en banc* on September 28, 1994. This petition is timely filed within 90 days of that date. 28 U.S.C. § 2101(c); Sup. Ct. Rules 13.1, 13.4. This Court has jurisdiction to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit by writ of certiorari pursuant to 28 U.S.C. § 1254.

CONSTITUTIONAL PROVISION INVOLVED

United States Constitution, Article I, § 8, provides, in relevant part:

> "The Congress shall have power . . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

STATEMENT OF THE CASE

A. Procedural history.

In 1982, respondent Robert W. Kearns ("Kearns") filed suit against petitioner Chrysler Corporation ("Chrysler") in the United States District Court for the Eastern District of Michigan, alleging that Chrysler infringed four of his patents relating to electronic intermittent windshield wipers.[2]

From October 1982 until January 1991, the case was stayed pursuant to stipulation and order, pending resolution

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[2] Respondent's complaint alleged that petitioner infringed Patents Nos. 3,351,836 (the '836 patent), 3,564,374 (the '374 patent), 3,581,178 (the '178 patent), and 3,602,790 (the '790 patent).

of a similar suit by Kearns against Ford Motor Company involving the same patents. The *Ford* case was settled in November 1990. In January 1991, the trial court returned the *Chrysler* case to the active calendar and set it for trial.

The trial court ordered the jury trial bifurcated, and the liability phase began in October 1991. Based on the trial court's construction of the pretrial stipulations that had stayed the action since 1982, the trial court barred Chrysler from showing that the Kearns patents were invalid. Based on this same construction of the pretrial stipulations, the trial court also precluded Chrysler from introducing "prior art" evidence — *i.e.*, evidence of other intermittent windshield wiper systems and components that predated Kearns' patents — even for the purpose of construing the claims at issue so as not to cover subject matter wholly in the public domain. Chrysler was thus precluded from showing that its accused windshield wiper system was identical to the prior art in every detail relevant to Kearns' claim of infringement.

The jury found that Chrysler had infringed all four patents at issue. Subsequently, the trial court set aside the verdict of infringement with respect to the '178 patent and entered a judgment of non-infringement of that patent.

The damage phase of the case commenced before the same jury with respect to the three remaining patents. The jury found that Chrysler's infringement was not willful, and the jury assessed damages of $.90 per intermittent windshield wiper unit sold by Chrysler during the period of infringement. The trial court entered judgment in the amount of $18,740,465.43.[3]

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[3] The amended judgment of July 31, 1992 established 12,563,107 as the number of cars subject to the royalty, and $11,306,696.30 as the amount of the damage award. [A. 91]. ("A. " denotes a reference to the three-volume Appendix filed by Chrysler in the appeal to the Federal Circuit.) On October 26, 1992, the trial court also awarded

Chrysler filed a motion for judgment as a matter of law or, in the alternative, for a new trial on issues of infringement and damages. The trial court denied Chrysler's motion in an opinion and order dated June 3, 1993. Appx. C.

Chrysler filed a timely notice of appeal in the United States Court of Appeals for the Federal Circuit, which had jurisdiction of this matter pursuant to 28 U.S.C. § 1295(a)(1). In an opinion dated August 11, 1994, the Court of Appeals affirmed the trial court's judgment. Appx. A.

B. Pertinent facts.

The three patents involved in this suit relate to intermittent windshield wiper systems for use in automobiles. The term "intermittent" refers to the feature whereby the wiper blades stop or "dwell" for some predetermined time period when they reach the end of each wiping cycle. Typically, intermittent operation is selected by the driver in conditions of misty weather, as opposed to steady rain that requires continuous operation of the wipers.

A windshield wiper system achieves intermittent operation by using one of several mechanical or electronic time-delay mechanisms to interrupt electrical power to the wiper motor when the blades reach the end of the wipe cycle, i.e., the "dwell position." Then, after passage of a requisite (and usually adjustable) time period, power is restored to the motor and the wipers thus complete another cycle.[4]

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prejudgment interest and made other adjustments, bringing the total amount of the judgment to the above amount. [A. 94].

[4] Kearns' '836 patent disclosed an electronic intermittent windshield wiper system designed to achieve automatic switchover from intermittent operation to continuous operation and back to intermittent operation, depending on the wetness of the windshield. [A. 176-187]. The '374 patent was a division of the same application as the '836 patent, but focused on the specific electronic time-delay feature. [A. 188-201]. The '790 patent retained the moisture-sensing aspects of the '836 and '374

Kearns was not a pioneer in intermittent windshield wiper technology. Several intermittent windshield wiper systems were patented and manufactured before Kearns applied for the patents at issue here.[5] The first intermittent windshield wiper systems were mechanical. During the 1950's, Trico Corporation patented a time-delay mechanism that used the automobile's vacuum system to operate a diaphragm and thereby open switch contacts each time the wiper blades reached the dwell position. [A. 251-267]. The Trico system permitted the driver to control the duration of the dwell interval by using an adjustable bleed valve to regulate the rate at which the original air pressure was restored. In 1960, General Motors filed a patent application for an intermittent system in which the time delay was controlled by a bimetallic strip that was heated electrically during the dwell interval and distorted by the heat to close switch contacts and start the motor. [A. 268-272].

During the early 1960's, a number of companies developed and patented intermittent windshield wiper systems in which the dwell interval was controlled electronically using simple and well-known transistorized time-delay circuits, much like those in the systems described in the patents at issue in this case. Motorola, Lucas Industries, Bosch, Trico and General Motors all obtained prior art patents using resistor-capacitor-transistor combinations that predated Kearns' patents in this case.

Also in the 1960's, two-speed operation of windshield wipers became common, in part because of government regulation. The Mellor patent to Lucas Industries, applied for in 1965, shows a two-speed system with both high-speed and low-speed continuous operation and low-speed parking.

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patents, but added the feature of two speeds for the wiper motor. [A. 202-213].

[5] The filing date for the '836 and '374 patents was December 1, 1964. The filing date for the '790 patent was October 18, 1967.

[A. 309-310]. The Gute patent to General Motors, applied for in 1960, disclosed a two-speed intermittent system, with high- and low-speed continuous operation and low-speed intermittent operation. [A. 268-272]. The Moller patent to Bosch, applied for in early 1964, used an electronic intermittent timing circuit in a two-speed system. [A. 288-294]. A Japanese utility patent, published in 1965, also showed an electronic intermittent controller used with a two-speed motor. [A. 311-316]. The first U.S. automobile with a factory-installed intermittent system was Ford's 1967 Mercury which used a two-speed wiper motor and Trico's vacuum operated module to control timing.

Much of this prior art, the vast majority of which was excluded from evidence during the liability phase of the trial, revealed the very features that characterized the accused Chrysler system. The '790 patent is exemplary. Claim 14 of that patent, which was found to be infringed, covers the manner of switching an intermittent windshield wiper system between high-speed continuous, low-speed continuous and intermittent operation. [A. 411]. One prior art reference excluded by the trial court was a Japanese utility patent [A. 311-316] showing a switching configuration that was, for all intents and purposes, identical to the switching used by Chrysler. Chrysler's offer-of-proof [A. 354-355] demonstrates that it would be impossible to draft a patent claim covering the switching arrangements for the Chrysler system without also covering the excluded prior art. Both the trial court and the Federal Circuit regarded this as irrelevant.

Because of the trial court's order precluding the admissibility of prior art, however, the jury was permitted to give a broad construction to the claims that assumed the absence of such prior art. The verdict thus invaded the public domain by subjecting Chrysler to damages for using what was plainly available in the prior art. There was no real

dispute about this point. Neither the trial court nor the Federal Circuit expressed any doubt that Chrysler's accused system was identical to the prior art for all purposes relevant to the application of the claims. The trial court simply ruled that Chrysler could not introduce any of this prior art to construe the scope of the patent claims, because this would be a "back door" attack on validity. *See* Appx. A, p. 11. The Court of Appeals affirmed, stating, "[that] we might have reached a different result or might have affirmed had the district court gone the other way are insufficient bases for reversal under the abuse of discretion standard which applies to our review of this part of the court's judgment." Appx. A, p. 11.

REASONS FOR GRANTING REVIEW

I. THE RULING BELOW — THAT A TRIAL COURT IN A PATENT INFRINGEMENT SUIT HAS "DISCRETION" TO EXCLUDE EVIDENCE OF PRIOR ART TO CONSTRUE THE PATENTS AT ISSUE WHERE THE DEFENDANT IS PRECLUDED FROM CHALLENGING THE PATENT'S VALIDITY — IS CONTRARY TO THIS COURT'S DECISION IN *WESTINGHOUSE v. FORMICA CO.*, 266 U.S. 342 (1924).

This case presents a fundamental question of patent law arising from this Court's decision in *Westinghouse Co. v. Formica Co.*, 266 U.S. 342 (1924) — does a trial court have "discretion" to exclude evidence of prior art offered by the defendant to construe the patent at issue, where the defendant is otherwise precluded from challenging the patent's validity?

Under section 102 of the Patent Act of 1952, a patent may not issue if the claimed invention is found in any of several categories of prior art. The two categories of greatest importance to this case are found in section 102(b) and

102(e). Section 102(b) provides that a patent may not issue if the invention is described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year before the application is filed. Section 102(e) precludes the issuance of a patent on an invention described in the specification of some other U.S. patent applied for prior to the application for the patent in question.

In *Westinghouse,* this Court addressed the proper role of such prior art where the defendant is precluded from challenging the patent's validity. In particular, *Westinghouse* addressed the situation where the assignor of a patent, in defense of a suit by the assignee for infringement, is precluded by estoppel from challenging the patent's validity.[6] 266 U.S. at 349. *Westinghouse* holds that:

> "[T]he state of the art can not be used to destroy the patent and defeat the grant, because the assignor is estopped to do this. *But the state of the art may be used to construe and narrow the claims of the patent, conceding their validity.*"

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[6] This situation arose in *Westinghouse* because the inventor, who had once worked for the patent owner and had assigned the patent to it, was associated with the alleged infringer at the time of trial. This Court held that where an assignee sues an assignor for patent infringement, the assignor is estopped from challenging the validity of what was assigned. 266 U.S. at 349-350. *Westinghouse* is indistinguishable from the case at bar, because the basis for ruling that an infringer is precluded from challenging validity is immaterial to the Court's holding on the use of prior art for claim construction.

266 U.S. at 351 (emphasis added).[7] This Court rejected several lower court decisions to the contrary, explaining:

> "Can the state of the art be shown in a suit by the assignee of a patent against the assignor for infringement to narrow or qualify the construction of the claims and relieve the assignor from the charge? . . . [T]he better rule, in view of the peculiar character of patent property, is that the state of the art may be considered. Otherwise the most satisfactory means of measuring the extent of the grant the Government intended and which the as-

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[7] In assessing the validity of a patent claim, the trier of fact compares the claim at issue with prior art to see if there is anything new in the patent holder's claim. The narrower the claim — i.e., the more limited the scope of the "invention" protected by the patent — the more likely that it will be found valid. Thus, the patent holder typically argues for a narrow construction of the claim for purposes of avoiding a validity challenge. If the trier of fact concludes the claim can be construed in such a way that it contains some point of novelty not taught in the prior art, then the claim is valid and the trier of fact goes on to see whether the defendant's accused device infringes the patent claim.

The broader the patent claim, the more likely that a defendant will be found to have infringed it. A patent holder is precluded, however, from arguing for a narrow construction of the claim at issue to avoid a validity challenge, and then arguing for a broad construction of the same claim for purposes of infringement. *See, e.g., Medtronic Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1583 (Fed. Cir. 1983) ("Because both validity and infringement involve construction of a claim, and because the construction *must be the same* in determining both, it is desirable to decide both questions at the same time") (emphasis added); *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989) ("claims must be given the *same* construction when considering infringement as when considering validity").

Thus, in comparing the patent claim to the defendant's device in the infringement analysis, it is essential that the trier of fact use a construction of the claim that would survive a validity assessment. A defendant can infringe only what the patent holder can legitimately claim to have invented; a patent holder can legitimately claim to have invented only that which has not already been invented or disclosed by someone else and thereby entered the public domain.

> signor assigned would be denied to the court in reaching a just conclusion."

266 U.S. at 350-351.

The decisions of the trial court and the Federal Circuit are contrary to this controlling authority. Just as in *Westinghouse*, Chrysler sought to use the prior art to establish the proper construction of the disputed language of the patent claims at issue. Under *Westinghouse*, this was proper even though the trial court had ruled that Chrysler was estopped from challenging the validity of the patents. Relying on *Westinghouse*, Chrysler attempted to show that its accused windshield wiper system was identical, for all purposes germane to the issue of infringement, to the prior art described above. *See supra*, pp. 4-6. The trial court peremptorily excluded this evidence, ruling that "what [the prior art] shows is irrelevant" [A. 653-656] and that such use of prior art would be a "disguised attack on the validity" of the patent. *See* Appx. C, p. 15.

Affirming the trial court, the Federal Circuit adopted the same reasoning, i.e., that Chrysler's attempt to rely upon prior art to properly construe Kearns' claims was an attack on the validity of the patent and was "expressly proscribed by the binding stipulation" entered by Chrysler before trial. Appx. A, p. 11.[8] But this is precisely the reasoning that

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[8] The Federal Circuit did note in passing that "the claims could be construed according to their plain meaning and that reference to prior art was not required" (Appx. A, p. 11). However, this permitted Kearns' experts to construe the claims in a vacuum, so as to encompass Chrysler's products. The Federal Circuit went on to find it "highly significant" that the trial court believed Chrysler was attempting to make a "back door" attack on the validity of the patents by offering prior art evidence to construe the patents. Appx. A, p. 11. Thus, the question presented by this petition was critical to the Federal Circuit's affirmance.

In any event, the suggestion that disputed claim language can be determined without any reference at all to extrinsic evidence is contrary

Westinghouse rejected. *Westinghouse* established that use of prior art to "narrow and construe" the patent is *not* an impermissible "back door" attack on the patent's validity. Rather, the prior art *must* be considered in order to reach a "just conclusion" by permitting a proper construction of the claims, and thereby "measuring the extent of the grant the Government intended." 266 U.S. at 350, 354.

The Federal Circuit erroneously ruled that the trial court had "discretion" to exclude the prior art evidence offered by Chrysler to construe the patents, and that the trial court's ruling was subject to an abuse of discretion standard. Appx. A, p. 11. In so ruling, the Federal Circuit misconstrued language in *Westinghouse* that prior art evidence "may be used to construe and narrow the claims of the patent" to mean that a trial court was free to exclude such evidence. Such a misreading of *Westinghouse* overlooks the fact that this Court expressly rejected several lower court opinions which "seem[ed] to exclude any consideration of evidence of this kind for such a purpose." 266 U.S. at 350. Furthermore, such a misreading of *Westinghouse* is contrary to this Court's conclusion that "[i]n view of the art," the claims at issue *"must be read"* as including by implication a two-step process of pressure and heat, followed by cooling and baking, that was not expressly set forth in the claims. 266 U.S. at 354 (emphasis added). This Court stated, "[w]ithout this, there was nothing new in them in the field to which they applied." 266 U.S. at 354. As so construed narrowly to avoid the prior art, this Court held the claims were not

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to prior opinions of the Federal Circuit. *E.g., SRI International v. Matsushita Electric Corp.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (even where the language on its face appears clear, definite and unambiguous, "claim interpretation and resort to extrinsic evidence [is] required" where the defendant asserts that "the claim language, as interpreted in light of the specification, prosecution history, and prior art, does not actually read on his device").

infringed. It is simply not possible to reconcile the Federal Circuit's decision with this Court's ruling in *Westinghouse*.

The Federal Circuit's reasoning underscores the need for review by this Court to clarify that a trial court has no "discretion" to exclude prior art evidence offered to construe the patent. Unlike non-patent cases, there is no possibility that other circuits will address the issue and reach a different decision, because the Federal Circuit has exclusive jurisdiction of appeals in patent cases. 28 U.S.C. § 1295. Unless reviewed by this Court, the Federal Circuit's decision will stand and erroneously signal to trial courts that they have discretion to preclude prior art evidence offered to construe patents. The Federal Circuit's ruling makes it possible for a patent holder to preclude others from using technology on which the patent holder has no legitimate monopoly. This threatens the core principles on which the patent system is founded. Far from advancing "science and the useful arts," the rulings below stand as an impediment to legitimate invention and progress. This Court must review the question presented in this case in order to correct the Federal Circuit's misreading of this Court's decision in *Westinghouse*.

II. THE RULING BELOW HAS THE EFFECT OF REMOVING SUBJECT MATTER FROM THE PUBLIC DOMAIN, IN VIOLATION OF ARTICLE I, § 8, OF THE UNITED STATES CONSTITUTION.

The United States Constitution, Article I, § 8, cl. 8, provides in relevant part:

> "Congress shall have Power . . . To promote the Progress of Science and the useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . discoveries."

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), this Court noted that the foregoing provision of the Constitution "is both a grant of power and a limitation." *Id.* at 5. This Court noted the implications of Article 1, § 8:

> *"Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.* Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the progress of . . . useful art.' This is the *standard* expressed in the Constitution and it may not be ignored."

Id. at 6 (emphasis added).[9]

We respectfully submit that both the trial court's denial of judgment as a matter of law, and the Federal Circuit's affirmance of that ruling, violate precisely this Constitutional standard. The rulings below would allow Dr. Kearns to recover for infringement based on an overly broad construction of his patents that he could never have obtained from the U.S. Patent & Trademark Office. The published opinion of the Federal Circuit gives future trial courts, where validity is not in issue, "discretion" to exclude entirely even the fact that the accused product itself was in the public domain long before the invention reflected in the patent. That result is directly contrary to the fundamental principle — rooted in Article I, § 8 of the Constitution — that a patent cannot be construed to grant exclusivity for subject matter that is in the public domain.

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[9] This Court also acknowledged that the historical underpinning of Article I, § 8, is the English Statute of Monopolies, enacted over a hundred years earlier, to prevent the Crown from creating monopolies in products that were in the public domain. *Id.*

Both lower court rulings assume the absence of any appreciable distinction between the accused device sold by Chrysler and the significant body of pertinent prior art that predates the patent. In other words, both lower courts accepted Chrysler's contention that for all purposes relevant to a determination of infringement its system was essentially identical to the prior art; yet both erroneously ruled that this was irrelevant, purportedly since patent validity was not in issue. Affirming infringement of that patent was a fundamental violation of Chrysler's Constitutional rights and an unacceptable application of the Patent statute to limit Chrysler's right to use freely that which is in the public domain.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

United States Court of Appeals for the Federal Circuit

93-1450, -1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant,

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

DECIDED: August 11, 1994

Before LOURIE, RADER, and SCHALL, *Circuit Judges.*
LOURIE, *Circuit Judge.*

Chrysler Corporation and Robert W. Kearns appeal and cross-appeal, respectively, from the final judgment of the United States District Court for the Eastern District of Michigan awarding Kearns $18,740,465.43. The judgment was entered on jury verdicts that three patents owned by Kearns were infringed by Chrysler. *Kearns v. Chrysler Corp.*, Civil No. 82-70748 (E.D. Mich. Oct. 30, 1992). The court denied Chrysler's motion for judgment as a matter of law or in the alternative for a new trial. *Kearns v. Chrysler Corp.*, Civil No. 82-70748 (E.D. Mich. June 3, 1993). We affirm the judgment in all respects.

BACKGROUND

In 1982, Kearns filed an action against Chrysler alleging infringement of U.S. Patents 3,351,836, 3,564,374, 3,602,790, and 3,581,178, all relating to electronic intermittent windshield wipers (IWWs) for use in automotive vehicles. At the time the suit was filed, Kearns had three similar suits pending against other automobile manufacturers and distributors involving the same patents, *Kearns v. Ford Motor Co.*, Civil Action No. 78-70740 (E.D. Mich.); *Kearns v. Wood Motors, Inc.*, Civil Action No. 78-70642 (E.D. Mich.); *SWF-Spezialfabrik fur Autozubehor Gustav Rav GmbH v. Kearns*, Civil Action No. 79-74451 (E.D. Mich.).[1]

On October 22, 1982, proceedings in the Chrysler action were stayed pending resolution of the earlier filed suits. The stay was instituted pursuant to Chrysler's stipulation that it would be "bound by the judgment as to the validity of . . . U.S. patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790" in either *Ford*, *Wood Motors*, or *SWF*, whichever was the last to be adjudicated. The stipulation expressly provided, however, that Chrysler would "not be bound by any consent judgment."

In 1989, shortly before the Ford case went to trial, Chrysler renewed its stipulation regarding the issues of invalidity and unenforceability. Subject to continuation of the court-ordered stay, Chrysler agreed to be "bound by the judgment (excluding a consent judgment) in the *Kearns v.*

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[1] Kearns subsequently filed other infringement actions involving patents relating to IWWs, *e.g.*, *Kearns v. General Motors Corp.*, Civil Action No. 85-70461 (E.D. Mich.), *aff'd*, No. 93-1535 (Fed. Cir. July 25, 1994); *Kearns v. Toyota*, Civil Action No. 85-70459 (E.D. Mich.); *Kearns v. Ferrari SpA.*, Civil Action No. 85-70459 (E.D. Mich.); *Kearns v. American Motors Corp.*, Civil Action No. 85-70460 (E.D. Mich.) (consolidated with the instant case by order of the district court on February 3, 1990).

Ford case, C.A. 78-70740 as to the validity and enforceability of the patents involved in that action that are also involved in this action. Those patents included United States Patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790." That stipulation was subsequently entered by the court on February 15, 1990.

1. The Ford Litigation

The liability phase of the Ford case commenced on January 3, 1990. On January 29, 1990, the jury returned a unanimous verdict for Kearns, finding that Ford had not proved by clear and convincing evidence that claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790 patent, and claim 6 of the '178 patent were invalid or unenforceable. On March 9, 1990, the district court entered partial judgment that the specified claims were valid, enforceable, and infringed by Ford. That partial judgment was eventually "made final" upon entry of the court's final judgment on November 14, 1990.

The damage phase of *Ford* was tried before the same jury in April, 1990. The jury, however, was unable to reach a unanimous verdict and a second trial on damages was held in July, 1990. The second jury ultimately returned a unanimous verdict in favor of Kearns, awarding $5,163,842 for the period from April 3, 1978 through 1988. On July 13, 1990, partial judgment was entered on the damage award assessed by the second jury. Although damages for the period from 1972 to April 3, 1978 remained in dispute, Ford and Kearns eventually reached a settlement as to the total amount of liability. Consequently, the partial judgment on damages was vacated and Ford withdrew its pending post-verdict motions for judgment notwithstanding the verdict or in the alternative for a new trial and waived its appellate rights.

2. The Chrysler Litigation

The Chrysler case returned to active status in early 1991. On February 20, 1991, the district court issued a pretrial order stating that the issues to be adjudicated at trial concerned "infringement, damages, and willfulness." On May 3, 1991, Chrysler filed a motion to have the pretrial order modified to add patent validity as an issue for trial. In support of its motion, Chrysler argued that the pretrial stipulations of October 15, 1982 and February 15, 1990 did not bar Chrysler from challenging the patents in suit. Chrysler claimed that because the final judgment in *Ford* was entered pursuant to a settlement agreement between Ford and Kearns, it was a "consent judgment" within the meaning of the stipulations.

The district court denied the motion and limited trial to the issues stated in the pretrial order. In rejecting Chrysler's argument, the district court noted that although a settlement had been reached in *Ford* on the issue of damages, the issue of validity was "hotly" contested by the parties at trial, resulting in a unanimous jury verdict and a final judgment in favor of Kearns. Moreover, the court found that the stipulations did not obligate Ford to pursue post-trial motions and exhaust all rights of appeal in order for the judgment in *Ford* to be binding on the parties in *Chrysler*.

By order of the court, the Chrysler action was bifurcated into separate jury trials on the issues of liability and damages. On December 10, 1991, the jury returned verdicts that Chrysler's accused IWW circuits, designated the "1977 Circuit" and the "1980 Circuit," infringed claim 12 of the '836 patent, claim 6 of the '374 patent, and claim 14 of the '790 patent.[2] On June 11, 1992, the same jury returned a

[2] The jury also found that Chrysler infringed claim 7 of the '178 patent. Due to an inconsistency between the jury's general verdict of infringement and its answer to a special question, the district court set

verdict that Chrysler's infringement was not willful and assessed a reasonable royalty of $.90 per unit for a total of 12,564,107 infringing units.[3] Pursuant to the jury's verdicts, the district court entered final judgment in favor of Kearns in the amount of $18,740,465.43, including prejudgment interest and costs.[4]

Chrysler subsequently filed a motion for judgment as a matter of law (JMOL), asserting that the jury's findings of infringement were not supported by substantial evidence. Alternatively, Chrysler moved for a new trial, claiming that the district court improperly excluded evidence and misinstructed the jury on critical legal issues. The district court denied Chrysler's post-verdict motions. The court considered the expert testimony adduced at trial together with the documentary evidence of record to be a sufficient basis upon which the jury could have supported its findings of infringement. Further, the court determined that the exclusion of evidence was not prejudicial to Chrysler's substantive rights and that the jury was correctly instructed on the interpretation of the claims and their application to the accused circuits.

DISCUSSION

Chrysler now appeals, asserting that the district court's judgment should be reversed as a matter of law because the underlying jury verdicts of infringement were not supported

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aside the jury's finding and entered judgment of noninfringement pursuant to Fed. R. Civ. P. 49(b). The court's judgment respecting claim 7 is not at issue in this appeal.

[3] The Court subsequently revised the number of infringing units downward to 12,563,107 units.

[4] Specifically, the judgment consisted of $11,306,696.30 for infringement damages, $8,075,193 for prejudgment interest, and $25,898.75 for costs, less $667,322.62 in costs, expenses, and attorneys' fees awarded to Chrysler.

by substantial evidence, or in the alternative, that a new trial is warranted in view of the prejudicial error committed by the district court in barring Chrysler from introducing prior art evidence necessary to properly construe the claims at issue and to challenge their validity and enforceability. Kearns cross-appeals certain rulings of the court that allegedly deprived him of the total compensation to which he claims he is entitled.

New Trial

We first address the district court's denial of Chrysler's motion for a new trial. "The denial of a motion for new trial can be reversed only if the district court abused its discretion." *Arachnid, Inc. v. Medalistic Marketing Corp.*, 972 F.2d 1300, 1301, 23 USPQ2d 1946, 1948 (Fed. Cir. 1992) (citation omitted); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1367, 21 USPQ2d 1321, 1326 (Fed. Cir. 1991), *cert. denied*, 113 S. Ct. 60 (1992). An abuse of discretion may be established by showing that the district court either made an error of law, a clear error of judgment, or made findings which were clearly erroneous. *See Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1569, 28 USPQ2d 1081, 1091 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1540 (1994).

1. Invalidity and Unenforceability

In support of its contention that a new trial is required, Chrysler claims that the district court erred as a matter of law in excluding evidence allegedly showing that the patents in suit are invalid and unenforceable. Chrysler claims that the district court's decision to exclude such evidence was based on an erroneous interpretation of the pretrial stipula-

tion of February 15, 1990,[5] in which Chrysler agreed to be bound by the judgment rendered in the Ford case on the issues of invalidity and unenforceability. It is Chrysler's position that the Ford judgment was in fact a consent judgment, which, under the terms of the stipulation, was not binding on Chrysler.

The proper interpretation of the parties' pretrial stipulation, like any contract, presents a legal question that we address *de novo*. *See Intel Corp. v. ULSI Sys. Technology, Inc.*, 995 F.2d 1566, 1569, 27 USPQ2d 1136, 1138 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 923 (1994). As always, our inquiry begins with the language of the agreement memorializing the intent of the parties.

The controlling language of the agreement between Chrysler and Kearns provides that Chrysler "shall be bound by the [Ford] judgment *(excluding a consent judgment)* . . . as to the validity and enforceability" of the patents in suit. [Emphasis added.] Chrysler asserts that the existence of the "consent judgment" exception in the stipulation indicates that it only intended to be bound by a judgment respecting invalidity and unenforceability where those issues were "fully litigated" by Ford, *i.e.*, only after Ford vigorously defended its position at trial and exhausted all available post-trial remedies. Chrysler insists that the final judgment entered in *Ford* was a "consent judgment" because the parties in that case reached a settlement on the issue of damages that effectively mooted Ford's post-trial motions and forced Ford to forfeit its appellate rights.

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[5] The district court did not rely on the first stipulation of October 15, 1982 in making its disputed evidentiary rulings. The court considered that stipulation to be *functus officio* in view of the February 15, 1990 stipulation. We will therefore limit our discussion to the latter stipulation.

We reject Chrysler's attempts to avoid the consequences of its stipulation by redefining its terms. The fact that Ford was precluded from proceeding with its post-trial motions or seeking appellate review because of its damage settlement does not render the court's judgment a "consent judgment." In our effort to give effect to the original intent of the parties, we adhere to the well-settled rule that words in an agreement are interpreted in accordance with their ordinary and commonly accepted meanings. *See Hol-Gar Mfg. Corp. v. United States,* 351 F.2d 972, 979 (Ct. Cl. 1965). The term "consent judgment" is defined as "[a] judgment, the provisions and terms of which are settled and agreed to by the parties to the action." *Black's Law Dictionary* 842 (6th ed. 1990). This meaning is in contradistinction to a judgment that is rendered by a court without agreement of the parties. The commonly accepted meaning of the term "consent judgment" prevails here because the stipulation is devoid of any indication that the parties intended a different meaning.

Although it is undisputed that Ford settled the amount of compensation due Kearns, no such settlement or agreement was reached between the parties in *Ford* respecting the issues of validity, enforceability, and infringement of the asserted patent claims. Indeed, as the trial court noted, those issues were "hotly," "vigorously," and "fully" contested by the parties during a lengthy jury trial.[6] Pursuant to unanimous verdicts returned by the jury, the court entered partial (and later final) judgment holding claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790

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[6] The judge who presided over the Ford litigation also presided over the Chrysler litigation. In rejecting Chrysler's initial attempts to avoid its stipulation, Judge Cohn stated, "I know that I entered a Partial Judgment of Validity, after a hotly contested trial. To my way of thinking . . . there was no Consent Judgment on Validity. Validity was contested. Kearns won, Ford lost and it chose not to appeal, and it withdrew its Motions JNOV or New Trial. That doesn't obviate the fact that it was judgment contested arising in a contested environment."

patent, and claim 3 of the '936 patent valid, enforceable, and infringed. Because neither party in *Ford* "settled and agreed" on the issues of validity and enforceability, the district court's judgment respecting those issues was not a "consent judgment" within the meaning of the stipulation. Chrysler is thus bound by that judgment. *See Restatement (Second) of Judgments* § 40 (1982) ("A person who agrees to be bound by the determination of issues in an action between others is bound in accordance with the terms of his agreement.").

In a further attempt to avoid the consequences of its stipulation, Chrysler urges that "public policy" favors allowing it to challenge the patents' validity and enforceability. Even were we to agree with this proposition, we do not see how it aids Chrysler here. Chrysler was certainly entitled to raise the defenses of invalidity and/or unenforceability when it was accused of infringement, but it chose instead to rely on the judgment rendered in *Ford* on those issues. Public policy will not rescue Chrysler from a decision which it later finds to be imprudently made. On the contrary, public policy favors preventing Chrysler from reneging on an agreement into which it freely entered and upon which Kearns and the district court relied. *See Interspiro USA Inc. v. Figgie Int'l Inc.*, 18 F.3d 927, 930, 30 USPQ2d 1070, 1072 (Fed. Cir. 1994); *Bank of America Nat'l Trust and Savings Assoc. v. United States*, No. 93-5059, slip op. at 4-5 (Fed. Cir. April 29, 1994).

Accordingly, we agree with the district court that Chrysler was barred under the stipulation from introducing prior art evidence directed toward challenging the validity and enforceability of the asserted patents in this case.

2. Interpretation of Claims

Next, Chrysler contends that the district court committed reversible error by excluding prior art evidence allegedly

essential to the proper construction of the claims at issue. As a result of that error, Chrysler asserts that a new trial is warranted because the jury's infringement analysis was predicated on distorted claim interpretations.

"The decision to admit or exclude evidence is within the sound discretion of the trial court and will be reversed on appeal only for a clear abuse of that discretion." *Smith & Lee Assocs., Inc. v. City of Taylor, Mich.*, 13 F.3d 920, 928 (6th Cir. 1993). In order to show that the district court abused its discretion in excluding the prior art evidence, Chrysler must demonstrate that the exclusion prejudiced its substantive rights. *See DMI. Inc. v. Deere & Co.*, 802 F.2d 421, 428, 231 USPQ 276, 280-81 (Fed. Cir. 1986). Here, Chrysler has failed to make that showing.

It is well-settled that reference may be had to prior art when it will assist a court in determining how a disputed claim is understood by those skilled in the art. *See Palumbo v. Don-Joy Co.*, 762 F.2d 969, 975, 226 USPQ 5, 8 (Fed. Cir. 1985); *Tandon Corp. v. International Trade Comm'n*, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). However, when claim language is clear and unambiguous on its face, resort to prior art may be unnecessary.

Whether a claim has been infringed requires first interpreting the claim and then comparing the properly construed claim to the accused device. *See Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992). When, as here, prior art is not required to resolve the underlying legal question concerning what a claim means, it necessarily has little relevance to the ultimate factual question of infringement. Such evidence is by definition "irrelevant" and need not be admitted by a trial court. *See* Fed. R. Evid. 401, 402.

At trial, Chrysler attempted to introduce prior art patents ostensibly for the purpose of aiding in the interpretation of

the claims at issue. Specifically, Chrysler intended to show that under Kearns' interpretations of the claims, the claims were impermissibly broad because they read upon or were obvious over the prior art. The district court, however, concluded that the claims could be construed according to their plain meaning and that reference to prior art was not required.[7] Moreover, and highly significant here, the district court believed that Chrysler's attempts to offer such evidence constituted a disguised, "back door" attack on the validity of the patents, which was expressly proscribed by the binding stipulation.

The district court's reasoning adequately supports its refusal to admit the proffered evidence. "[That] we might have reached a different result or might have affirmed had the district court gone the other way are insufficient bases for reversal under the abuse of discretion standard which applies to our review of this part of the court's judgment." *RCA Corp. v. Data General Corp.*, 887 F.2d 1056, 1065, 12 USPQ2d 1449, 1457 (Fed. Cir. 1989). Moreover, even if the court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced. The district court's denial of Chrysler's motion for a new trial is therefore affirmed.

Judgment as a Matter of Law

We now consider Chrysler's argument that the district court erred in denying its motion for judgment as a matter of

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[7] The claims at issue contain limitations expressed in "means-plus-function" format. 35 U.S.C. § 112 ¶ 6 (1988). The court's ruling is consistent with the rule that "[i]t is not necessary to consider the prior art in applying section 112, paragraph 6. Even if the prior art discloses the same or an equivalent structure, the claim will not be limited in scope thereby." *Intel Corp. v. United States Int'l Trade Comm'n*, 946 F.2d 821, 842, 20 USPQ2d 1161, 1179 (Fed. Cir. 1991).

law on the issue of infringement. Chrysler contends that no substantial evidence supports the jury's findings that Chrysler literally infringed claim 14 of the '790 patent, claim 16 of the '836 patent, and claim 6 of the '374 patent.

"We reverse a denial of a motion for JMOL only if the jury's factual findings, presumed or express, are not supported by substantial evidence or, if they are, that the legal conclusions implied from the jury's verdict cannot in law be supported by those findings." *Arachnid, Inc. v. Medalistic Marketing Corp.*, 972 F.2d at 1301, 23 USPQ2d at 1948 (citation omitted). The "substantial evidence" standard "requires us to decide for ourselves whether reasonable jurors viewing the evidence as a whole could have found the facts needed to support the verdict in light of the applicable law. If we conclude that no reasonable findings of fact, supported by substantial evidence, could support the verdict that was incorporated into the trial court's judgment, then we must conclude that the trial court erred in not granting the motion for [JMOL]." *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1207, 23 USPQ2d 1284, 1288 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993). Moreover, we review the evidence in the light most favorable to Kearns, the nonmoving party, drawing all reasonable inferences in his favor. *See Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 181, 30 USPQ2d 1462, 1464 (Fed. Cir. 1994).

Chrysler devotes the bulk of its appeal to challenging the jury's findings that the accused circuits performed the functions required by each of the asserted means-plus-function clauses by means of structure taught in the specification or an equivalent of those structures. In doing so, Chrysler pays mere lip service to the substantial evidence standard by ignoring the evidence upon which the jury reasonably relied in reaching its verdicts and by rearguing the merits of the infringement issues. An appeal, however, is not to be used as

a means of retrying a case. *See DMI,* 802 F.2d at 426, 231 USPQ at 279. Under the substantial evidence standard, the appellate court's function is exhausted once a sufficient evidentiary basis is deemed to exist to support the jury's findings. *See Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1235, 9 USPQ2d 1913, 1919 (Fed. Cir.), *cert. denied,* 493 F.2d 853 (1989).

Trial on the issue of infringement lasted approximately four weeks, during which expert testimony was introduced by both parties. Specifically, as the district court stated, "the expert testimony first construed each of the asserted claims and then went on to describe how the Chrysler system responded to each of the elements of each of the claims. . . . It is this expert testimony together with admissions in Chrysler's documents describing the gestation of the Chrysler system which constituted, for the most part, the substantial evidence supporting the jury's verdict of infringement." After receiving instructions on the law governing infringement of means-plus-function claims,[8] the jury returned verdicts that the asserted claims were literally infringed by Chrysler's accused IWW circuits. Each of the jury's verdicts of infringement was supported by a number of detailed special interrogatories (referred to at trial as "special questions") that addressed specific issues that had been the focus of expert testimony at trial.[9]

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[8] "In order to meet a means-plus-function limitation, an accused device must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure." *Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.,* 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994).

[9] The jury decided some 39 special questions concerning the issue of infringement. Five special questions were directed to infringement of claim 5 of '790 patent, 17 special questions to claim 16 of the '836 patent, and five special questions to claim 6 of the '374 patent.

We have recognized that "[t]he use of special interrogatories . . . facilitates appellate review . . . for such use frees the court from having to survey every possible basis for the jury's decision." *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1361, 220 USPQ 763, 773 (Fed. Cir.), *cert. denied*, 469 U.S. 821 (1984). The district court, in denying Chrysler's post-trial motions, analyzed all of the special interrogatories answered by the jury and cited evidence presented to the jury pertinent to each interrogatory, including expert witness testimony. Thus, it is clear that the jury verdicts were supported by substantial evidence. The detailed nature of the special interrogatories, as well as the extensive analysis by the trial judge in considering Chrysler's post-trial motions, are impressive indeed, giving great credibility to the decisions reached.

We conclude that Chrysler has failed to show that on the entirety of the record reasonable persons could not have found the facts necessary to support the jury's verdicts of infringement. Because substantial evidence supports the jury's verdicts and because the legal conclusions implied from those verdicts are consistent with the jury's findings, the district court's denial of Chrysler's motion for judgment as a matter of law is affirmed.

Cross-Appeal

Kearns now cross-appeals a number of rulings issued by the district court that Kearns claims precluded him from obtaining all the relief and compensation to which he was entitled under the law. At issue are the district court's orders (1) granting Chrysler's motion for summary judgment on Kearns' right to seek injunctive relief, (2) granting Chrysler's motion for summary judgment on Kearns' right to recover lost profits as damages, (3) denying Kearns' motion to disqualify Chrysler's counsel for conflict of interest, (4) precluding Kearns from challenging the number of

infringing units without filing supporting documentary evidence, (5) denying Kearns' motion to offer separate evidence of willful infringement by American Motors, (6) granting Chrysler's motion for a directed verdict on the issue of willfulness, (7) assessing prejudgment interest for the period from March 2, 1982 to June 11, 1992 at simple interest rather than 2% above the prime rate, and (8) awarding Chrysler $677,332.62 for attorneys' fees and expenses. We will address each of these rulings in turn to the extent necessary.

1. Post-expiration Injunctive Relief

Shortly before trial, Kearns expanded his claim for relief to include injunctive relief. Kearns believed that Chrysler's infringement deprived him of the "full value" of his patents during their respective terms by effectively extinguishing his exclusive right to sell his patented IWW systems to automobile manufacturers. Kearns urged that Chrysler should be enjoined from manufacturing infringing IWW systems for a period of sufficient duration "to put him in [a] position where the harm [caused by] past infringement during the terms of the patents in suit is rectified." The district court refused to grant such relief because the patents had already expired.[10] The court concluded that "there is nothing in statute or common law giving [Kearns] the right to an injunction against practicing the disclosures in an expired patent."

In arguing that the district court erred in denying him post-expiration relief, Kearns claims that the $11 million damage award is not adequate to compensate him for the loss he sustained as a result of Chrysler's infringement. Kearns contends that Chrysler's infringement stripped him

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[10] The '836 patent expired in 1984 and the '790 and '374 patents both expired in 1988.

of "exclusive time" over his patents in violation of his rights under the U.S. Constitution and the patent laws, and that he is entitled to have that time restored to him. That contention, however, finds no basis in the statutory scheme governing patent infringement remedies.

Under the laws enacted by Congress, a patent grants the patent owner the right to exclude others from making, using, or selling the claimed invention in the United States for the term of seventeen years. 35 U.S.C. § 154 (1988). When that exclusive right is infringed, the patent owner is authorized to obtain compensation in the form of damages, measured, *e.g.*, by lost profits or a reasonable royalty. 35 U.S.C. §§ 281, 284 (1988). Moreover, the statute expressly provides for the grant of injunctions "in accordance with the principles of equity." 35 U.S.C. § 283 (1988). In view of the fact that the principal right afforded by a patent is the "right to exclude," we have noted that "[t]he nature of the patent grant ... weighs against holding that monetary damages will always suffice to make the patentee whole." *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 387-88, 2 USPQ2d 1926, 1930 (Fed. Cir. 1987). Indeed, "[w]hile monetary relief is often the sole remedy for past infringement, it does not follow that a monetary award is also the sole remedy against *future* infringement." *Atlas Powder Co. v. Ireco Chemicals*, 773 F.2d 1230, 1233, 227 USPQ 289, 292 (Fed. Cir. 1985) (emphasis added). However, § 283 relief is available only to "prevent the violations of any right secured by patent." Thus, when the rights secured by a patent are no longer protectable by virtue of expiration or unenforceability, entitlement to injunctive relief becomes moot because such relief is no longer available. *See Illinois Tool Works, Inc. v. Grip-Pak, Inc.*, 906 F.2d 679, 681, 15 USPQ2d 1307, 1308 (Fed. Cir. 1990).

An invention claimed in a patent passes into the public domain upon termination of the patent's 17-year statutory

term. Because the rights flowing from a patent exist only for the term of the patent, there can be no infringement once the patent expires. Here, all the asserted patents expired before the commencement of trial. Therefore, Kearns "can no longer obtain injunctive relief with respect to [those patents]." *See Kinzenbaw v. Deere & Co.,* 741 F.2d 383, 386, 222 USPQ 929, 931 (Fed. Cir. 1984), *cert. denied,* 470 U.S. 1004 (1985); *see also Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo, Ltd.,* 754 F.2d 345, 347, 224 USPQ 863, 865 (Fed. Cir. 1985). Granting the relief requested by Kearns could impermissibly extend the statutory term beyond that established by Congress. Congress has the power to provide for patent term extension in appropriate circumstances, *see* 35 U.S.C. §§ 155, 156 (1988), but it has not done so here and we cannot legislate in its place. *See Denkler v. United States,* 782 F.2d 1003, 1008 (Fed. Cir. 1986) ("Should Congress wish to extend the [statute's scope], it knows how to do so."). The expiration of Kearns' patents precludes the grant of injunctive relief and the judgment for $11 million in damages thus amounts to adequate and full compensation under the law for Chrysler's past violation of his patent rights.

Kearns argues that our decision in *Roche Prods., Inc. v. Bolar Pharmaceutical Co., Inc.,* 733 F.2d 858, 221 USPQ 937 (Fed. Cir.), *cert. denied,* 469 U.S. 856 (1984), suggests that the availability of post-expiration equitable relief is simply a matter within the discretion of the trial court. In *Roche,* the trial court denied the patent owner's request for a permanent injunction because it found there was no infringement. Although the trial court's finding of noninfringement was reversed on appeal, the request for injunctive relief became "no longer . . . necessary" because the patent had expired. Despite the patent's expiration, the case was remanded to the lower court with directions to fashion an appropriate equitable remedy to redress the harm to the patent owner caused by past acts of infringement. *Id.* at 865,

221 USPQ at 942. Kearns argues that the district court should consider taking action similar to that contemplated in *Roche*. Kearns, however, is not in a position to benefit from such relief.

The post-expiration relief discussed in *Roche* was intended to return the parties to the status quo before infringement (*e.g.*, destruction of data obtained as a result of the infringement) and was not intended to prohibit future use of the invention. Importantly, the relief was also considered in the context of harm to a patent owner that had been selling the patented product. Thus, deferral of competition by an infringer who had entered the market prematurely, *i.e.*, before the patent expired, was considered as a means of equitably compensating the patent owner. In contrast, because Chrysler has been manufacturing and selling its infringing IWWs for many years and Kearns has not (see *infra*), there is no basis for granting relief similar to that contemplated by the court in *Roche*.

We sympathize with Kearns' complaint that his patents have expired without his ever being able to exclude others from practice of his invention, especially since he is an individual inventor contending with a multitude of giant corporations.[11] While it is of course the essence of a patent that it provides the right to exclude, the same statute that grants that right also permits other parties, including accused infringers, to challenge the validity of a patent and to contest a charge of infringement. *See* 35 U.S.C. § 282 (1988). Moreover, entitlement to an injunction implementing the right to exclude, as compared with only assessing damages against an infringer, is not absolute even during the life of a patent, but is discretionary. *See* 35 U.S.C. § 283

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[11] The fact that Kearns has fired several of his attorneys and attempted to conduct massive multiple suits *pro se* may be relevant to his dilemma.

("courts having jurisdiction of cases under this title *may* grant injunctions" (emphasis added)); *see also City of Milwaukee v. Activated Sludge, Inc.*, 69 F.2d 577, 593, 21 USPQ2d 69, 85-86 (7th Cir. 1937); *Vitamin Technologists, Inc. v. Wisconsin Alumni Research Found., Inc.*, 146 F.2d 941, 944-45, 63 USPQ 262, 267 (9th Cir. 1944). Here, because Kearns' patents have expired, the district court certainly did not abuse its discretion in denying injunctive relief.

It is unfortunate that Kearns feels that he never enjoyed an exclusive status under his patents, but that is simply a consequence of the right of others to challenge his patents and the fact that his patents have expired. The patent statute does provide for increased damages and attorney fees as additional relief for aggrieved patent owners, *see* 35 U.S.C. §§ 284, 285 (1988), but Kearns did not persuade the district court that he was entitled to such relief.

We therefore conclude that the district court properly granted summary judgment in favor of Chrysler on Kearns' request for post-expiration injunctive relief.

2. Lost Profits

Kearns argues that the district court erred in granting Chrysler's motion for summary judgment on Kearns' claim for damages based on lost profits, rather than a reasonable royalty. A patent owner bears the burden of proof on damages. *Fromson v. Western Litho Plate and Supply Co.*, 853 F.2d 1568, 1574, 7 USPQ 1606, 1612 (Fed. Cir. 1988). Kearns has not carried that burden with respect to lost profits.

A lost profits award is appropriate only if the patent owner can prove there was a reasonable probability that "but for" the infringement, it would have made the infringer's sales. *Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 671, 7 USPQ2d 1097, 1106 (Fed. Cir.), *cert. denied*,

488 U.S. 968 (1988). One way to establish "but for" causation is to meet the four-part test pronounced in *Panduit Corp. v. Stahlin Bros. Fiber Works*, 575 F.2d 1152, 1156, 197 USPQ 726, 729-30 (6th Cir. 1978). *See Standard Havens Prods.*, 953 F.2d at 1372-73, 21 USPQ2d at 1331. To recover under that test, the patent owner must prove (1) a demand for the patented product, (2) an absence of acceptable noninfringing substitutes, (3) *manufacturing and marketing capability to exploit the demand*, and (4) the amount of profit the patent owner would have made. *Id.* (emphasis added).

In ruling against Kearns, the district court concluded that Kearns failed to prove the *Panduit* requirements for lost profits, particularly with regard to whether he possessed the capability to manufacture and market IWWs. The court determined that "[a]t best plaintiff's offer of proof demonstrates plans for manufacture that were tentative, speculative and contingent. Plaintiff does not suggest he ever made any sales of intermittent windshield wipers or had the manufacturing capability in hand to do so." Kearns disputes the court's finding, stating that his company "Kearns Engineers" had the capacity to manufacture, market, and sell IWWs since the 1960's and that Chrysler's infringement prevented him from selling his IWWs to Chrysler. That contention, however, is not supported by the record.[12] Where, as here, a patent owner fails to prove lost profits, the court is left with no alternative but to have damages determined on the basis of a reasonable royalty. *See Water Technologies,* 850 F.2d at 673-74, 7 USPQ2d at 1108.

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[12] We note that the appendices filed by Kearns on appeal contain documents not considered by the district court. We, of course, must limit our review to the record produced at trial. *DMI,* 802 F.2d at 426, 231 USPQ at 279.

Accordingly, we affirm the district court's grant of summary judgment in favor of Chrysler on the issue of lost profits.

3. Other Rulings

We have carefully reviewed the district court's other rulings respecting willful infringement, disqualification of counsel, prejudgment interest, and attorneys' fees and costs. The rulings are adequately supported by the record and are consistent with governing law. We need not address Kearns' contentions in detail. For purposes of our decision, suffice it to say that Kearns has not identified any reversible error in law or fact made by the district court in reaching its decisions. Accordingly, we affirm the district court's rulings.

CONCLUSION

The district court did not err in denying Chrysler's post-verdict motions. Nor did the district court commit any reversible error in ruling on the various issues disputed by Kearns. Accordingly, the district court's judgment is affirmed in all respects.

AFFIRMED

APPENDIX B

United States Court of Appeals for the Federal Circuit

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on October 5, 1994.

FOR THE COURT,
FRANCIS X. GINDHART,
CLERK

Dated: September 28, 1994

By /s/ DIANE M. FRYE
Diane M. Frye
Chief Deputy Clerk

cc: ROBERT P. TAYLOR
ROBERT W. KEARNS

WILLIAM D. DURKEE, RICHARD L. AITKEN

KEARNS V CHRYSLER CORP, 93-1450
(DCT - 82-70748)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX C

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v.

CHRYSLER CORPORATION,

Defendant.

Civil No. 82-70748

OPINION AND ORDER

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I. INTRODUCTION

A. Nature of Case

This is a patent case involving four patents for intermittent windshield wipers owned by plaintiff Robert W. Kearns (Kearns). Defendant is Chrysler Corporation (Chrysler).[1] On December 19, 1991, after a 27 day trial and 9 days of deliberations, a jury found Chrysler infringed Claim 16 (together with Claim 12) of U.S. Patent No. 3,351,836 (the '836 patent), Claim 6 (together with Claim 5) of U.S. Patent No. 3,564,374 (the '374 patent), Claim 14 (together with Claims 9 and 13) of U.S. Patent No. 3,602,790 (the '790 patent) and Claim 7 (together with Claim 1) of U.S. Patent No. 3,581,178 (the '178 patent). On April 28, 1992, because of an inconsistency between the jury's answer to a special question and the general verdict of infringement on the '178 patent, the Court, pursuant to Fed. R. Civ. P. 49(b), ordered that the Chrysler A and B systems (the Chrysler intermittent windshield wiper systems alleged to have infringed)[2] did not infringe.

On June 11, 1992, after a 21 day trial and 6 days of deliberations, the same jury found that Chrysler's infringement was not willful and that a reasonable royalty was 90 cents an infringing unit.[3] On October 26, 1992, as of June 11, 1992, the Court entered a final judgment in

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[1] A separate case against American Motors Corporation was consolidated with this case under a stipulation to include the American Motors Corporation intermittent windshield wiper units as part of the Chrysler units.

[2] Chrysler in its argument generally makes no distinction between the two systems. The Court will use the term Chrysler system to refer to both systems.

[3] The parties could not agree on the number of infringing units. It was a contentious point throughout the case. Eventually the Court determined there were 12,563,107 infringing units.

Kearns' favor for $18,740,465.43, which includes prejudgment interest. Now before the Court is Chrysler's motion under Fed. R. Civ. P. 50(b) and 59(a) for judgment as a matter of law or in the alternative for a new trial on grounds which will be discussed below.[4] For the reasons which follow the motion will be denied.

B. Prior Rulings

The Court on November 11, 1992, and December 10, 1992, denied similar motions by Kearns. Also, during the course of the case the Court granted or denied numerous motions based on a variety of grounds. Many of the orders granting or denying these motions are likely to be the subject matter of an appeal. It would inappropriately prolong the length of this opinion for the Court to describe these orders much less attempt to divine which of them the parties consider sufficiently egregious to warrant the expense and effort of an appeal.[5] Since Chrysler has vigorously disputed the Court's ruling that it agreed to be bound by the decision on validity and enforceability in *Kearns v. Ford Motor Co.*, Civil No. 78-70740, which was decided in Kearns' favor, that ruling is likely to be the subject of an

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[4] Chrysler's motion filed June 25, 1992, asserts somewhat different grounds than it argued in its brief filed September 1, 1992. See Chrysler's Supplemental Memorandum In Support Of Motion For Judgment As A Matter Of Law, Or In The Alternative, For A New Trial, filed February 2, 1993. The Court in this Opinion And Order deals only with the grounds asserted in Defendant Chrysler Corporation's Memorandum In Support Of Its Motion For Judgment As A Matter Of Law, Or In The Alternative, For A New Trial On Liability And Damages Issues, filed September 1, 1992. To deal with both would unreasonably burden the obligations of the Court regarding Chrysler's request for post-trial relief.

[5] An appendix reflecting the more significant filings by the parties and orders entered by the Court is attached.

appeal.[6] And, since Kearns believes he is entitled to injunctive relief effectively extending the 17 year statutory life of his patents, he is likely to ask the Federal Circuit to review the Court's denial on February 24, 1992, of such relief.[7] Lastly, it would also inappropriately lengthen this opinion for the Court to describe the course of the case and particularly the significant events in the two trials. Suffice it to say, the case was vigorously and contentiously fought and the trials were hotly contested with a multitude of witnesses and exhibits on each side. Importantly, the Court gave each party ten preemptory challenges, gave counsel the order in which the venire would be drawn in advance, utilized a ten person jury because of the bifurcation of liability from willfulness and damages, used substantive preliminary instructions, gave the jury a glossary of terms, used a multiple general verdict form, special questions, juror note taking, juror notebooks, and gave the jurors the right to ask questions. The Court also utilized the services of a special master for pretrial matters in the willfulness and damages phase.

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[6] See discussion at p. 61, *infra*.

[7] Kearns places no weight on the unpublished decision of the Court of Appeals for the Federal Circuit in *Kearns v. The United States*, Appeal No. 85-645 (April 26, 1985), a case in which Kearns sued the United States in the Court of Claims to obtain an extension of certain of his patents. In its decision the Federal Circuit said

> Congress alone has the power to extend the patent term . . . Applicants' apparent frustration with litigation delays and with what he views as the failure of others to understand his patents is understandable, but nothing in the Constitution or in any statute precludes a patent owner's fellow citizens from challenging the propriety of a patent grant.

Publication of the decision by the Federal Circuit would have improved the likelihood of resolving this case by agreement.

C. Pro Se Representation[8]

Lastly, mention should be made of a peculiarity in this case. Kearns has sued every major automobile manufacturer in the world which sells automobiles in the United States for infringement of his patents concerning intermittent windshield wipers. After three jury trials, one on validity and enforceability and two on damages (the first jury could not agree on damages), Kearns settled with Ford Motor Company (Ford). After the jury finding of infringement in this case, Kearns discharged his lawyers and handled the willfulness and damages trial *pro se*. Kearns is also handling the pending motion *pro se*, as well as two cases now pending on the Court's docket against General Motors Corporation and five major Japanese automobile manufacturers. Cases against German and other foreign automobile manufacturers have been stayed pending a decision in the case against the major Japanese manufacturers. Also, after receiving Chrysler's 167 pages with 294 footnotes brief, the Court solicited a brief amicus from Kearns' former counsel, Arnold White & Durkee, who represented Kearns in the case against Ford and who handled much of the pretrial in this case, and Reed Smith Shaw & McClay, who handled the liability phase of this case, since it appeared to the Court that Kearns' lack of legal acumen made it unlikely he could mount an adequate response to Chrysler's motion papers. The Court was correct. The Court, in the discussion with follows, has relied largely on the amicus' 110 page with 33 footnotes brief. Kearns' two briefs in opposition are unfocused and of little help.[9]

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[8] See also discussion at p. 74, *infra*.

[9] The Court in the discussion which follows does not distinguish between the amicus' argument and Kearns' argument but simply refers to the two arguments in the singular as "Kearns".

D. Applicable Law

No extended discussion of the legal principles governing the Court's consideration of Chrysler's motion is necessary. These principles are well known. *See generally Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542 (Fed. Cir. 1983). Likewise, so are the legal principles governing the particular grounds for relief urged by Chrysler. To the extent the Court believes appropriate, legal principles will be discussed as particular grounds are discussed.

II. JUDGMENT AS A MATTER OF LAW — INFRINGEMENT

A. Introduction

1.

Fed. R. Civ. P. 50(a) (1) states:

> If during a trial by jury a party has been fully heard with respect to an issue and there is no legally sufficient evidentiary basis for a reasonable jury to have found for that party with respect to that issue, the court may grant a motion for judgment as a matter of law against that party on any claim, counterclaim, cross-claim, or third party claim that cannot under the controlling law be maintained without a favorable finding on that issue.

So long as "reasonable jurors viewing the evidence as a whole could have found the facts needed to support the verdict as a matter of applicable law", *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1207 (Fed. Cir. 1992), the Court may not interfere with the finding of infringement. The Court should not, however, simply accept such a finding. As suggested in *Lemelson*, "there is a special burden placed on the trial judge" in a jury trial patent case to ensure that the applicable rules do not "get short shrift." 968 F.2d at 1206. Here, the applicable rules were stated in the instructions to

the jury; the Court finds no error in the instructions.[10] Some additional comment on the applicable law, however, is in order.

2.

In an unpublished decision, *Drexelbrook Controls, Inc. v. Endress & Hauser, Inc.*, No. 92-1234, 92-1235 (Decided February 4, 1993), the Court of Appeals for the Federal Circuit said:

> Although claim interpretation is a question of law, in cases such as this where the claim terms in issue involve complex scientific principles and conflicting expert testimony, an underlying question of fact is created. *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft,* 945 F.2d 1546, 1549-52, 20 USPQ2d 1332, 1336 (Fed. Cir. 1991); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 643, 2 USPQ2d 1271, 1273 (Fed. Cir. 1987). In such cases where there is conflicting testimony and argument on material fact issues, due deference must be given to the decision of the jury and trial judge. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 619, 225 USPQ 634, 636 (Fed. Cir. 1985), *cert. dismissed,* 474 U.S. 976 (1986).

In *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985), the Court of Appeals for the Federal Circuit said:

> To interpret "means plus function" limitations as limited to a particular means set forth in the specification would be to nullify the provision of § 112 requiring that the limitation shall be construed to cover the structure described in the specification and equivalents thereof. Patentees are required to disclose in the specification

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[10] See discussion at pp. 43-52 and 63-66, *infra.*

some enabling means for accomplishing the function set forth in the "means plus function" limitation. At the same time, there is and can be no requirement that applicants describe or predict every possible means of accomplishing that function. The statute, § 112-6, was written precisely to avoid a holding that a means-plus-function limitation must be read as covering only the means disclosed in the specification.

In other words, the Court is not to read the specifications into the claims. See *Texas Instruments, Inc. v. United States International Trade Commission,* 805 F.2d 1558, 1562 (Fed. Cir. 1986).

As to infringement, a determination of equivalence in an accused device under 35 U.S.C. § 112, which is involved here, is a question of fact, *Durango Associates, Inc. v. Reflange, Inc.,* 843 F.2d 1349, 1357 (Fed. Cir. 1988), and that all of the elements of a claim are old is "simply irrelevant". *Environmental Designs, Ltd. v. Union Oil Co. of Cal.,* 713 F.2d 693, 698 (Fed. Cir. 1983).

3.

There are several fundamental flaws in Chrysler's argument that it is entitled to a judgment as a matter of law. First, since the jury's verdict on infringement is reviewed under the substantial evidence test, it is improper for Chrysler to ignore the evidence which supports the verdict and to argue as if it was involved in a trial to the bench. Here, there was substantial evidence in the form of detailed expert testimony which the jury could have found credible to support the findings of infringement. Particularly, the expert testimony first construed each of the asserted claims and then went on to describe how the Chrysler system responded to each of the elements of each of the claims. Chrysler simply ignores this testimony.

Second, Chrysler, in its argument, reduced each of the claims to a particular embodiment or practice and then compared that embodiment to the Chrysler system and goes on to argue no infringement.

Lastly, Chrysler has made no effort to explain the answers to special questions contrary to its position.

4.

In the discussion which follows, the Court has relied in considerable part on the representation of Kearns as to the content of the record regarding the testimony of Arthur L. Larkey, a professor of electrical engineering at Leigh University, William Hall, a patent lawyer, and Jerome Meisel, a professor of electrical engineering at Wayne University, its experts at trial. It is this expert testimony together with admissions in Chrysler's documents describing the gestation of the Chrysler system which constituted, for the most part, the substantial evidence supporting the jury's verdict of infringement. Nowhere in Chrysler's argument is there support for the assertion that reasonable jurors could not differ as to a finding of the absence of identity of function and identity of means or their equivalent in the Chrysler system compared to the asserted claims. Chrysler repeatedly mischaracterizes the comparison to be made when it says:

> The functions of [the elements] are not identical to the functions performed by the Chrysler system. The structures of [the elements] are not the same or equivalent to the structures used in the Chrysler system.

What Chrysler should be arguing is that

> The functions of the Chrysler system are not identical to the functions performed by [the elements]. The structures of the Chrysler system are not the same or the equivalent to the structures used in [the elements].

After all, it is the Chrysler system which is accused of infringing and not vice-versa.

5.

The verdicts returned by the jury read generally as follows:

> A. Has Dr. Kearns shown by a preponderance of the evidence that the [Chrysler system] literally infringed [patent claim]?
>
> [Answer] *Yes*
>
> B. Did the [Chrysler] system nevertheless, not infringe because it was so changed in principle that it performed the same or a similar function to produce substantially the same result, but did so in a substantially different way?
>
> [Answer] *No*[11]

The jury answered consistent with its finding of infringement five special questions on the '790 patent, 17 on the '836 patent and five on the '178 patent.

B. Claim 14 of the '790 Patent

Claim 14 of the '790 patent (which includes claim 9 and claim 13) reads:

> 9. A windshield wiper system for automotive vehicle comprising
>
> A. *a DC motor* connected to drive at least one windshield wiper blade through wipe cycles on an automotive vehicle windshield, *said motor having three brushes* so that the greater portion of said armature

[11] Chrysler makes no argument about the jury's finding that it did not show non-infringement under the reverse Doctrine of Equivalents.

winding is energized when voltage is applied between a first pair of said brushes than is energized when voltage is applied between a second pair of said brushes so that said motor will run at a higher speed when energized between said second pair of brushes,

B. *motor control means having first and second conditions* and energizing said motor between said first pair of brushes in said first condition and energizing said motor between said second pair of brushes in said second condition,

C. *said motor control means* in only one of said first and second conditions being operable to energize said motor intermittently to drive said wiper blade through repeated wipe cycles with a dwell period occurring automatically at the end of each of said wipe cycles, and

D. *a switch control movable between first and second positions* to place said motor control means in said first condition or in said second condition.

• • • • •

13. A windshield wiper system as recited in claim 9 wherein

E. *said motor control means comprises a capacitance, a resistance, a circuit* connected to vary the charge on said capacitance by current flowing through said resistance during said dwell period, and *means responsive to the charge on said capacitor reaching a predetermined level* to energize said motor to end said dwell period.

14. A windshield wiper system as recited in claim 13 wherein

F. *said means responsive to the charge in said capacitance reaching a predetermined level* to energize said motor comprises *a solid state electronic valve* connected in a circuit to become conductive when said capacitance reaches said predetermined level and *means responsive to said electronic valve becoming conductive* to energize said motor.[12]

As described by Kearns:

The '790 patent relates to an intermittent windshield wiper system with a two-speed three-brush motor. Claim 14 states that intermittent wiping may be done in only one of the two speeds. It does not state which speed.

Chrysler argues that the function of elements C and D are not identical to the functions performed by the Chrysler system and that the structures of elements B, C, D, E and F are not the same as or equivalent to the structures in the Chrysler system. These contentions were fully explored at trial. The jury found otherwise. The Court agrees with the jury.

1.

Chrysler's argument regarding the function of Element C may be summarized as follows:[13]

Element C requires the following:

[structure] in only one of said first and second conditions being operable to energize said motor intermittently to drive said wiper blades through repeated wipe

---

[12] The Court has used Chrysler's breakout of the elements. It does not differ significantly from Kearns' breakout. The underlined part of each element are the "means" while the balance is the "function."

[13] The summaries of Chrysler's arguments which follow are taken from Chrysler's brief with some editing. Kearns' positions are taken from his brief with some editing.

cycles with a dwell period occurring automatically at the end of reach of said wipe cycles.

Element C should be construed as if it read:

[structure] to energize said motor intermittently using the high speed brush to drive said wiper blades through repeated wipe cycles . . . .

Element C is a reference to the fundamental teaching of the '790 patent that intermittent operation uses only the high-speed brush of the motor for intermittent wiping operations. Throughout the specification, it is established that the patent calls for energizing a two-speed motor through its high-speed brush to carry out wiping operations.

The evidence is undisputed that Chrysler's system does not operate in intermittent mode on the high-speed brush. The Chrysler system runs only on the low-speed brush for intermittent operation, and thus achieves different objectives than what the patent states are its principal advantages.

The claim does not say which of the two speeds the motor is energized to operate in intermittent but that it can only be one of the two speeds.

There is no ambiguity in element C.

There was substantial evidence that element C calls for intermittent in high or low speed but not both. Chrysler's argument would have this Court rewrite element C as well as confine the element to a particular embodiment.

2.

Chrysler's argument regarding the function of Element D may be summarized as follows:

Element D requires, as function, the following:

> [structure] to place said motor control means in said first condition or in said condition.

Element D should be construed as if it read:

> a switch control moveable between OFF and INTERMITTENT positions to place said motor control means in low speed or in high speed, respectively.

Put differently, Element D requires a change of speeds in switching the system from intermittent to off.

The Chrysler system does not change speeds in going from intermittent to off; thus, the Chrysler system does not perform this function. In the Chrysler system, power is applied to the low-speed brush at all times during intermittent operation and when the system is switched off. When the driver selects OFF, the wiper blade continues at low speed to its resting place and is parked. This is fundamentally different from the dual-speed approach disclosed in the '790 patent.

This is a continuation of Chrysler's argument regarding the construction of element C and fails for the same reason as its argument regarding element C.

The switch control is a specific component. There was substantial evidence that it was movable so that it had two modes of operation without confining a particular position to a particular condition, i.e., speed. Chrysler would confine element D to a particular embodiment.

3.

A.

Chrysler's argument regarding the structural differences as to element D may be summarized as follows:

> Structural differences between the switching arrangements required by Element D of the '790 and those of the Chrysler system negate the necessary correspondence for infringement. The '790 patent achieves its switching back and forth between the low-speed brush for parking, the high-speed brush for the intermittent wipe cycle, and the low-speed brush for braking at the end of each wipe cycle through the dwell switch.
>
> At trial, plaintiff did not show how the circuitry of the '790 was similar to Chrysler's, because they are different on their face. The patent requires a switch that simultaneously changes five separate circuits in going from one mode of operation to another. This is hardly the same as the two-segment switch used by Chrysler and its related circuitry. Nor did plaintiff establish that the switches are equivalent. They are not "interchangeable" in any meaningful sense. Apart from the fact that both systems can be used for intermittent operation and that both use a two-speed motor, it is difficult indeed to find structural similarity of any kind.

B.

Chrysler's argument regarding the structural differences as to elements B, C, E, and F may be summarized as follows:

> The structures of Elements B, C, E, and F of claim 14 also are not the same as or the equivalent of corresponding Chrysler structures. Element B is a reference to the entire system disclosed in the '790 patent, less the motor. As such, it contemplates numerous structural features

that are quite different from the Chrysler system. These include the braking resistors needed for automatic skipping of the dwell period when the windshield is wet, a capacitor charging circuit that creates dwell intervals that vary with the length of the preceding wipe cycle, the direct connection of the transistor to the motor needed for motor speed control and variable motor speed in continuous operation, and the use of the transistors for both intermittent and continuous operation.

C.

There was substantial evidence supporting a finding of the same or the equivalent structures as called for by elements B, C, D, E and F in the Chrysler system. Whatever the actual differences between the structures called for by these elements and the structures in the Chrysler system, there is nothing in Chrysler's argument that the differences it argues have any real relevance to the question of infringement.

4.

Chrysler relies on seven pieces of prior art to argue against infringement of the '790 Patent. Each piece, according to Chrysler, utilizes a 2-speed, 3-brush motor, low speed in park, and intermittent and either high or low speed for continuous operation. Nothing more is described as to any piece of prior art.

This argument has three flaws. First, it is a disguised attack on the validity of the '790 Patent. Second, it is conclusionary and lacks substance. Third, it depends in part on evidence not before the jury in the infringement trial.

C. Claim 16 of the '836 Patent

Claim 16 of the '836 patent (which includes claim 12) reads:

12. In a windshield wiper cleaning system,

A. *electric motor driven windshield wiper drive means* for driving wiper blade means across the windshield in repeating wiping cycles, and

B. *automatic control means* for energizing said motor intermittently to produce complete wiping cycles with each wiping cycle followed by a predetermined dwell period, said control means including

C. *transistor switch means* for energizing said motor to initiate a wiping cycle and deenergizing said motor to terminate a wiping cycle,

D. *timing means* to determine said predetermined dwell period, and

E. *switch means responsive to the position of said drive means* for conditioning said timing means to bias said transistor switch means off at the end of each wiping cycle for said predetermined dwell period.

• • • • •

16. The invention as defined in claim 12 wherein said automatic control means includes

F. *manually activated switch means* for selectively connecting said drive means and transistor switch means in a continuous position for continuous operation of the drive means without dwell periods and in an intermittent position for said intermittent operation of said drive means.

As described by Kearns:

> The '836 patent relates to an intermittent windshield wiper system in which the dwell period is synchronized to the position of the wiper blade on the windshield. Claim 16 specifies a system having transistor switch means for energizing and deenergizing the wiper motor, timing means to determine the dwell period and switch means responsive to the wiper motor for conditioning the timing means.

Nothing is stated in the claim about moisture responsiveness. The effort of Chrysler to put moisture responsiveness into the claim in that context flaws the argument at the inception.[14]

Chrysler argues that the functions of elements B, C, E, and F are not identical to the functions performed by the Chrysler system and that the structures of elements C, E and F are not the same as or equivalent to the structures in the Chrysler system. These contentions were fully explored at trial. The jury found otherwise. The Court agrees with the jury.

1.

Chrysler's argument regarding the function of element F may be summarized as follows:

Element F requires, as function, the following:

> [structure] for selectively connecting said drive means [the motor] and transistor switch means in a continuous position for continuous operation of the drive means without dwell periods and in an intermittent position for said intermittent operation of said drive means.

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[14] See discussion at pp. 22–24 and 57–59, *infra*.

Element F should be construed as if it read:

> [structure] for selectively causing the transistors to run the motor continuously for continuous operation or alternatively causing the transistors to run the motor with dwell periods for intermittent operation.

Element F, properly interpreted, requires that the transistors provide power to the motor in continuous operation. The structure described in Element F is the switch, which in the "C" or continuous position connects the motor and transistors in one circuit arrangement for continuous operation and in the "I" or intermittent position connects the same two components in a different circuit arrangement for intermittent operation. Both the transistor and the motor are essential to the operation of the system in either continuous or intermittent mode.

The Chrysler system does not satisfy the functional requirement of Element F. In the Chrysler system, the transistors play no role whatsoever in continuous operations. Continuous operation occurs because the driver-operated switch applies power directly to the motor and bypasses the electronic controller altogether.

Element F functions to manually switch between continuous and intermittent, according to the expert testimony, and does not require a wired connection between the transistors and the motor. According to the expert testimony, Chrysler's system does the same thing and whether the transistors in the Chrysler system are off is of no moment. The jury answered the special question relating to Chrysler's contention as follows:

> Does "selectively connecting said drive means and transistor switch means in a continuous position for continuous operation" in describing the function of the "manually activated switch means" in Claim 16 in-

clude intermittent windshield wiper systems where the transistors are turned off in continuous operation?

X YES

2.

Chrysler's argument regarding the function of element E may be summarized as follows:

Element E requires, as function:

> [structure] for conditioning said timing means to bias said transistor switch means off at the end of each wiping cycle for said predetermined dwell period.

Element E should be construed as if it read:

> [structure] to provide current for charging the capacitor during the wipe cycle, whereby the capacitor voltage will render the transistor fully nonconductive to start the dwell and will keep the transistor nonconductive throughout the dwell period.

Element E properly construed requires (a) that the dwell switch (and not some other component) provide the current to charge the timing capacitor during the wipe cycle, (b) that the timing capacitor (and not some other component) bias off the transistor at the end of the wipe cycle, (c) that the transistor be off during the dwell interval, and (d) that the timing capacitor (and not some other component) hold the transistor off during the dwell period.

The Chrysler system does not contain element E because it performs none of those four functions.

Element E functions to charge the capacitor to a sufficient voltage so that the transistor switch means turns off each time the dwell switch moves to the dwell position, according to the expert testimony. The element does not,

according to the expert testimony, require the charging current pass directly through the switch. Likewise, the expert testimony supports a finding that nothing in the file history is to the contrary. The jury answered the special question relating to this point as follows:

> Does "conditioning said timing means" in Claim 16, include intermittent windshield wiper systems where the charging of the capacitor of the timing circuit is permitted by the position of the dwell switch, but not charged through the dwell switch during each wiping cycle during intermittent operation?
>
> __X__ YES

Chrysler's argument that there must be a direct connection between the capacitor and the transistor was rejected by the jury in its answer to a special question as follows:

> Does "conditioning said timing means to bias said transistor switch means off" in Claim 16 include intermittent windshield wiper systems where the capacitor of the timing circuit is electrically connected to the base of a transistor through a diode?
>
> __X__ YES

Chrysler's argument that the transistor switch means must be reverse biased during the dwell period was contrary to the expert testimony to the effect that all that is necessary is for the transistor switch means to be off. The jury answered a special question as follows:

> Does "to bias said transistor switch means off" in Claim 16 include intermittent windshield wiper systems where the transistor switch means is turned off at the

end of each wiping cycle other than by reverse biasing a transistor?

__X__ YES

Lastly, the expert testimony was contrary to Chrysler's argument that the capacitor, or timing means, holds the transistor switch means off during the entire dwell period. All that is required, according to the expert testimony, is that the capacitor be responsible for turning the transistor switch means off, and that the transistor switch means remain off during the dwell period.

There was substantial evidence to the effect that Chrysler's system performs the function of element E. The expert testimony was to the effect that Chrysler's timing capacitor bias' off the transistor at the start of the dwell period. The jury answered a special question as follows:

> Is the capacitor of the timing circuit in the Chrysler system "conditioned" by the dwell switch to permit the capacitor to charge during each wiping cycle as described by Claim 16?

__X__ YES

As to the presence of the diode in the Chrysler circuit between the capacitor and the transistor, the expert testimony was to the effect it was of no moment. The jury answered a special question as follows:

> Is the connection between the capacitor and the transistor in the Chrysler system the same or equivalent to the connection between the capacitor and the transistor described in the patent?

__X__ YES

The expert testimony was to the effect that in the Chrysler system there is a transistor that is biased off

because it can no longer carry the current necessary to hold the relay in an active position so the motor no longer has sufficient current to run. This means the Chrysler circuit includes the same function as called for in the claim. The expert testimony was to the effect that any leakage through the transistor made no difference.

3.

Chrysler's argument regarding the function of element C may be summarized as follows:

Element C requires as follows:

> [structure] for energizing said motor to initiate a wiping cycle and deenergizing said motor to terminate a wiping cycle.

Element C should be construed as if it read:

> [structure] for providing current to energize said motor to initiate a wiping cycle and blocking said current to deenergize said motor to terminate a wiping cycle.

Element C, properly construed, requires a direct connection between the transistor and the motor of the '836 patent. Otherwise, the claim language "for energizing said motor" would be superfluous. Moreover, several important features of the '836 patent would be inoperative without the direct connection.

The Chrysler system does not use transistors to energize and deenergize the motor. In intermittent operation, Chrysler's transistors are used to energize and deenergize a relay, which in turn controls the motor. In continuous operation, the Chrysler transistors and relay have no function whatever in controlling the motor.

Element C functions to energize and deenergize the motor on each wipe cycle. This element is certainly not ambiguous. Chrysler's argument that there cannot be a relay

between the transistors and the motor depends on a preferred embodiment overriding the language of the claim element according to the expert testimony which, of course, flaws the argument. Chrysler's heavy dependence on the relay in its system to defeat a finding of identity of function (in reality arguing against equivalent structure) is contrary to the expert testimony and the jury's answer to a special question as follows:

> Does "transistor switch means" in Claim 16 include, as of 1977, intermittent windshield wiper systems which has a relay and transistors?
>
> __X__ YES

4.

Chrysler's argument regarding the function of element B may be summarized as follows:

Element B requires as follows:

> automatic control means for energizing said motor intermittently to produce complete wiping cycles with each wiping cycle followed by a predetermined dwell period.

Element B should be construed as if it read:

> control means for energizing said motor intermittently to produce complete wipe cycles with each wiping cycle followed by a predetermined dwell period, configured so that the system can be adjusted to skip the dwell period automatically when the windshield is wet.

The structure in Element B is a reference to the entire system depicted in Claim 16, less the motor. It encompasses the timing circuit, transistors, braking resistors, dwell switch and driver control switch. The term "automatic control" in Element B may be construed only as a

reference to the dwell-skipping, moisture responsive nature of the '836 system.

The word "automatic" was used numerous times throughout the specification to describe this feature, whereby the braking resistors could be adjusted so that the wiper blades would coast past their normal stopping position when the windshield was wet, and would cause the dwell switch to reinitiate a wipe cycle without a full dwell period. A fair reading of the '836 patent specification from top to bottom leaves little doubt that a moisture responsive system was what plaintiff invented and filed his patent to protect.

The evidence is undisputed that the Chrysler system is wholly incapable of the "dwell skipping" function called for in Element B and is thus incapable of "automatic" operation in the context of the patent. Accordingly, the identical function required by section 112(6) is missing and the '836 patent is not infringed.

According to the expert testimony, element B specifies the function of automatically energizing the wiper motor intermittently, with a dwell period between wipes. According to the expert testimony, the dwell period need not be related to the length of the preceding wipe cycle, braking resistors are not used, and there is no moisture responsiveness. These features are found in a particular embodiment. The jury so found when it answered a special question as follows:

> Does "automatic control means" in Claim 16 include intermittent windshield wiper systems where the length of each dwell period may be set by the driver so as not to vary with the length of the preceding wiping cycle?
>
> __X__ YES

According to the expert testimony, the Chrysler system energized the wiper motor intermittently with the dwell period between wipes.

5.

Chrysler's argument regarding Element F's switch means may be summarized as follows:

> Chrysler's driver-controlled switch is neither the same as nor the equivalent of the three-segment switch disclosed in the '836 patent. Chrysler's driver-controlled switch is a two-segment switch, half of which bypasses the electronics and connects battery voltage directly to the appropriate brushes of the motor for continuous operation and for parking, the other half of which supplies power to the electronics module for intermittent wiping but does not interact with that module. The switch means as claimed must be part of the automatic control means that is necessary to add breaking resistors to the system for intermittent operation. Chrysler has no counterpart at all to that portion of the driver-operated switch in the '836 patent that switches the brake resistors in and out of the circuit. Facially, the Chrysler switch is not the same as the three-segment switch that plaintiff used in the '836 patent.
>
> Nor are the switches equivalent. Certainly the Chrysler switch was not shown to be interchangeable with the switch of the '836. The record reflects no substantial evidence that the Chrysler driver control switch connects the motor voltage to the base of the transistors in continuous operation. Chrysler does not even use transistors for continuous operation. Chrysler's driver-controlled switch plays no part at all in braking during intermittent operation, as is the case in the '836 patent; that braking function is performed by a relay in the Chrysler system. Accordingly, Chrysler has no structure that corresponds

to switch segments #132, #130 and #134; and there is no infringement.

The jury answered a special question as follows:

> Is the driver control switch in the Chrysler system the same or equivalent to the manually operated switch described by the '836 patent?
>
> X YES

According to the expert testimony, the "by-pass feature" of the Chrysler manual switch, i.e., that the switch is not involved with braking during intermittent, is only a feature not found in the claim. This was substantial evidence to support the answer to the special question.

6.

Chrysler's argument regarding Element E's *switch means responsive to the position of said drive means* may be summarized as follows:

> The '836 patent discloses a double-pole, double-throw switch that, among other things is also necessary to carry out the braking function associated with the moisture responsive features of the patent. In the Chrysler A system, by contrast, the dwell switch is a single-pole, single-throw switch that merely places ground on the left hand side of the capacitor during dwell and removes it during run. In the Chrysler B system, the dwell switch is a single-pole, double-throw switch that switches the left hand side of the capacitor from ground (during dwell) to battery (during run) and back to ground, but which has no counterpart in the braking feature needed for the '836.
>
> Further, the structure of Chrysler's timing circuit, which carries out the functions of element E, is different from that of the patent. For all of the reasons that the functions are different, the structure needed to provide

those functions is equally different. The timing capacitor charges far more quickly and through a separate charging path than that of the '836, and a diode isolates the transistor from the capacitor. The transistor in Chrysler is controlled by a circuit producing about a one volt peak-to-peak variation in base voltage that never turns the transistor off as the system cycles, whereas the transistor control in the '836 is at full battery voltage and turns the transistor off very hard.

The expert testimony was to the contrary. Again, Chrysler, according to the expert testimony, relies on features not required by the claim. Again, the jury answered a special question as follows:

> Is the dwell switch in the Chrysler system the same or the equivalent to the dwell switch described by the patent?
>
> __X__ YES

7.

Chrysler's argument regarding Element B's *automatic control means* may be summarized as follows:

> Chrysler uses a dead short to brake the motor instantaneously, whereas the system taught by the patent will not work with such a configuration. Chrysler uses a timing circuit that charges rapidly through a path independent of the dwell switch, whereas the patent teaches a timing circuit that charges slowly through the dwell switch. Chrysler uses a simple system that operates in the continuous mode and park mode independently of the transistorized module, whereas the patent discloses a system in which the transistors are essential for park, continuous and intermittent. Chrysler switches its motor with a relay, whereas the patent discloses a system in which a relay

cannot be substituted if the system is to carry out its disclosed purposes.

These are not minor points of difference but instead go to the essence of what is disclosed. The systems are certainly not the same, certainly not interchangeable, and are therefore not "equivalent" in any meaningful sense. Plaintiff had a duty to establish "equivalence" with more than conclusory statements to that effect by his expert. The fact that both systems involve intermittent windshield wiper systems is a feature they have in common with considerable prior art and that cannot establish equivalence.

The jury answered special questions as follows:

> Is the dead short braking in the Chrysler system the equivalent of the resistor braking described by the '836 patent?
>
> __X__ YES
>
> Does the Chrysler system have a control device that provides a "predetermined dwell period" in intermittent operation as described by Claim 16?
>
> __X__ YES

These answers were consistent with the expert testimony. Chrysler's different structure, because of a different timing circuit, relay, and motor braking, are not, according to the expert testimony, contrary to the requirements of the claim and have no relationship to the claim language.

Again, the prior art cited by Chrysler to defeat the jury's finding of infringement of the '836 patent is of no moment. Chrysler has made no effort to support a finding by the Court that Claim 16 as it reads on the Chrysler circuit, according to the expert testimony and the jury's answers to the special questions, might also read on the prior art.

Chrysler's repeated efforts to contest its agreement to follow the finding in *Kearns v. Ford* on validity in the guise of arguing non-infringement has been a detriment to the Court's ability to assess the merits of its argument for a judgment as a matter of law.

D. Claim 6 of the '374 Patent

Claim 6 of the '374 patent (which includes claim 3 and claim 5) reads:

> 3. A control device for activating motor driven windshield wiper drive means for driving wiper blades across a windshield in repeating wiping cycles comprising:
>
> A. (1) *a timing circuit* for determining repeated spaced time intervals comprising *a capacitance, a resistance, and circuit means* to charge said capacitance between said time intervals to provide a voltage across said capacitance at the start of each of said intervals and to connect said resistance to one side of said capacitance in an RC circuit during said intervals, said circuit jumping the potential applied to the other side of said capacitance at the start of each of said intervals in a direction to increase the voltage across said resistance, said circuit means terminating said intervals when the voltage across said resistance drops to a predetermined level, and
>
> B. (2) *activating means including said timing circuit* for activating said drive means intermittently to provide dwell periods between successive wiping cycles, said activating means terminating each dwell period to initiate a wiping cycle when the circuit means terminates a time interval determined by said timing circuit.
>
> 5. A control device as recited in claim 3 wherein

C. *said circuit means includes an electronic valve having a first conductive condition and a second conductive condition*, said circuit means connecting said electronic valve to said resistance during said intervals in a manner to switch said electronic valve from said first condition to said second condition to terminate each of said intervals in response to the voltage across said resistance dropping to said predetermined level.

6. A control device as recited in claim 5 wherein

D. *said circuit means includes a DC source*, wherein the switching of said electronic valve from said first condition to said second condition is in response to the voltage between a pair of electrodes of said electronic valve having a predetermined polarity and reaching a predetermined level, and wherein during said intervals said circuit means connects said resistance between said one side of said capacitance and one side of said DC source, connects one of said electrodes to the other side of said DC source, and connects the other one of said electrodes to said resistance, whereby the voltage between said electrodes will reach the predetermined level with said predetermined polarity to cause said electronic valve to switch from said first condition to said second condition when the voltage across said resistance drops to the predetermined level at which said circuit means terminates said intervals.

As described by Kearns:

The '374 patent relates to an intermittent windshield wiper system like that of the '836 patent; it has the same specifications. Claim 6, particularly, relates to a system in

which the RC timing circuit[15] which governs the length of the dwell period has a "voltage jumping"[16] feature.

Chrysler argues that the function of elements A and D are not identical to the functions performed by the Chrysler system and that the structures of elements A, B, C, and D are not the same as or equivalent to the structures used in the Chrysler system. These contentions were fully explored at trial. The jury found otherwise. The Court agrees with the jury.

1.

Chrysler's argument regarding the function of element A may be summarized as follows:

> Element A requires, among other things, the following function:
>
> > [Structure] to charge said capacitance between said [dwell] intervals . . . .
>
> The foregoing portion of Element A should be construed to read, in pertinent part:
>
> > [structure] to charge said capacitance in a manner so as to prolong charging throughout the full duration of the wipe cycle . . . .

---

[15] The glossary defines "RC timing circuit" as follows:

> Resistor-capacitor circuit. A circuit element consisting of one or more resistors and capacitors which is used to time things such as the dwell period in an intermittent windshield wiper circuit, usually based on the amount of time it takes a capacitor to charge or discharge through a resistor to a desired voltage.

[16] The glossary defines "voltage jumping" as follows:

> An electrical circuit in which one side of a capacitor is connected to a source of electrical voltage input and then suddenly switched in such a manner that the electrical voltage on the other side of the capacitor is forced to make a similar change.

The '374 patent discloses a system in which the charging of the capacitor during the wipe cycle begins after three other events have occurred — first, the motor has begun to move; second, the moveable portion of the dwell switch has moved off of its initial ground contact; and third, the moveable portion of the dwell switch has completed its travel to contact #78 which connects the negative pole of the battery to the time capacitor. Until contact is made to the negative pole of the battery, charging does not commence.

Chrysler's system charges the capacitor during an almost mutually exclusive portion of the wipe cycle from that of the patent. In the Chrysler system, charging of the capacitor begins immediately upon the initial movement of the dwell switch off of the ground contact, when the motor just begins to move, and occurs at a very high speed. In Chrysler, charging is 80% to 90% complete by the time charging commences in the system taught by the '374 patent. Chrysler designed its system intentionally to charge the capacitor rapidly, which assures among other things that the dwell period does not vary with the time of the previous wipe, an intrinsic feature of the '374 circuits.

Element A calls for charging the capacitor during the wiping period and not necessarily during the whole of the period, according to the expert testimony. The jury answered a special question on the point as follows:

> Does to charge said capacitance between said time intervals in Claim 6 include intermittent windshield wiper systems where the capacitor of the timing circuit is charged during part of the wiping cycle?
>
> __X__ YES

The expert testimony was to the effect that the charging function as called for by the claim was to be found in the

Chrysler system. The jury agreed when it answered a special question as follows:

> In the Chrysler system is the capacitor charged between dwell periods during intermittent operations as described "by to charge said capacitance between time intervals" in Claim 6?
>
> X YES

The fact that Chrysler's capacitor charges more rapidly, and not throughout the wiping cycle, does not negate a finding that it performs the same function as called for by the claim element.

2.

Chrysler's argument regarding the function of Element D may be summarized as follows:

Element D requires as follows:

> said circuit means includes a [battery] wherein the switching of said [transistors] from said first condition [off] to said second condition [on] is in response to the voltage between a pair of electrodes of said electronic valve having a predetermined polarity and reaching a predetermined level, and wherein *during said [dwell] intervals said circuit means* connects said resistance between one side of said capacitance and one side of said [battery] connects one of said electrodes to the other side of [battery], *and connects the other of said electrodes to said resistance*, whereby the voltage between said electrodes will reach the predetermined level with said predetermined polarity to cause said electronic valve to switch from said first condition (off) to said second condition (on) when the voltage across said resistance drops to the predetermined level at which said circuit means terminates the intervals.

The language underscored requires that the timing resistance be "connected" to the transistor during the dwell interval, as shown in Figure 4 of the '374 patent. This is an essential feature of the '374 design, because the capacitor voltage is used to hold the transistor off throughout the dwell period.

The Chrysler timing resistance is not "connected" to the transistor during the bulk of the dwell interval; an isolation diode separates those two components electrically until the timing capacitor has reached a voltage which begins to turn on the transistor.

The function of element D, according to the expert testimony, is to connect the transistor to the timing circuit to facilitate switching the transistor on at the end of the dwell period. The expert testimony was to the effect that a direct connection is not required. The jury answered a special question as follows:

> Does said circuit means connecting said electronic valve to said resistance in Claim 6 include intermittent windshield system where the base of the transistor is connected to the resistor of the timing circuit through a diode?
>
> X YES

The expert testimony was to the effect that Chrysler's circuit performs the connecting function specified in Element D. The presence of the diode in the Chrysler circuit is not relevant to the claim of infringement since it is not required by Element D. Again, the jury answered a special question, contrary to Chrysler's argument, as follows:

> Are the transistors of the Chrysler system electrically connecting the resistance as described by "said circuit means connecting said electronic valve to said resistance during said intervals in a manner to switch said

electronic valve from said first condition to said second condition to terminate each of said intervals in response to the voltage across said resistance dropping to said predetermined level" in Claim 6?

___X___ YES

3.

The jury's verdict established that Chrysler's structure is the same as or equivalent to that called for by Claim 6 and the expert testimony at trial was to that effect. Chrysler's argument does not support a contrary view.

4.

Again, Chrysler cites prior art in support of its argument to defeat infringement and again it fails to show how claim 6 as read on its circuit also reads on the prior art.

III. New Trial — Infringement

A. Introduction

Chrysler asserts a variety of grounds in moving for a new trial. These include misstated instructions and ill formed special questions, improper evidentiary rulings, and too much judicial generosity regarding rebuttal argument and none regarding the request for surrebuttal argument. In discussing these grounds and finding that they lack merit, the Court is much moved by the contentiousness of the infringement trial and the resolute failure of the parties to cooperate. Particularly egregious with regard to Chrysler's faulting the Court's rulings in both trials is Chrysler's failure to pay even lip service to Fed. R. Civ. P. 61 which reads:

> No error in either the admission or the exclusion of evidence and no error or defect in any ruling or order or in anything done or omitted by the court or by any of the parties is ground for granting a new trial or for setting

aside a verdict or for vacating, modifying, or otherwise disturbing a judgment or order, unless refusal to take such action appears to the court inconsistent with substantial justice. The court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties.

Also vexing was the particular inability of the parties to come close to agreement on the instructions and special questions. The law is not so uncertain as to have allowed for the difficulty the Court encountered in its effort to obtain agreement on the instructions and special questions. Some description of that difficulty is in order.

In Pre-Trial Order No. 1, entered February 21, 1991, the procedure to be followed prior to consideration by the Court in preparing jury instructions and resolving differences between the parties was explicitly described. That order stated in part:

A. Plaintiff shall serve defendant with a draft of the Order [Final Pre-Trial Order] in accordance with the requirements of this order, accompanied by a draft of proposed jury instructions, including plaintiff's theory of the case if appropriate, by June 10, 1991.

B. Defendant shall respond with additions, deletions or modifications to plaintiff's draft of the order accompanied by additions, deletions or modifications to plaintiff's draft of proposed jury instructions together with defendant's theory of the case if appropriate, by June 20, 1991.

C. Each proposed jury instruction shall be on a separate page. If a pattern instruction is requested a copy of the instruction shall be included; reference to the number is not sufficient. The parties shall work toward agreement on jury instructions so that the

need for the Court to resolve instructions is minimized.

On July 2, 1991, Kearns filed proposed jury instructions on liability. On July 3, 1991, Chrysler filed proposed jury instructions on liability. On August 27, 1991, Chrysler again filed proposed instructions on liability. What followed is not clear to the Court, i.e., the extent to which the parties met in an endeavor to resolve their differences. During the week of November 11, 1991, it appears there were attempts by the parties to resolve their differences and drafts of jury instructions exchanged.

The parties rested on Tuesday, November 19, 1991. The jury was told to come back Thursday, November 21, 1991, for final argument and instructions preliminary to their deliberations. However, Wednesday, November 20, 1991, and Thursday, November 21, 1991, were needed to resolve a number of outstanding matters necessary for decision before the Court could turn its attention to the jury instructions and special questions. As to special questions, the Court had made clear the need for them in keeping with the admonition in *Structural Rubber Products Company v. Park Rubber Company*, 749 F.2d 707, 720 (Fed. Cir. 1984) ("This court has counselled district courts in appeals to us that specific answers from the jury on factual issues are desirable.")

On Wednesday, November 20, 1991, the Court discussed with the parties the exhibits which had been admitted and would be given to the jury during deliberations. There was strong disagreement as to which exhibits were part of the trial record. This dispute was not resolved until the following day. The Court also had to decide once and for all on Kearns' right to assert infringement by the Doctrine of

Equivalents,[17] a matter the Court had previously decided against Kearns based on a representation that he claimed only literal infringement. The Court denied Kearns' motion for reconsideration. (Tr. 11/20/91, p. 4026)[18] In addition, the Court considered and denied motions for directed verdict by both parties. (Tr. 11/20/91, p. 4029) Finally, the Court discussed with the parties the contents of the juror notebooks (Tr. 11/20/91, p. 4030).[19]

On Thursday, November 21, 1991, the Court continued the discussion on admitted exhibits and the contents of the jurors' notebooks. Finally, on Thursday the Court was able to address the matter of instructions and special questions. The parties were at loggerheads and indeed, had not fully reviewed each others' drafts. (Tr. 11/21/91, pp. 4056-57) The Court's frustration with the lawyers was such that it was constrained to make a statement as follows (Tr. 11/21/91, pp. 4058-60):

> It's 3:30 on Thursday, November 21. The proofs concluded in this case Tuesday afternoon, November 19. The parties have been struggling for two days to arrive at proper jury questions, . . . , jury instructions and the general verdict form. The problem with the instructions had been a nagging one in this case since the beginning.
>
> The joint pre-trial statement envisioned that there would be an exchange and agreement prior to the commencement of trial, since the rules of law that the jury

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[17] Initially Kearns disavowed any claims of infringement under the Doctrine of Equivalents (Tr. 9/12/91, pp. 14-15) and then exerted almost as much effort to get out of the disavowal as did Chrysler to get out of its stipulation on validity.

[18] In Parts III and IV the Court is citing to the record because of the importance of the record to a proper understanding of the Court's rulings.

[19] See discussion at pp. 59-60, *infra*.

was going to be instructed on could be followed during the course of trial. This did not happen.

The Court is reasonably satisfied that it will not be able to determine who is at fault. It's likely that Defendant was over resourced in the case and Plaintiff was under resourced, and Plaintiff's limited resources were being devoted to preparing for trial each day.

In any event, the Court can't decide who is right and who is wrong.

We have gone through the instructions. The Court has made some rather arbitrary decisions only because the Court has only so much time, and we feel we have to get to the jury tomorrow morning at 9 o'clock. We have now got a set of instructions. The Plaintiff has furnished the Court with a series of special questions which it feels reasonably illuminates the underlying factors that go to make up the jury's verdict. The Court is satisfied that the format and general tenor of Plaintiff's questions are satisfactory.

The Defendant has submitted about 60 pages which is a combination of Defendant's version and Plaintiff's version. The Court is not in a position to go through these question-by-question. It would take hours in the Court's view. Therefore, the defense can submit a set of special questions tomorrow morning that it thinks appropriate. The Court will choose between Plaintiff's and Defendant's, and that will be the end of the matter. The Court will not exercise any effort in the future to obtain agreement. The Court may well decide to submit both sets to the jury and just let the jury struggle with them.

The Court doesn't have any choice in the matter. My resources are limited. It doesn't have the kind of technical assistance, nor does it have a grasp of the record sufficient to enable it to sit here and negotiate with the parties as to

the proper form of the special questions. So there will be no special questions or the Court will submit both parties' set of special questions. The Court will choose one or the other. The Court will do that tomorrow morning at 8:30.

You're on your own. It's your case.

The parties were given a complete set of the instructions the end of the day Thursday, November 21, 1991, so that they could make their final arguments in light of the law the jury was to apply. The jury heard final arguments and was instructed on Friday, November 22, 1991. Following dismissal of the jury for the day, the Court took up the parties' objections to the instructions. (Tr. 11/21/91, pp. 4273-79) Kearns placed his objections on the record. Chrysler relied on exceptions filed that day. These exceptions, while specific as to what Chrysler believed incorrect in the instructions, did not contain alternative text. The Court was again constrained to make a statement as follows (Tr. 11/22/91, pp. 4275-76):

In the Pre-Trial Order entered February 21, 1991, the Court explicitly laid out the manner in which the jury instructions were to be drafted, exchanged and resolved.

As of this morning at 8 o'clock, which is November 22, 1991, after, by the Court's count, some 28 days of trial, the parties have still failed to present jury instructions in the form as required by the Court's pre-trial order. Indeed, they failed to give the Court detailed, word-for-word proposed instructions in lieu of those that the Court was dealing with.

With regard to Plaintiff's objections to claim interpretation, the record should reflect that only last week did the Plaintiff, for the first time, furnish the Court with what it believed to be the proper interpretation of the claims as argued in *Kearns v. Ford Motor Company*, and even then did not explicitly particularize the claim interpretation

with extracts from the record which would support the interpretation directly.

The Court unfortunately was obligated to fly alone on the instructions for the most part while the parties gave it substantial assistance. The Court is satisfied that the instructions reasonably reflect the law applicable to the issues, and the jury has been properly instructed and we now can go on to the exhibit list.

Over the weekend of November 23-24, 1991, the Court discussed with the parties the form of the special questions and at the beginning of court on Monday, November 25, 1991, went through with the jury the contents of their notebooks, directing them to remove anything that had not been agreed upon the previous week. Because of the confusion over which exhibits had been admitted, the Court had a concern that a juror may have inadvertently retained an exhibit not admitted. The jury was given a list of all the exhibits which had been admitted. These exhibits were available during deliberations on request. (Tr. 11/25/91, pp. 4287-88)

Following the correlation of the exhibit books, the special questions were read to the jury. (Tr. 11/25/91, pp. 4289-4302) Because of the manner in which the special questions had been drafted and considered, as described above because of the inability of the parties to agree, the Court decided not to submit special questions and then *sua sponte* reconsidered, drafted the questions and went over them with the parties before the opening of court). Following the reading of the special questions to the jury the Court made a statement (Tr. 11/25/91, p. 4303):

[I]f you think that the text of any of those questions can be improved on reflection during the day, I'm quite willing to bring them back and give them a revised form of text. This was all done rather hurriedly this morning.

So, if you will agree, I will be delighted to do so, okay.

Chrysler relied on exceptions filed that morning to memorialize its exceptions which were general in form and did not deal with any particular question or offer alternative text. For the third time the Court was constrained to make a statement. (Tr. 11/25/91, pp. 4305-07)

The record should reflect that early on in this case, the Court indicated that the appropriateness, consistent with the precedent from the Federal Circuit to ask that special questions of the jury, along with a general verdict to test whether or not the jury had made the requisite subsidiary finding to support a general verdict of either infringement or non-infringement. And in this case, the doctrine — the reverse doctrine of equivalence.

The parties apparently had great difficulty in agreeing on special questions, and continued to submit to the Court their respective versions, presumably expecting the Court to harmonize or rule on the differences of the versions.

Today is Monday morning. The jury was instructed late Friday. Saturday afternoon the Court met with the parties in an effort to further harmonize their respective versions. And it appeared that there was no way that any kind of harmony could be reached.

For example, the parties, even at that late hour, could not agree whether the word "cover" should be used, or the word "include" should be used in the Special Questions. Notwithstanding the fact that in the instructions both words were used to mean the same thing.

The Court at the conclusion of that informal conference, conceded to the wishes of the parties and decided not to ask the special questions except under the reverse doctrine of equivalence, but later in the afternoon reflected on the importance of those Special Questions, and over the weekend attempted to harmonize the two sets as

best the Court could with its limited understanding at this point of the nuances and subtleties of their respective versions. And not knowing whether their respective versions were put forth in good faith, or in an effort to sabotage the jury's deliberations.

Without casting aspersions on either party, but there's obviously multiple agendas that have been at work in this case right from the beginning, and the Court is generally the last to know.

In any event, the Court advised the parties over the weekend of its efforts, and we met early this morning, and the Court gave them the Court's work product, and as best we could, we went over it, attempted to correct some typographical errors, some technical misunderstandings, since it was imperative that the material be given to the jury this morning so they could begin their deliberations.

And what the jury now has and what is reflected in the record is a result of that process.

The Court remains open, if the parties can come to an agreement, to correct typographical errors in the text, to correct phraseology in the text, indeed, even to delete or modify the language of these questions, and to so instruct the jury.

But, absent any agreement of the parties, the die is now cast, the text is fixed, and whatever happens, happens.

There's always the likelihood that the jury will ask the Court questions, which will allow further explanation on the questions the Court has asked of the jury. But, I think we all have to remember that there are four or five cases yet to follow this one, and it's to be hoped that this experience will not have to be replicated.

B. The Instructions[20]

1.

Fed. R. Civ. P. 51 reads:

> At the close of the evidence or at such earlier time during the trial as the court reasonably directs, any party may file written requests that the court instruct the jury on the law as set forth in the requests. The court shall inform counsel of its proposed action upon the requests prior to their arguments to the jury. The court, at its election, may instruct the jury before or after argument, or both. No party may assign as error the giving or the failure to give an instruction unless that party objects thereto before the jury retires to consider its verdict, stating distinctly the matter objected to and the grounds of the objection. Opportunity shall be given to make the objection out of the hearing of the jury.

2.

Chrysler takes exception to the instruction regarding the steps the jury was to follow in deciding on literal infringement of the means-plus-function claim. The instruction read as follows. (Tr. 11/22/91, pp. 4264-67)

> In considering literal infringement of means-plus-function claim elements in a claim, you do the following:
>
> First, identify the structure in the patent specification that performs the function stated in the means-plus-function claim elements as I previously said you should do in interpreting the claims without considering the Chrysler system.

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[20] In both trials during deliberations the jury had the written text as well as a cassette recording of the instructions.

Second, identify the structural components in the Chrysler system that are performing the same or identical function of the means-plus-function claim element. If the structural components you identify in the Chrysler system are also performing additional functions not called for by the claim element, you ignore those additional functions. If you find that the structural components you identify in the Chrysler system are performing the same or identical functions as stated in the claim, but are performing that function in a manner better or worse than described in the claim, there is still identity of function for purposes of infringement.

If you find a structure in the Chrysler system that performs the same function of the means-plus-function claim element, you compare the structure of the Chrysler system performing the function stated in the claim with the structural components listed in the patent specifications that perform the claim function. This is the structure identified in the claim interpretation I mentioned a moment ago.

In this comparison, you should be careful to compare only the structural components in the Chrysler system performing the function stated in the claim with the structural components described in the patent specification as performing the function stated in the claim. Do not read into the claim any additional function or functions not stated by the claim element that may be performed by the structural component in the patent specification.

Finally, compare the structural component identified in the Chrysler system with the structural component identified in the patent specification to see if they are the same or equivalent. In making this comparison, it is not necessary that the structural components in the Chrysler system and in the patent be exactly the same and are directly interchangeable. *It is sufficient for this comparison that*

the structural components of the Chrysler system and of patent have enough in common that they perform the function stated in the claim in substantially the same way to achieve substantially the same result.

In this comparison, you can also take into account what was known in the art by the time the infringement occurred, including the disclosure in another of the patents-in-suit where the equivalents of the structural components used by Chrysler may be described. It is not required that the equivalent structure be known in the art at the time the patent application was filed, or at the time the patent issued. The question of equivalence of structure is determined as of the time the infringement took place.

If the structural components are found to be equivalent by this comparison, the means-plus-function claim element is found to be in the Chrysler system for purposes of literal infringement. (emphasis added)

Focusing on the underlined portion, Chrysler argues that the Court told the jury equivalency of function was sufficient and thus infected the test for literal infringement because it related function as used in Section 112, sixth paragraph, with the Doctrine of Equivalents. See *Valmot Industries, Inc. v. Reinke Manufacturing Co., Inc.*, 983 F.2d 1039 (Fed. Cir. 1993). While the instruction could have been more explicit,[21] Chrysler is wrong. Chrysler misreads the instruction. The Court did not tell the jury equivalency of function was sufficient. Fairly read, the instruction is telling the jury

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[21] Interestingly, there is no model instruction which carefully separates "equivalents" under § 112, sixth paragraph, and "equivalents" under the Doctrine of Equivalents. See AIPLA Guide To Jury Instructions In Patent Cases (1990), p. 13; ABA Section of Patent, Trademark And Copyright Law, 1988 Committee Reports, pp. 213-231, and particularly pp. 225-226; and Burton, Jury Instructions In Intellectual Property Cases.

equivalency of structure is sufficient. As stated in 35 U.S.C. § 112, sixth paragraph, "the corresponding structure ... described in the specifications and *equivalents thereof.*" (emphasis added). There was no prejudice to Chrysler sufficient to warrant a new trial.[22]

3.

Chrysler, without restating the instruction or making reference to the transcript page or particular language, takes exception to "Instructions Nos. 14, 15, 17, 25, 28, 29 and 36." As a consequence the Court is at a considerable disadvantage. The Court in dealing with instructions told the lawyers when objecting to an instruction to state which particular words should be added, deleted or modified, and to offer substitute words, etc. Chrysler does not do this in its argument but seems to be saying that the order or emphasis in these instructions was incorrect. Since the Court of Appeals for the Federal Circuit has not given its imprimatur to a set of standard instructions for patent cases, disagreement as to order and emphasis offers no grounds for claiming prejudice sufficient to warrant a new trial.

4.

Chrysler takes exception to portions of the following instructions (Tr. 11/22/91, pp. 4259-61):

> Now let me go into more detail as to what the specification of the patent is and how you can use it in interpreting words of the claims. The specification as you heard is a written description of the invention and how to make

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[22] The Court's findings in Part II, *supra*, should obviate any error in the instruction. Also, speaking more generally, and in light of the circumstances under which the instructions were drafted, the Court does not believe any error in the instructions is fundamental or that a new trial is necessary to avoid great injustice. *Ivac Corp. v. Terumo Corp.*, 15 USPQ2d 1456, 1457 (Fed. Cir. 1990) (unpublished).

and use it, in such full, clear, concise and exact terms as to enable any person of ordinary skill in the art to make and use the invention. The specification also describes the best mode or modes contemplated by the inventor of carrying out the invention. The latter are called the preferred embodiments. However, preferred embodiments and other descriptions in the specification of the claimed invention are not read into the claims to add limitations to the claims. There is no requirement that the specification describe all embodiments, or include any commercial embodiment at all. Therefore, you cannot read limitations from the specifications into the claims to avoid infringement, except as you consider the specifications to identify the means portion of a claim element.

With respect to the one sentence object paragraphs that you find in the specifications, you should note that stating the object of an invention is not a requirement of the law, and that there is no requirement in the law that the accused system respond to any of the objects stated in order to infringe. As I have told you before, it is the claims of the patent that measure the patented invention, and it is only the claims that can be infringed.

As I said, the prosecution history also may be relevant in determining the meaning of words in patent claims. If Dr. Kearns, or his attorneys on behalf, made statements about the claims or amendments after the application was filed in obtaining the patent, these amendments can be used to understand the claims in the issued patent. These statements and amendments made in the U.S. Patent and Trademark Office may be used in favor of the patentee as well as against him in interpreting wording in the patent claims. Absent some special meaning given to the words of the claim in the prosecution history, the words of the claims are to be given their broadest reasonable interpretation.

These instructions were preceded by instructions which read (Tr. 11/22/91, pp. 4255-59):

> Some of the terms I will go over with you now will be familiar; others may be less familiar. The first familiar term is "claims." Claims, you may remember, are the numbered paragraphs which are at the end of the patent. The claims of a patent are "word pictures" which define the boundaries of the patented invention. They provide a legal definition of the invention. Beyond those boundaries, the patent owner has no rights.
>
> It is only claims of the patent that can be infringed. Neither the specification nor the drawings can be infringed. However, the specification and drawings can be used to help explain the meaning of words used in the claims.
>
> • • •
>
> Each of the claims used the transitional phrase "comprising." "Comprising" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended. As such the claims are not limited to only the components recited in the claims. Based on this explanation if you find that Chrysler's systems include all of the components in any one of the patent claims and, in addition, Chrysler's systems include additional components, Chrysler's systems still infringe such claim or claims. The presence of additional components in Chrysler's systems does not mean that the systems do not infringe.
>
> The particular claims at issue are found at Tabs 6 and 7 of your notebooks. The parties have divided the claims into elements. This is primarily for the purpose of making it easier for everyone to refer to specific parts of a claim. The parties have differed on how they divided the claim

language into elements. You are not bound by any particular division into elements. This is a common sense matter so that we can deal with the claim language with more precision. It is the words of the claim that are important to your consideration.

• • •

I have just talked about the fact that every word in a claim is important, and that the limitations of a claim depend on the words that are used. This means it may be necessary for you to decide what particular words mean in interpreting and applying a claim. I am going to explain how you can do that.

I am going to list the things you can use in determining the meaning of words in a claim. Then I will explain in more detail how you should use each of these sources for interpretation. The order in which I discuss these is not intended to suggest the order you should consider them, or their relative importance.

First, you may use the ordinary everyday meaning of words unless that ordinary meaning has been replaced by some special meaning in the patent.

Second, you may look at the way words are used in the other parts of the patent itself: (a) you may use the specification and drawings; and (b) you may use other claims within the patent that were called to your attention.

Third, you may also look at what is in the U.S. Patent Office file on the patent, which is called a "file history" or "file wrapper."

Fourth, you may also consider the way the words in the claims were explained in the expert testimony.

Fifth, you may look at evidence about what is called prior art.

Chrysler says that the Court was too generous with the latitude allowed the jury with regard to the limitations in assessing the means of a means-plus-function claim that arise from the specifications and prosecution history. In making this argument Chrysler ignores the context of these instructions. At this point the Court was discussing general rules of claim interpretation and had not yet focused on the particulars of a means-plus-function claim. Thereafter the Court instructed the jury as follows (Tr. 11/22/91, pp. 4261-63):

> Certain elements or components in the patents are stated as "means-plus-function" claim elements. The "means-plus-function" claim elements are identified by the use of the words "means for" or "means to" as part of the claim element. A "means-plus-function" claim element defines part of the structure of the invention as a "means" for performing a certain function, thus conveying the concept that the component must be present to accomplish that function.
>
> In interpreting means-plus-function claim elements, you should identify the "function" of the claim element as stated in the claim. If the words in the claim function are plain, there is no need to refer to the specification; but if particular words of the function are ambiguous or in dispute as to what function is being described, then you may look to the specification to find out what the words mean. It is not proper in this endeavor to "read into" or limit the function of a claim element to the preferred embodiments described in the specification. The function of a means-plus-function claim element is ascertained from the words of the claim element as stated in the claim, with any uncertainty in definition resolved by you.

The "means" of a means-plus-function claim element is the structure in the patent specification that relates to the function of the means-plus-function claim element. To identify the "means," you must identify the structure performing the function as stated in the claim element. The fact that the structure in the specification of the patent is also performing another function or functions is of no moment.

You have heard testimony with regard to certain elements of the claims being known in the prior art. Individual claim elements may, and often do, read on the prior art, particularly in combination patents, such as the patents in suit. Virtually all inventions are combinations, and virtually all the combinations of particular elements found in the prior art. For that reason, it is of no moment whether a particular "means-plus-function" claim element may have been found in the prior art standing by itself.

There is nothing wrong in these instructions. Earlier, the Court instructed the jury on how to go about interpreting claim language generally. Then, the Court instructed the jury how to go about interpreting the means-plus-function claims. There was no prejudice to Chrysler sufficient to warrant a new trial.

5.

Chrysler takes exception to the instructions just above recited on the grounds the jury was told to ignore prior art "in determining whether the Chrysler systems infringed the patents-in-suit." The jury was told no such thing. Indeed, the jury was instructed on the role of prior art in interpreting a claim, see pp. 44-45, *supra,* and was specifically instructed as follows (Tr. 11/22/91, p. 4261):

When I use the term prior art, I mean you may consider the Amos and Foreman patents as discussed in

the prosecution histories and as explained to you in the courtroom.

Lastly, Chrysler takes exception to the instructions on the reverse Doctrine of Equivalents, a defense which Chrysler asserted and the jury found lack merit which went as follows (Tr. 11/22/91, pp. 4254-55; 4267-68):

It is your job to decide this dispute over infringement and to carry out that job you must follow the process I will now outline to you.

First, you must decide whether or not there has been literal infringement. In doing this, you will consider the evidence Dr. Kearns has offered that there is literal infringement and the evidence Chrysler has offered that there is no literal infringement.

Second, depending on your decision regarding literal infringement, you may then have to decide whether or not the reverse doctrine of equivalence applies to prevent a finding of infringement. When I say reverse doctrine, I am referring to the evidence Chrysler has offered that Chrysler's systems did not infringe because they were so changed in principle from the patented inventions that they performed the same *or a similar function* to produce substantially the same result, but did so in a substantially different way. At the same time you will consider the evidence Dr. Kearns has offered that the Chrysler systems were not so changed in principle from the patented inventions because they performed the same *or a similar function* to produce substantially the same result and did so in substantially the same way.

• • •

If your answer to the question of whether or not Chrysler literally infringed Dr. Kearns' patent is "Yes,"

you must then consider what is known as the "Reverse Doctrine of Equivalence."

I told you previously that under the Reverse Doctrine of Equivalence, you may still find that Chrysler has not infringed the claims. The question is whether the Chrysler systems were so changed in principle that they performed the same or a similar function to produce substantially the same result, but did so in a substantially different way.

If the changes you find in the Chrysler systems were only such that they still performed the same *or a similar function* to produce substantially the same result in substantially the same way, then Chrysler has not made out a case under the Reverse Doctrine of Equivalence.

When I use the phrase "so changed in principle," I mean that taken as a whole, Chrysler's system had a substantially different way of performing the function and reaching the results of the patented invention. (emphasis added)

Chrysler, focusing on the underlined language, argues that it allowed the jury to find literal infringement without finding identity of function as an element under the means-plus-function rules explicated in *Valmont, supra.*

Chrysler is wrong. The instruction clearly states that what is now being judged is the claimed invention. The underlined words come directly from *Graver Tank & Manufacturing Co., Inc. v. Linde Air Products Co.,* 339 U.S. 605, 608-609 (1950). There was no prejudice to Chrysler.

C. The Special Questions

Chrysler says it suffered substantial prejudice from the use of special questions that incorrectly and incompletely compared and described the asserted claims and the Chrysler system, and then goes on to pick apart the special

questions in great detail to make its points. Kearns has responded to the substance of Chrysler's arguments in the same detail. However, the Court is satisfied that Chrysler failed to properly except to the text of the special questions and according to the rule that unless an objection is properly made to jury instructions, which obviously includes special questions, any error is not preserved unless there is plain error, which is not argued here. The discussion at pp. 40-43, *supra,* describes the difficulty the Court faced in framing the special questions, including the unresponded to invitation to revise them if either party was dissatisfied with the Court's formulation. That difficulty, coupled with the general nature of the Chrysler objections, which mirror Kearns' objections (See Exhibits A and B), prohibits Chrysler from arguing for a new trial on grounds it was prejudiced by the special questions. See *Woodbridge v. Dahlberg,* 954 F.2d 1231, 1234-1237 (6th Cir. 1992), and *Gonzalez v. Volvo of America Corporation,* 752 F.2d 295, 298 (7th Cir. 1985). It should be noted here that on the basis of the answers to the special question regarding the '178 Patent, Chrysler was successful in obtaining a verdict in its favor. See p. 1, *supra.*

D. Evidentiary Rulings

Chrysler's arguments regarding evidentiary rulings is difficult to discuss because they are long on law but short in describing the precise rulings to which exceptions were taken as reflected in the record. Again, Chrysler ignores the rule that entitlement to new trial because of a wrong ruling on a matter of evidence requires a showing of prejudice. Fed. R. Civ. P. 61 reads:

> No error in either the admission or the exclusion of evidence and no error or defect in any ruling or order or in anything done or omitted by the court or by any of the parties is ground for granting a new trial or for setting aside a verdict or for vacating, modifying, or otherwise

> disturbing a judgment or order, unless refusal to take such action appears to the court inconsistent with substantial justice. The court at every stage of the proceeding must disregard any error or defect in the proceedings which does not affect the substantial rights of the parties.

See also: *Douglass v. Eaton Corporation*, 956 F.2d 1339, 1344 (6th Cir. 1992); *Westwood Chemical, Inc. v. Owens-Corning Fiberglass Corporation*, 445 F.2d 911, 918 (6th Cir. 1981), *cert. denied*, 405 U.S. 917 (1972).

1.

Chrysler says the Court wrongfully denied Paul Enlow, a Chrysler expert, to discuss certain prior art, and excluded Chrysler Exhibits 273 and 701. Since Chrysler fails to cite the record pages regarding the exclusion of these exhibits, the Court will not discuss them. As to the prior art ruling, the record pages cited by Chrysler do not tell the whole story. As best the Court can determine from the record, it was the particular questions Chrysler put to the witness to which objections made by Kearns were sustained. Suffice to say, the Court did not exclude prior art as an aid to claim interpretation but rather excluded discussion of prior art in circumstances in which Chrysler was obviously trying to challenge the validity of the patents-in-suit.

The particular question cited by Chrysler was as follows (Tr. 11/11/91, p. 2791):

> Q. . . . Would you describe for us what is contained or what is shown in the Foreman system, in the Foreman prior art —
>
> THE COURT: The objection is sustained. We are dealing with the office actions, what the Examiner said, and how the applicant responded. I have made that ruling previously, Mr. Taylor, and you should have understood it.

What Foreman teaches what Amos teaches to say is irrelevant. It is what the Examiner says and how the applicant responds that is relevant.

Clearly, substantially more of the record must be studied to understand the question, the objection and the Court's ruling. Lastly, the jury was specifically instructed that "evidence about what is called prior art" could be used in "determining the meaning of words in a claim" (See Tr. 11/22/91, pp. 4259, 4258), and that "the Amos and Foreman patents as discussed in the prosecution histories and as explained to you in the courtroom" could be considered in assessing prior art. (See Tr. 11/29/91, p. 4261).

There was no prejudice to Chrysler prohibiting Paul Enlow's testimony regarding prior art.

2.

Chrysler says the Court wrongfully limited its use of the patent specifications in construing the claims and then cites excerpts from the record (See Tr. 11/5/91, p. 2022) as typical and makes no further reference to the record or any rulings of the Court. The complete text is instructive (Tr. 11/5/91, pp. 2022-24).

THE COURT: Ms. Siemer, you're asking her to say what the patent says the words energizing said motor to initiate a wiping cycle.

MS. SIEMER: That's right, your Honor, to initiate a wiping cycle. I want to define when the wiping cycle starts and when it stops.

THE COURT: Well, now this is what you ask her. You ask her what she found in the patents to initiate a wiping cycle. I'm going to sustain the objection.

I don't think you look at the patent spec for description of the functions. You look at the patent specs for structure

to define the means, but I'm not aware that you look to the patent to define function. If you think I'm wrong, we have to recess again and hassle it out.

MS. SIEMER: May I state it just briefly?

THE COURT: Yes.

MS. SIEMER: Not to determine the function, your Honor, but any word in any claim can be interpreted by looking elsewhere if it's ambiguous —

THE COURT: I don't see anything ambiguous in those words. Now, maybe the witness does.

MS. SIEMER: Suppose I ask that foundation question first.

THE COURT: I think that's a question for me to decide, don't you? I mean, I'm not skilled in the art, but I think the question whether or not there's an ambiguity is for the Judge to decide in the first instance.

Now again, if you want to recess, we'll call a recess and argue that one out. That's a ruling, as you understand. And I think it's unambiguous, it doesn't need any interpretation.

Clearly, the Court was not denying Chrysler the right to examine into the relationship of the specifications to the claims, but rather disallowing a generalized and unfocused line of inquiry. Chrysler's examination was not restricted. The jury was properly instructed. There was no prejudice to Chrysler.

3.

Chrysler says the Court wrongfully "exclude[d] ... evidence of the inherent moisture — responsive features of the windshield wiper systems disclosed by" the patents-in-suit. That is not what the Court did. What the Court did was to

instruct the jury that the claims-in-suit did not contain a moisture responsive limitation as follows (Tr. 11/7/91, pp. 2364-65):

> You will recall I told you at the beginning of the trial it's the Judge's function to define the issues in the case and operate as a traffic cop on the admission of evidence. You have heard testimony thus far that the Kearns invention overall had a feature in it known as moisture responsiveness, that is, length of the dwell and the speed of the wiper in intermittency could correlate itself to the amount of water on the window. So, if it was raining hard, it would move faster; less, it would move slower; no moisture, it would stop altogether. There is no requirement in the claims that are asserted in this case of moisture responsiveness. Therefore, the fact that neither the Chrysler A or B system have a moisture responsiveness capability is relevant to the issue or the question of infringement.

This instruction was based on a determination the day prior as follows (Tr. 11/6/91, pp. 2172-77):

> The moisture responsive issue is fundamental. The Court is satisfied that Dr. Kearns has the better of the argument but for slightly different reasons than asserted by counsel.
>
> The means plus function claim form in 112-6 reads, "an element in a claim may be expressed," et cetera.
>
> Chrysler's paper says,
>
> If the structure disclosed in the patent specification is to have any meaningful role in limiting the scope of a means plus function that claim, an alleged infringer must be permitted to introduce evidence that its device does not exhibit a feature that is inherent in the disclosed structure.

When Chrysler uses the word "structure" in that sense, it's referring to the totality of the invention, not an element of the claim; and I believe that what Chrysler is doing is taking the various elements of the claim, and the means in combination to create an overall structure, which is a device in action, which it cannot do. In literal infringement it's a question of whether of not each of the elements of the claim are found in the accused device, and it's not to compare the claim reduced to practice to the device — one device versus the other.

Second, these claims were construed initially in the suit challenging validity and enforceability, determining the validity of these patents. Chrysler is bound by the judgment in that case on validity and claim construction inherent in that judgment, that's not been disputed; and in that case there is nothing in the record that limits the claims which are in issue to moisture responsiveness. To inject, to allow the jury to consider moisture responsiveness in this case would confuse them, would mislead them, would make this case something different than it is.

Chrysler has to defend on the basis that its accused device does not literally infringe or the three-part test of reverse equivalence. The fact that it is possible to include moisture responsiveness in the Kearns' invention overall or various embodiments of it is of no moment in the Court's view.

• • •

THE COURT: I'm not going to strike the evidence. I will give the jury at an appropriate time, a cautionary instruction that moisture responsiveness is not required — a moisture responsive capability is not required in either Chrysler A or B system for a finding of infringement. I think that's the extent of my ruling — the extent the instruction has to go.

There was no error in the ruling on the instructions. Whatever an "inherent . . . responsive feature" may be of a "system disclosed by" a patent-in-suit, there was nothing in the asserted claims that allowed Chrysler to argue to the jury that it did not infringe because its intermittent windshield wiper systems were not moisture responsive. There was no prejudice to Chrysler in excluding evidence regarding moisture responsiveness.

4.

Chrysler argues, without citing its Patent Office number or exhibit number, that the Court erred in excluding from evidence the patent it obtained on its intermittent windshield wiper system, U.S. Patent No. 4,158,159, while allowing Kearns to cross-examine Chrysler witnesses on statements in Chrysler memoranda describing the Chrysler system. The statements were clearly admissible as admissions against interest, i.e., Chrysler's description of how its system operated. The Chrysler patent, offered by Chrysler to bolster its case on non-infringement, had no relevance as such. Chrysler was free to cross-examine Kearns' witnesses on their interpretations of the statements. The Court, in excluding the Chrysler patent, said it was hearsay and self-serving. (Tr. 11/14/91, p. 3277) The ruling was not prejudicial error.

5.

As previously described, there was considerable confusion as to which exhibits had been admitted during the course of the trial and because the jurors had notebooks before retiring to deliberate they were directed to retain and have in their notebooks when they went to the jury room to deliberate only certain of the exhibits. This is what the Court said. (Tr. 11/25/91, p. 4283).

THE COURT: Hi, folks.

> Be Seated.
>
> We have some housekeeping matters, and some supplemental matters.
>
> First, I want you to take your large notebooks, and I want to go through it page-by-page, tell you what you must have in it. If you have anything in it other than what I describe, you just rip it out.
>
> JUROR: I'm sorry, I left mine in the jury room.
>
> THE COURT: Okay.
>
> Go get it.
>
> That's extremely important that anything that's not in mine should not be in yours. And rather than go through them ourselves, we decided that we would respect your right of privacy and do it this way.

Chrysler dramatizes this little event by saying the Court "order[ed] the jurors to rip out of their notebooks and throw on the floor certain of Chrysler's exhibits that had been admitted into evidence." The Court does not find in the record any "order to throw" and, more than that, fails to find any explanation by Chrysler why it did not object at the time. Indeed, Chrysler knew from discussion with the Court the previous week[23] the Court's intended manner of dealing with exhibits. Also, all of the admitted exhibits were available to the jury during deliberations.[24] There was no prejudice to Chrysler.

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[23] See discussion at pp. 36-37, *supra*.

[24] Because of the volume of exhibits and number of witnesses, the Court gave the jurors a list of the admitted exhibits and a list of the witnesses who testified.

E. Rebuttal and Surrebuttal

While paying lip service to the Court's discretionary authority with regard to rebuttal and surrebuttal testimony, Chrysler argues in generalities that the Court abused this discretion by its generosity towards Kearns in rebuttal and its refusal to allow surrebuttal to Chrysler. No detailed discussion of the Chrysler's argument and Kearns' response is necessary. Kearns' case-in-chief took 8 trial days; Chrysler's defense took 10½ trial days. Kearns' rebuttal took 2 trial days. The Court ruled against Chrysler's surrebuttal stating, "I don't find that significant enough to allow any kind of surrebuttal." There was nothing exceptional about Kearns rebuttal evidence or in the Court denying Chrysler the right to surrebut. There was no prejudice to Chrysler.

F. The Pretrial Stipulation

As stated above,[25] Chrysler agreed to be bound by the decision on enforceability in Kearns' case against Ford, *Kearns v. Ford*, Civil No. 82-70748. In that case a jury found the Kearns patents-in-suit valid and enforceable. After the same jury hung on the issue of damages (it was unanimous on non-willfulness and a second trial on damages in which the jury found a reasonable royalty to be 30 cents a unit), Kearns and Ford settled. This obviated the Court's need to deal with Ford's motion for judgment notwithstanding the verdict or in the alternative for a new trial, and the Court of Appeals for the Federal Circuit to deal with a more than likely appeal. Almost from the time this case was scheduled for trial following the last of the Ford trials, Chrysler endeavored to get out of the stipulations by arguing there was no final adjudication and that, since *Kearns v. Ford* terminated by a consent judgment, Chrysler was not bound by the findings of enforceability and validity. The

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[25] See page 3, *supra*. Ford did not contest infringement.

Court ruled against Chrysler at a hearing held on May 30, 1991, and memorialized by an order entered May 31, 1991. No good reason has been shown for the Court to reverse its ruling.

IV. New Trial — Damages

Chrysler makes a variety of arguments in support of its position that it is entitled to a new trial on the issue of damages. None of its arguments have merit.

A. Limitation On A Reasonable Royalty

Chrysler argues that the reasonable royalty it must pay as an infringer cannot exceed 30 cents a unit because the uncontroverted evidence at the damages trial leads to the conclusion that Chrysler's cost to switch to a non-infringing intermittent windshield wiper system was 30 cents a unit and that non-infringing intermittent windshield wiper system were available. The trouble with the argument is that the jury found otherwise, presumably on the basis of testimony introduced by Kearns regarding the inadequacies of each of the alternatives intermittent windshield wiper systems argued by Chrysler. Chrysler is really asking the Court to rule that it does not have to pay more as an infringer than it would have paid if it had entered into a license voluntarily. That is not the law. There is no prejudice to Chrysler in the jury's finding that a reasonable royalty for infringement is 90 cents a unit.

B. The Instructions

Chrysler takes exception to the jury instructions of law regarding a reasonable royalty. The instructions went as follows (Tr. 5/29/92, pp. 3644-49):

> The damages that you are to award Dr. Kearns must be based on what is called a reasonable royalty. The term

royalty is the term that the law uses when referring to payments made to the owner of a patent, such as Dr. Kearns, by another person, such as Chrysler, when infringement has occurred.

The reasonable royalty is to be determined by use of what is called a hypothetical negotiation. This negotiation is presumed to have taken place at the time of the first infringement and assumes certain facts, including:

1. That Dr. Kearns, as Licensor, and Chrysler, as Licensee, would have been willing to enter into license negotiations for use of Dr. Kearns' patent IWW systems in May 1977, the date when the first infringing IWW system was manufactured;

2. That Dr. Kearns' patents were valid and infringed; and

3. That Dr. Kearns and Chrysler would have known all pertinent information of the other party.

You are not limited, nor are you constrained to use evidence that was available only at the time set for the hypothetical negotiation in 1977. Instead, you may use evidence pertaining to the period between 1977 and 1988 in coming to a conclusion as to what the hypothetical negotiations would have agreed to in 1977.

In a hypothetical negotiation the setting of a reasonable royalty after infringement cannot be treated as the equivalent of an ordinary licensing negotiation between a truly willing patent owner and a truly willing licensee. To do so would pretend that the infringement never happened, and that would mean that the infringer had nothing to lose but only had to pay the ordinary industry licensing fee. That is why the factors which I will shortly describe for you, that may be considered in the hypothetical negotiation, are broader than the factors that might

have been used in an actual automobile industry negotiation.

During the course of this trial, you have heard the testimony of a number of witnesses about factors that may be considered in determining the reasonable royalty in this case. You have seen exhibits displaying some or all of these factors. These factors are taken from cases dealing with reasonable royalties. You may find that not all of these factors are pertinent to the hypothetical negotiation in this case.

I have chosen to restate these factors to you as follows:

1. Industry licensing policies and practices, including the amounts paid by Chrysler for the use of other patents comparable to the patents in suit.

2. The nature of the rights that Chrysler would have received, including whether the license agreement would have been exclusive or non-exclusive.

3. The effect, if any, that the improvements in Chrysler IWW systems attributable to Dr. Kearns' patents had in promoting sales of other Chrysler products.

4. The duration of the patents-in-suit in May, 1977.

5. The established profitability, if any, provided by the improvements in Chrysler's IWW systems attributable to Dr. Kearns' patents, their commercial success, and their current popularity.

6. The utility and advantages of Dr. Kearns' patented IWW systems over older IWW systems, if any, or other reasonably available alternative IWW systems for accomplishing similar results. In considering reasonably available alternative IWW systems, you may take into consideration whether the alternative IWW systems had the beneficial characteristics of the infringing system (and therefore was an alterative to it) and whether it was

developed or available in the market. It is not necessary that Chrysler actually used any such alternative IWW systems, only that it was available for use.

7. The nature of Dr. Kearns' patented improvements to IWW systems and benefits, if any, to those who have used Dr. Kearns patents.

8. The extent, if any, to which Chrysler has made use of Dr. Kearns' patented improvements and any evidence probative of the value of that use.

9. The portion, if any, of the profit or selling price that may be customary in the automobile manufacturing business to allow for the use of Dr. Kearns' patents or analogous patents.

10. The portion of the benefit, if any, Chrysler realized from the improvements to its IWW systems that should be credited to Dr. Kearns' patented improvements as distinguished from non-patented elements, the manufacturing process, business risks taken by Chrysler in selling the infringing systems, or significant features or improvements added by Chrysler, if any.

11. The opinion testimony of qualified experts.

12. The amount which a prudent licensee who desired as a business proposition to obtain a license to manufacture and sell IWW systems embodying the patented improvements would have been willing to pay as a royalty and the amount which would have been acceptable by a prudent patentee who was willing to grant a license.

13. The hypothetical negotiations may involve other factors that normally prudent business people might, under similar circumstances, take into consideration in negotiating the license as you find from the evidence.

You should keep in mind that the purpose of the reasonable royalty is to provide compensation to

Dr. Kearns for the damages that he has suffered as a result of the infringement.

In determining a reasonable royalty, it will not be your purpose to punish Chrysler or make an example of it.

These instructions are substantively consistent with the law of damages in patent cases as stated in *Panduit Corporation v. Stahlin Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1158 (6th Cir. 1978), and *Georgia Pacific Corporation v. United States Plywood Corporation*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970), *modified & affirmed* 446 F.2d 295 (2nd Cir. 1971). No further discussion is required.

C. Evidentiary Rulings

Chrysler, again ignoring Fed. R. Civ. P. 61, complains of three evidentiary rulings in the damages trial in arguing for a new trial as follows:

1.

To establish the profitability of the infringing intermittent windshield wiper units, Kearns' principal witness on damages utilized Chrysler data from the Chrysler Product lost Data Base (Px 953-957). The Data Base is a print-out produced by Chrysler each year which contains a wide range of financial data on each of the principle components of the automobile manufactured by Chrysler including the profitability of intermittent windshield wiper systems. The witness explained the use of these studies as follows (Tr. 5/6/92, pp. 1073-75):

> From the documents that have been produced by Chrysler in this case, I have observed that they produced in advance of each model year a forecast of the profitability of each option attached to each vehicle that they sell in the United States, and a separate estimate for each vehicle in each option for Canada.

These forecasts are made in advance of the model year, and are finalized at about the time of the beginning of the model year which traditionally has been in the autumn.

These are the data which have been provided by Chrysler in this case in response to a request for all information regarding the profitability, or the costs, or studies concerning those for intermittent windshield wipers.

• • •

Q. And in what document does Chrysler report its estimate?

A. Documents referred to as the product cost studies.

Q. Why not use Chrysler's actual profit report as opposed to these product cost studies?

A. For one very simple reason; that is, Chrysler did not produce them. But also, in deposition evidence provided by Chrysler's employee, Mr. Milish, explaining the product cost studies, he said these are not regularly produced in the course of business by Chrysler. And that is why they did not produce them. That is, they do not go back at the end of the year and attempt to estimate the profitability of each option. They only do it in the beginning of the model year on a routine basis.

Chrysler argues that these studies were not relevant because they do not contain the kind of data courts have generally relied on to determine profitability of infringing devices. Chrysler is wrong. These studies were the only data produced by Chrysler with regard to profitability and, as explained by Kearns:

(a) [The] Product Cost Studies showed Chrysler's expected list price of the intermittent wiper option to

Chrysler new car dealers, along with expected discounts from the list price in another line of the same page.

(b) Product Cost Studies showed Chrysler's projected costs per unit of the intermittent wiper option, based on an assumed production volume for the Chrysler assembly plants.

(c) A cost accountant would have reached the same result if he tried to determine the costs of the products included in the Product Cost Studies.

(d) Chrysler has used Product Cost Studies "to understand our product costs".

(e) Fourteen Chrysler accounting people worked on the Product Cost Studies, with many more in Chrysler's plants providing supporting data.

(f) Chrysler used Product Cost Studies as a base or starting point for additional internal studies and were an important tool of the corporation.

(g) Product Cost Studies have been done every year at Chrysler for at least 25 years. [citations to the record omitted]

The Court engaged in a rather extended colloquy with Chrysler's counsel regarding these studies to assure itself that they were the only evidence available regarding profitability, as follows (Tr. 5/7/92, pp. 1249-59):

THE COURT: So, the only data that's available to arguably relate to profit is the product cost studies?

MR. TAYLOR: Yes.

• • •

THE COURT: Then, are you telling me there are still documents available in the Chrysler files relating to

either cost or profit that have not been produced in this case?

MR. TAYLOR: No, sir, I'm not.

• • •

THE COURT: All you're saying is whatever Chrysler produced related to cost and profit, you got?

MR. TAYLOR: Right.

• • •

THE COURT: Did Chrysler produce everything it had in good faith?

MR. TAYLOR: It did, your Honor, everything.

THE COURT: That's all that existed? That's all that existed, right?

MR. TAYLOR: That's correct.

• • •

THE COURT: And there's nothing that you have that they didn't ask for.

MS. SIEMER: No, that's right.

• • •

MR. TAYLOR: There are no documents within Chrysler, that I'm aware of, relating to the profitability of options that were not produced.

THE COURT: And the cost of manufacture?

MR. TAYLOR: And the cost of manufacture.

Certainly, evidence of expected and actual profitability is relevant when the jury considers the *Georgia Pacific, supra,* factors. See *Trans-World Manufacturing Corporation v. Al Nyman & Sons, Inc.,* 750 F.2d 1552, 1568 (Fed. Cir. 1984). Chrysler had ample opportunity and put it to good use to place the product cost studies in context and to argue to the jury the severe limitations on them. There was no prejudice to Chrysler.

2.

Chrysler says the Court erroneously denied admission of a 1964 agreement Kearns signed with Tann Corporation (Tann) regarding licensing of his intermittent windshield wiper invention and a 1973 letter Tann wrote Ford proposing a license. Aside from the dramatically different circumstances which obtained in 1964 when the agreement was signed, and in 1973 when the offer was made, the jury did hear of the essential terms of both documents. (Tr. 5/27/92, p. 3398) The Court was, and is, satisfied that Chrysler had ample opportunity in cross-examination of Kearns to display to the jury Kearns' views on the worth of his invention in the context of his relationship to Tann and in the offer to Ford and that the jury obviously did not think such a view was persuasive of what Kearns was entitled to from Chrysler as an infringer. There was no prejudice to Chrysler.

3.

Chrysler takes exception to the Court overruling its objection to the testimony of Stephen Thompson (Thompson) in rebuttal. Thompson was called to testify by Kearns regarding the disincentive to inventors when they receive unreasonably low royalties for their work. The Court was initially disinclined to let Thompson testify on the grounds that his opinion had no relevance to any of the issues. After an

extended voir dire outside the presence of the jury, the Court allowed Thompson to testify for the limited purpose of responding to Chrysler's evidence that a reasonable royalty for its infringement was 3 cents a unit. The Court said (Tr. 5/27/92, pp. 3427-31):

> I'm going to let him testify. I'll give the jury a cautionary instruction now or later, but I'm satisfied that the jury is entitled to some further background as to what their function is, and how they are to approach it in the consequences of their decision-making.
>
> I think that we have put juries at sea in these patent cases, and given the range here between $.03 and $29.00, both of which figures the Court finds extreme and this Court candidly, . . .would not allow a verdict to stand at $.03 a unit, nor would it allow a verdict to stand at $29.00 a unit. I would find . . ., the first one unreasonably low, and either grant a new trial, or a remittitur,[26] and [on] the other one would grant either a new trial and a remittitur. And what has happened in many of these cases, Mr. Taylor, as I can see it, is that the Court simply substitutes its judgment for the judgment of the jury, and that is not trial by jury.
>
> • • •
>
> [I]n this case, if he asks those questions the way he has, given the answers that will be given, you have a right to bring out the generality and the lack of familiarity, and I am prepared to tell the jury now or later that this testimony is offered for a very limited purpose and that is, to give them some fuller appreciation of what is involved

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[26] This is an erroneous statement. The Court's authority in the event of an unreasonably low verdict would be limited to the grant of a new trial.

in the patent system, and why the Constitution provides for a system of patents, and that's the sole purpose.

MR. TAYLOR: The problem that I have, your Honor, is this, we've got a witness here who is going to give sworn testimony —

THE COURT: Opinion testimony.

MR. TAYLOR: And then I'm going to have to stand here and — many of the important considerations on the other side —

THE COURT: You can bring out in leading questions, and if he says he doesn't know — he may admit some of them, but that's the risk we take.

But, let me tell you Mr. Taylor, I don't want to spend a lot more time about it, but the Defendants put themselves in this position in their approach of what constitutes a reasonable royalty for infringement. I didn't come up with the $.03 a unit; you came up with it. I am judicially outraged with that figure, I want you to know that.

I think what you did is you came in with the lowest possible figure, figuring that the jury, if you got low enough, then the jury would boost it, but it might not boost it as high, as high if it came it a little higher.

I also think, Mr. Taylor, that some of the examples of alternatives were off the wall. I think what you did with the . . . two design rounds, those aren't reasonable alternatives. They're not available in the marketplace. They are some engineer's speculations, and you've done a very good job, an excellent job, of building them up into something that's meaningful.

If I were a Judge trying this case to the bench, I don't know if I would have even allowed that testimony. I described it the other day, and I'm not going to describe it

again, but — I can't blame you. I guess that's the way these cases are tried, ...

• • •

I think this . . . [is] entitled to here this, . . . I'm willing to give them an instruction on the narrowness of the reasons why the Court is allowing this.

The Court went on to give a limiting instruction to the jury as follows (Tr. 5/27/92, pp. 3435-36):

Ladies and gentlemen, — this testimony is being offered for a very limited purpose. You sit here as a jury and you will get the rules of the law that you are to apply on Friday.

• • •

It will be your job to determine what constitutes a reasonable royalty in the circumstances of this case according to the rules of law that I give you.

Now, what I say now is not a comment on the evidence. You have heard a rather wide range of what constitutes a reasonable royalty per unit, but my guess is as low as $.03 a unit, and as much as $29.00 and something a unit. . . . — it's your decision to make.

This testimony may be of some assistance in allowing you to evaluate all of the other testimony that you've heard and some assistance in applying the various rules of law that I give you, particularly . . . — the factors from what we call the *Georgia-Pacific* case, and the fact that you are determining a reasonable royalty in the context of an infringement case, not in the context of a voluntary negotiation where you are simply asked for advice.

So, it's for that limited purpose and for that — and to give you some background upon which you can deliberate and come to a conclusion.

Is that satisfactory?

MR. TAYLOR: That's the instruction you said you were going to give.

THE COURT: I just want to be consistent with what I told you I was going to do.

MR. TAYLOR: That is what you said you would do.

THE COURT: I didn't leave anything out?

MR. TAYLOR: No, sir.

Thompson then testified that an award of an unreasonably low royalty to Kearns would undermine the very purpose of the patent system and that in considering a reasonable royalty "you get into the incentives for the system and for the inventor." Chrysler extensively cross-examined Thompson.

There was no error in allowing Thompson to testify. There was no prejudice to Chrysler.

D. Kearns' Pro Se Representation[27]

As described above, Kearns represented himself in the damages trial. Chrysler complains that the Court unfairly and improperly assisted Kearns to Chrysler's substantial prejudice. In its argument Chrysler makes a number of references to the record without stating the text of the record. Also, Chrysler says that Kearns, while representing himself to be without counsel, in fact had the assistance of counsel behind the scenes. Chrysler does not support this assertion by any record reference and does not cite any

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[27] See discussion at p. 4, *supra*.

record reference where it moved the Court for relief on the occasions it argued that the Court unfairly assisted Kearns. Moreover, at no time did Chrysler move for a mistrial or suggest to the Court how it should deal with Kearns' obvious floundering and lack of understanding of how to proceed. Lastly, Chrysler offers no suggestion of what result might have obtained if the Court had acted in the way Chrysler believes appropriate. There was no prejudice to Chrysler in the manner in which the Court handled Kearns.

V. Remittitur

Chrysler's last point in arguing for a new trial is that the jury's verdict of 90 cents an infringing unit was excessive, and therefore a remittitur to 30 cents a unit is appropriate because there were acceptable non-infringing alternatives available, and therefore "the proper measure of a royalty is capped at the cost difference between such an alternative and the infringing device." This argument has already been rejected. Again, Chrysler would have the Court rule that Chrysler should not pay more for its trespass than it would have paid if it negotiated a license with Kearns. Kearns' proofs were to the effect that $3.00 a unit was a reasonable royalty to be paid by Chrysler for its infringement. The jury verdict of 90 cents a unit was within the limits of an amount that the jury could reasonably have found appropriate for Chrysler's infringement. There is no basis for a remittitur.

VI. Conclusion

A. Comments

This opinion has taken too long to complete. The inordinate length of time the Court has spent on it has been occasioned by judicial distractions, personal circumstances, and mostly the complexity and excessiveness of Chrysler's argument. Too much of its argument was taken up in

assertions that Chrysler knew, or should have known, lacked merit given the standards of review established by Fed. R. Civ. P. 50 (a)(1), Fed. R. Civ. P. 51 and Fed. R. Civ. R. 61.

Kearns' response, as previously mentioned, was of little assistance. Without the contribution of the amicus brief the Court would still be struggling to come to a conclusion. The Court's role is now at an end. The parties, if they desire, may now take their dispute to a higher level. If they do they certainly should heed the lessons learned at this level, and Kearns, particularly, should mind the admonition: *Basilicae non adsunt ut rotam interum inveniant.*

B. The Order

For the reasons stated above Chrysler's motion for judgment as a matter of law or, in the alternative, for a new trial is DENIED.

SO ORDERED.

/s/ AVERN COHN

AVERN COHN
UNITED STATES DISTRICT JUDGE

DATED: JUNE 3, 1993
Detroit, Michigan

Supreme Court, U.S.
FILED
FEB 25 1995
OFFICE OF THE CLERK

(2)

No. 94-1131

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

CHRYSLER CORPORATION, AND
AMERICAN MOTORS CORPORATION,
Petitioners,

v.

ROBERT W. KEARNS,
Respondent.

On Petiton for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENT' S RESPONSE TO PETITION FOR WRIT OF CERTIORARI

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88 pp

DISCLAIMER

Through adjudged and alleged infringement by defendants who are under the subject matter and personal jurisdiction of this U.S. Supreme Court 700 million Intermittent Windshield Wiper features have been added to the roads.

In the model years 1965 through 1968 the Ford Motor Company offered Intermittent Windshield Wiper Systems supplied to Ford by the Trico Products Corporation of Buffalo, N.Y. It was recognized and acknowledged in Trico's U.S. Patents, 3,110,056 by Oishei et al. and 3,339,123 by Reister that when the accumulation increases in the windshield wiping area visibility is impaired. In its patent specification Trico complied with 35 U.S. Code § 112 to **set forth the best mode contemplated by the inventor for carrying out his invention as did Dr. Kearns.**

Trico used engine vacuum in the operation of its Intermittent Windshield Wiper System and provided a vacuum operated switch **44** as a safety escape from dwell. Dr. Kearns' Intermittent Windshield Wiper Systems sensed the moisture in the windshield wiping area to skip the dwell period at the end of the current wiping stroke if dwell was not safe.

Infringers are not hampered by the law. None of the infringers who took Dr. Kearns' Intermittent Windshield Wiper Systems inventions took the accompanying safety provisions published in the U.S. Patent literature.

In all the years of the Vietnam War there were not as many as 55,000 U.S. citizens killed, yet <u>each year</u> on U.S. roads 55,000 die in automobile accidents. More than half of those accidents occur in wet weather yet the weather is not wet half the time.

Dr. Kearns believes the Intermittent Windshield Wiper feature assembled into Chrysler products is inherently dangerous. Dr. Kearns invented Windshield Wiper System with Intermittent Operation to reduce wet weather accidents. The opposite has occurred. Dr. Kearns disclaims the responsibility for the infringements and for allowing the infringers to continue sales.

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CONSTITUTIONAL PROVISION INVOLVED

Article I, Section 8, Clause 8

"The Congress shall have the power:

To promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

TREATY INVOLVED

General Agreement on Tariffs and Trade ("GATT") to the Uruguay Round Agreements was signed on April 15, 1994, submitted to Congress on September 27, 1994 and enacted on January , 1995 and includes in relevant part at (15) The Agreement on Trade-Related Aspects of Intellectual Property Rights which in turn includes in relevant part:

PART I
GENERAL PROVISIONS AND BASIC PRINCIPLES

Article 1
Nature and Scope of Obligations

1. Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

PART III
ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

SECTION 1: GENERAL OBLIGATIONS

Article 41

1. Members shall ensure that enforcement procedures as

specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Article 46

Other Remedies

In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed. The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements. In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

STATUTES INVOLVED

35 U.S.C. Patents, provides:

APPLICATION FOR PATENT

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, **and shall set forth the best mode contemplated by the inventor for carrying out his invention.**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. July 19, 1952, c. 950, § 1, 66 Stat. 798.

35 U.S.C. § 281, Patents, provides:

> **§ 281. Remedy for infringement of patent:**
> A patentee shall have remedy by civil action for infringement of his patent. July 19, 1952, c. 950, § 1, 66 Stat. 812.

35 U.S.C. § 283, Patents, provides:

> **§ 283. Injunction:**
> The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable. July 19, 1952, c. 950, § 1, 66 Stat. 812.

SIXTH CIRCUIT RULE INVOLVED

That a Senior Judge cannot adjudge a case outside his district if a case on his docket is there for more than five years.

TITLE 28 § 1654 RULE INVOLVED

§ 1654. Appearance personally or by counsel

In all courts of the United States the parties may plead and conduct their own cases personally or by counsel as, by

the rules of such courts, respectively, are permitted to manage and conduct causes therein. (As amended May 24, 1949, c. 139, § 91, 63 Stat. 103.)

ADDITIONS AND CORRECTIONS TO STATEMENT OF THE CASE

As an inventor, Dr. Kearns believed:

> "(T)he patent system provides a **protected market** with the opportunity for **unusual profit** necessary to justify the heavy investment in time, effort, and capital necessary to bring the improvement to the public. This same **protected market** provides an **entering wedge** by which a business enterprise entering a new field can overcome the obstacles that otherwise discourage entry into an industry already populated[1]." page 5 of Study No. 2 of the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary, 84th Cong., 2d sess. (1957), entitled *The Patent System and the Modern Economy*.

In 1957 he founded Kearns *Engineers* to manufacture the U.S. and foreign patented products he invents.

35 patents in
Intermittent Windshield
Wiper Systems

Dr. Kearns has been awarded 29 U.S. patents. Nominally, he has been awarded 12 foreign patents with other foreign patents pending. Thirty-five (35) of those patents and the foreign patents pending are in the art of Intermittent Windshield Wiper System ("IWWS").

Dr. Kearns has never licensed any of the patents he has been awarded.

---

[1] Congressional Library Microfilm #11997.

Computer Central© exported to France and Japan

Dr. Kearns has supplied one of his patented inventions to Chrysler's Missile Division.

Dr. Kearns supplied with his quotation to Chrysler Corporation's purchasing department 20 pre-production IWWS electronic modules (A. 1) that Kearns *Engineers* personnel pre-tested against Chrysler Performance Standard PS-6338. Dr. Kearns sought a waiver from PS-6338 and provided the 20 pre-production IWWS electronic modules with his moisture sensitivity skip feature. The waiver he sought from PS-6338 was only that the wiper blades had to touch and wipe a windshield during test.

Dr. Kearns supplied with his quotations to both Daimler-Benz ("Mercedes") Aktiengesellschaft and, to Dr. Ing. h.c.f. Porsche A.G. two of the pre-production IWWS electronic modules.

Dr. Kearns demonstrated his IWWS to personnel of the Ford Motor Company, Chrysler Corporation and General Motors Corporation among others.

He supplied another of his inventions[2] from 1964 through 1978 to companies and universities located throughout the U.S. (CAFC Appendix pp. 904 to 1445) and through export licenses issued by the U.S. Department of Commerce to France and Japan (A. 2).

Civil actions

Dr. Kearns demonstrated the external features of his IWWS to Ford and Chrysler engineers in October 1963. Dr. Kearns demonstrated the features of his IWWS to an array of personnel of General Motors Corporation and built his IWWS into a General Motors' model of automobile. Dr. Kearns was awarded a doctorate in engineering from Case Institute of Technology the following June.

---

[2] Dr. Kearns' manufactured-inventions were sold under the U.S. trademark *Computer Central*© as shown at (A. 1-2).

IWW features are assembled into models of every automobile assembled in the western world. Dr. Kearns sought IWWS supply contracts from every automobile assembler in the western world. Through infringement of Dr. Kearns' patents each automotive assembler in the western world controls its segment of the market comprising the industry. (A. 3-5)

Dr. Kearns has or maintains civil actions for infringement against every assembler of automobiles in the western world except Fiat[3]. Dr. Kearns had positioned himself to be a major supplier of IWWS to the automotive industry if his U.S. patents were enforced under 35 U.S.C., as acknowledged by District Judge Pratt in denying Dr. Kearns his Motion for a Preliminary Injunction filed in 1979. (A. 6-11)

Adjudged infringers

The Ford Motor Company lawyers admitted that all 20.5 million of their electronic IWWS sold, which included IWW features sold by Ford to American Motors Corporation, infringed Dr. Kearns' patents if his patents were valid. Chrysler Corporation and American Motors Corporation lawyers stipulated to be bound by the validity trial in *Kearns* v. *Ford Motor Co.*, 726 F. Supp. 59 (E.D. Mich. 1989) ("*Ford*"). The *Ford* jury found all six of Dr. Kearns' U.S. patents litigated in that trial to be valid. The *Chrysler and American Motors* jury found all four of the six *Ford* patents litigated in the *Chrysler and American Motors* trial to be infringed. Dr. Kearns, his lawyers, and, his patent expert found in preparing for the *Kearns* v. *General Motors* trial that General Motors Corporation infringed 207 claims of nine of Dr. Kearns' U.S. patents.

All the civil actions were filed in the U.S. District Court in Detroit, Michigan.

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[3] Fiat no longer does business in the U.S.

Kearns *Engineers* expansion

In 1957 at age 30, Dr. Kearns, with his Masters (M.S.E.M.), founded Kearns *Engineers* in Detroit, Michigan to manufacture and sell his patented products. In 1958 Kearns & Law *Engineers* expanded to Livonia, Michigan. (CAFC A-1122) In 1960, Kearns & Law *Engineers* expanded a second time back into Detroit, Michigan. (CAFC A-1098)

Seeking specifications

On October 29, 1963, Dr. Kearns contacted management at the Chrysler Engineering Center in Highland Park, Michigan to speak to windshield wiper engineers to obtain engineering specifications of the automotive environment to complete his work on Intermittent Windshield Wiper Systems ("IWWS").

Chrysler management first required Dr. Kearns to sign a Non-Confidential Disclosure Agreement. That Agreement stated that Chrysler would "respect valid U.S. patents." Dr. Kearns signed the Agreement and, secondly, at the request of management, demonstrated to four managers of Product Planning for each car line, the external features of his IWWS which he had installed on a 1962 Ford Galaxie convertible. That IWWS provided a continuously-variable continuous speed driver-rotated control in the continuous position of the driver-controlled-wiper-switch and a variable-dwell continuously-variable continuous dwell period in the 'park' position with the same driver-rotated control when the driver-controlled-wiper-switch was in the intermittent position.

Third, management allowed Dr. Kearns to talk to the windshield wiper lab supervisor and his assistant, but they provided no specifications to Dr. Kearns.

The week before Dr. Kearns went to Chrysler seeking specifications, he had gone twice to the Ford Motor Company engineering center seeking automobile environmental specifications for his IWWS. Again, Dr. Kearns was required to sign a Non-Confidential Disclosure Agreement prior to talking to their engineers.

Ford's Agreement said they would honor U.S. patents. Accordingly, Dr. Kearns signed that Agreement and demonstrated his IWWS to Ford general parts division management and numerous windshield wiper engineers.

Dr. Kearns learned during the demonstrations that the environment under the hood was 270° F. and that the wiper motor had to be subjected to 3 million cycles in a life test. Mr. Neill, the manager, requested an approximate price for an IWWS.

Disappointed, as he had expected more specifications, Dr. Kearns went to Chrysler, was disappointed again and returned to his laboratory where he succeeded on June 29, 1964 in being able to adapt his IWWS technology for any temperature and then started his life test which completed 3.4 million cycles on November 16, 1964. He filed a specification for his first IWWS U.S. patent on December 1, 1964. (A. 12)

Kearns' pre-trial contacts
with Chrysler personnel

It was 17 years before trial, that Dr. Kearns sought automotive environmental specifications to complete his development work on IWWS - October 29, 1963 from Chrysler Engineering personnel.

On December 9, 1964, Dr. Kearns again demonstrated his IWWS to Chrysler engineers who received a complete schematic engineering drawing (CAFC A-134)(Court of Appeals for the Federal Circuit Appendix page 134) of Dr. Kearns' IWWS. On January 16, 1965, Dr. Kearns received a copy of S.R.Ward's drawing of Dr. Kearns' IWWS in a Chrysler windshield wiper system. (CAFC A-140)

On February 5, 1965, an IWWS in Chrysler cars "had been approved by all concerned." (CAFC A-146)

Mr. Bouwkamp, Chief Engineer & Manager of Dodge Product Planning tested a car for nine months that contained a Dr. Kearns' IWWS. (CAFC A-147)

On May 1, 1968, Dr. Kearns had prepared a PROPOSED

CHRYSLER CIRCUITS and PATENTABILITY FEATURES REPORT for Glen Farison who reported to Chrysler's Chief Patent Counsel. (CAFC A-151; -154) Fig. I-1 of that report will be important shortly. (CAFC A-158)(A. 13-14)

On February 23, 1972 Ford raised the defense of the invalidity of Dr. Kearns' patents.

On May 23, 1974, Chrysler's Sourcing Committee acknowledged that Chrysler's competitors used 2-continuous speeds plus intermittent and predicted a "recurring profit of 13.4 million annually" from the use of IWWS. (CAFC A-198)

Mercedes sought a quotation from Kearns Engineers for its worldwide production needs. (CAFC A-481 to -584). Kearns Engineers quoted Mercedes, Porsche and Chrysler. (CAFC A-587, 589, 1032)

On June 16, 1974, a Source Planning Letter was **released** for a 2-continuous speed IWWS for Job #1 1977 (to be in dealer's showrooms by August 1976).

On June 14, 1974, Chrysler engineer, Mr. Orris submitted a patent disclosure for an IWWS.

On July 10, 1975, Chrysler's patent counsel, Mr. Santo held a meeting in his office with Mr. Orris at which they discussed the Kearns patents, with Mr. Santo discussing specific Kearns patents '836, '374 and '178 which he thought was "involved on the controller portion for the intermittent wipe system per se." Mr. Santo informed Mr. Orris that Chrysler was setting up a $500,000 fund "for when the patentees would present a charge of patent infringement." (CAFC A-368)

Fourteen days later, on July 24, 1975, Mr. Santo wrote to engineering the results to date of his patent investigation. The three Chrysler IWWS designs developed over the past two years had "objectional aspects" (CAFC A-376) found by the Huntsville, AL reliability engineers (CAFC A-365) (A. 15-16).

Nineteen days after the Santo-Orris meeting, Mr. Orris 'conc-

eived' as his own (A. 18-20) Dr. Kearns' Fig. I-1 given to Mr. Farison (A. 13-14); Dr. Kearns' '836 Fig. 1 (A. 12); Dr. Kearns' '178 Fig. 1 (A. 17). Dr. Kearns submitted Fig. I-1 to Chrysler because their wiper motor used a one-movable-contact one-stationary-contact motor driven switch. On August 11, 1975 Mr. Orris made the final conception circuit shown at CAFC A-390.(A. 21).

Notice there is no #58 resistor in series with the input of the transistor as there is shown in Dr. Kearns' '178 Fig. 1. (A. 17) On January 5, 1979 an Engineering Change Order was issued to install the missing #58 resistor (CAFC A-416). On 25 January 1979 a second Engineering Change Order was entered to change the motor-driven switch to the one-movable-contact two-stationary-contacts motor-driven switch used by Dr. Kearns in his patents to make the copying complete **except for Dr. Kearns' moisture responsive dwell period**. (CAFC A-426)

On August 8, 1975 a memorandum by F. Zubrzycki of Dept. 3840 confirmed Chrysler management had established the $500-,000 fund. (CAFC A-388)

Chrysler presented no evidence that management ever withdrew the $500,000 patent liability fund.

Subcontractor agreements

During this time, Dr. Kearns and his family started to manufacture and sell through Kearns *Engineers* other of his patented products throughout the USA (CAFC A-1389-1424) under the trademark *Computer Central*©. (CAFC A-904-947) Still later, Dr. Kearns and his family, through export licenses issued by the U.S. Department of Commerce sold the *Computer Central*© patented products in France and Japan. (CAFC A-604) (A. 1) Dr. Kearns advertised his patented products in technical magazines. (CAFC A-1369 to 1385)

Dr. Kearns' IWWS patents Constitutionally permit him the exclusive right to supply a IWWS sub-assembly for automobile-assembler installation.

Accordingly, in an effort to set up the manufacturing of Dr. Kearns' products, Dr. Kearns, through Kearns *Engineers*, entered into agreements: on 30 November 1964, with Prestolite company officials for them to supply 3-brush permanent-magnet field windshield wiper motors (CAFC A-1091-093); on July 11, 1967 with Lake Center Switch to design and build prototype driver-actuated-controls for his IWWS which they would supply (CAFC A-1082); and, on October 6, 1967 with Essex Wire to supply IWWS wiring harnesses (CAFC A-1096).

With the agreement of these sub-contractors and Dr. Kearns' IWWS patents, Kearns *Engineers* was prepared to manufacture and supply IWWS sub-assemblies in volume to automobile-assemblers worldwide.

Transcript of the Proceedings before Judge Cohn
Friday, May 15, 1992 p. 2012:

THE COURT: I don't understand, candidly, a company that's got to worry about infringement, is very busy gearing up for production, where the patent lawyer [Mr. Santo] is still futzing around with his opinion because he can't find a file history. I think the jury ought to decide that.

Here's the company, the engineers, the production people and there going full speed ahead.

MR. CONLEY: Yes.

THE COURT: Getting ready to market this on their car belatedly, and the patent lawyer he's working on the infringement opinion.

Boy, I've got to tell you something. Either Santo would have lost his job, or a couple of engineers would have lost their jobs, if Santo came up with the conclusion that we infringe, you can't do it and you've got to start all over again.

Truth stimulated by
the CAFC Opinion

In reading the Petition for Writ of Certiorari, Dr. Kearns

learned the citation for the location of the *Kearns* v. *Chrysler Corp. and American Motors Corp.* Opinion of the Court of Appeals for the Federal Circuit ("CAFC") in the patent literature- 32 F.3d 1541 (Fed. Cir. 1994).

He was shocked to read the first phrase, "Owner of patents for intermittent windshield wipers ..." Is that what we have here before our countries highest court, responding to Chrysler's petition, an owner of patents? 'Owner of patents' connotes the one who purchased the rights - or more importantly - the one who satisfied the desires of the inventor. And since that person can operate only in the remedies of money, why then, 'money damages' would be adequate - wouldn't they? And if that were so - why would Dr. Kearns bother the justices of the highest court of our land?

But, while the person who appeared before the CAFC is the patent owner, he is - more importantly - the inventor. Let us focus on this inventor of IWWS. What drives him to carry these 'lawyer troubles' burdens for 32 years? Obviously, with every 'enlightened' automobile assembler in the western world in litigation with him - which the Justices must know is very expensive of pocketbook and mental health - he must have refused each one of the ever-mounting money offers of settlement. Even the Ford lawyers are pleased to report - this inventor refused a $35 million initial offer from Ford[4].

The thoughtful followers of the IWWS saga would acknowledge that Dr. Kearns has proven he has a great faith in the Judicial Branch of his country. The inventor's goal was to reduce the slaughter of his 'Biblical neighbors' occurring on our nations

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[4] He took $10 million through the Court - paid off his lawyers - and fired them for not seeking equitable relief and the public interest, ... - and Bob Kearns began to represent Dr. Kearns - exclusively, on 3 March 1992.

highways during wet weather[5]. Let's look at the status of the problem he solved with his inventions before reviewing the thrust of Chrysler's Petition.

Dr. Kearns' first patent, relative to this litigation before the Supreme Court is "Windshield Wiper System with Intermittent Operation" U.S. Patent, 3,351,836. Let's reproduce claim 4:

> In combination with a vehicle having a windshield, a windshield cleaning system comprising wiper blade means slidably engaging said windshield, motor actuated drive means for driving said wiper blade means through repeating wiping cycles, and automatic control means for activating said drive means to drive said wiper blade means through said repeating wiping cycles, said automatic control means including means for automatically varying the time between wiping cycles in response to the degree of dryness of the windshield.

Moisture responsive dwell time period? "Hey, I don't have that on my car" a Justice exclaims. To get all the surprises on the table, know the vehicle Dr. Kearns drives is not equipped with an IWWS! How can this be? Let's ask Dr. Kearns. His reply- "An IWWS is less safe in the rain," he responds, "beyond the accumulation of a threshold number of raindrops in the blade wiping area of the windshield, the drivers visibility is impaired by an IWW feature - not helped." Moreover, the drivers 'fiddling' with the dwell time adjustment is distracting to the driver's purpose - driving."

With the filing of his 3,483,459 U.S. patent on 7 March 1966, Dr. Kearns' inventions included an automatic proportional moisture responsive dwell period which he demonstrated to about 40 Ford executives[6] by means of water-mist sprayed from a window-cleaner-pump bottle:

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[5] More than half the deaths occur during wet weather when the weather doesn't provide rain half the time.

[6] they were wearing suits.

Dr. Kearns saturated the viewing area with water-mist and stepped back -

at the first passage into the wiper blade parking area of the windshield - the dwell was skipped completely;

at the end of the next wiping cycle, the blade dwelled for say, 2 seconds;

at the end of the next wiping cycle, the blade dwelled for say, 5 seconds;

at the end of the next wiping cycle, the blade dwelled for say, 9 seconds;

at the end of the next wiping cycle, the blade dwelled for say, 15 seconds.

One can see the rainbow of colors from the remaining mist change on the windshield with each wiper cycle.

Ford didn't put the electronic IWW feature that infringed six of Dr. Kearns' patents until the 1969 model - more than two years later. [110,000 deaths, by then]

During his deposition, one Ford engineer acknowledged that Dr. Kearns was on the (Ford) design team (for the '69 models).

Electronic IWW feature first appeared on the Ford 1969 model - but not moisture responsive dwell time IWWS. Why not? [There is no increase in the number of parts required - merely an adjustment of those parts already present. That means no additional cost of installation, as well.]

To answer the question, would trials really have been necessary if Ford and Chrysler had used the moisture responsive feature as well?

Certainly not.

And what is the thrust of Chrysler's Petition here?

Can't we copy each of the elements of an IWWS we can later find in the IWWS prior art - and seek the aid of the Justices of the Supreme Court to limit the remedy due Dr.

Kearns for Chrysler's infringement of four of Dr. Kearns' patents?

The remedy sought is in 1995, 28 years and 1,540,000 deaths on the U.S. highways after the 1969 models appeared!

Is Const. Art I § 8 Cl 8 to promote science and the useful arts or the copiers of patents who do more harm than good?

Moisture responsive dwell time = safety

Dr. Kearns' filed specification claims were based upon: synchronizing the operations of the IWWS with the position of the wiper blade on the windshield to achieve an intermittent dwell period in the 'park' position outside the vision of the driver with minimal circuitry that was independent of the engine; a continuously-variable continuous wiping feature that used the same driver rotary control for both setting the time period of the intermittent dwell in the INTERMITTENT driver-switch position and set the continuous speed of the wiper blade in the CONTINUOUS driver-switch position; and, as the number of raindrops *in the wiped viewing area* increased between each wiping stroke to a threshold number, the IWWS would automatically leave intermittent operation and operate in continuous speed.

This feature ensured the clearest visibility thereby increasing the publics' safety.

The following 14 U.S. patents granted to Dr. Kearns contain moisture sensitivity safety features:

U.S. Patent	Title
3,351,836	Windshield Wiper System with Intermittent Operation
3,483,459	Pulsed Windshield Wiper Control
3,500,159	Electronic Control for Windshield Wipers
3,529,227	Windshield Wiper Control
3,564,374	Intermittent Control Device
3,573,584	Motor Speed Control

U.S. Patent	Title
3,593,090	Intermittent Windshield Wiper System
3,721,115	Structure for and Method of Surface Condition Sensing and Indicating and Motor Speed Control
3,737,750	Motor Speed Control
3,876,919	Structure for and Method of Surface Condition Sensing and Indicating and Motor Speed Control
3,902,106	Intermittent Windshield Wiper Control Device
4,339,698	Control Apparatus for Windshield Wiper System
4,494,059	Structure for and Method of Surface Condition Sensing and Indicating and Motor Speed Control
4,544,870	Intermittent Windshield Wiper Control System with Improved Motor Speed Control

The Chrysler Corporation and American Motors Corporation trial was dependent upon the validity trial in *Kearns* v. *Ford Motor Company* as Chrysler management desiring to avoid the expense and trouble of a validity trial stipulated to be bound by the validity trial in *Ford*.

IWWS are Federally regulated

The windshield wiper system is Federally regulated safety item:

> Federal Highway Administration Motor Vehicle Safety Standard No. 104 Windshield Wiping and Washing Systems (CAFC A-950)

The Intermittent Windshield Wiper feature operating alone is inherently dangerous

Dr. Kearns believes the Intermittent Windshield Wiper feature assembled into Chrysler products is inherently dangerous (A-). Trico management appreciated the inherent danger of intermittent windshield wiper operation in wet weather too and provided an

answer in their patent.[7] When the accumulation increases in the windshield wiping area from a change from misty to wet weather conditions visibility is impaired.

In all the years of the Vietnam War there were not as many as 55,000 U.S. citizens killed, yet each year on U.S. roads 55,000 die in automobile accidents. More than half of those accidents occur in wet weather yet the weather is not wet half the time.

There have been 700 million inherently dangerous Intermittent Windshield Wiper features produced through infringement and added to the roads

Through the process of infringement by Chrysler Corporation of U.S. patents that also contained in their specifications solutions to such problems, nominally 30 million Chrysler products were placed on the roads. Through the process of infringement by Ford Motor Company of the same U.S. patents, nominally 60 million such Intermittent Windshield Wiper features were added to the roads. Through the alleged (confirmed by experts) process of infringement by General Motors Corporation of the same U.S. patents, nominally over 100 million such Intermittent Windshield Wiper features were added to the roads.

There are pending in the Federal courts, patent infringement cases concerning the same and other U.S. patents invented by Dr. Kearns that are only the same partial embodiments of the solutions invented and presented to the U.S. Patent Office to make our planet "a nice place to live (and not die prematurely)." The number of such Intermittent Windshield Wiper features placed on the roads of the western world by the members of said automobile assembly industry constitute 700 million vehicles.

Safety teachings by Reister Trico U.S. Patent 3,339,123:

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[7] See U.S. Patent 3,339,123. Inventor: William C. Riester assignor to Trico Products Corporation, Buffalo, N.Y.

Col. 1, beginning line 62:
Col. 3, beginning line 1:
Col. 4, beginning line 72:
Col. 5, beginning line 42:

Safety teachings by R. W. Kearns in his U.S. Patent 3,351,836:

Col. 1, lines 47 - 53:
Col. 1, lines 69 - Col. 2, line 4:
Col. 2, lines 4 - 34:
Col. 2, lines 58 - 69:
Col. 3, lines 24 - 27:

Safety teachings by R. W. Kearns in his U.S. Patent 3,351,836: (con't.)

Col. 3, lines 37 - 43:
Col. 5, lines 58 - 60:
Col. 5, lines 70 - Col. 6, line 2:
Col. 6, lines 58 - 62:
Col. 7, lines 21 - 30:
Col. 9, lines 44 - 52:
Col. 12, lines 32 - 38:
Col. 12, lines 49 - 51:

Safety teachings of R. W. Kearns in his U.S. Patent 3,564,374:

ABSTRACT OF THE DISCLOSURE
Col. 1, lines 18 - 20:
BACKGROUND OF THE INVENTION
Col. 2, lines 3 - 63:
Col. 6, lines 29 - 48:
Col. 7, lines 17 - 39:
Col. 10, lines 13 - 20:
Col. 13, lines 19 - 45:

Safety teachings of R. W. Kearns in his U.S. Patent 3,602,790

Col. 1, lines 51 - 54:

Col. 5, lines 29 - 61:
Col. 6, lines 8 - 10:
Col. 7, lines 17 - 33:
Col. 7, lines 54 - 63:
Col. 10, lines 26 - 36:
Col. 13, lines 42 - 52:
The detailed teachings are given at (A. 22-28).

The teachings from
Westinghouse Co. v. *Formica Co.*,
226 U.S. 342, 350 (1924)

> The analogy between estoppel in conveyance of land and estoppel of a patent right is clear. If one lawfully conveys to another a patented right to exclude the public from making, using and vending of an invention, fair dealing should prevent him (the inventor) from derogating the title he has assigned, just as it estops a grantor of a deed of land from impeaching the effect of his solemn act as against the grantee. The grantor purports to convey the right to exclude others, in the one instance from a defined tract of land, and in the other, from a described and limited field of the useful arts.

Since the inventor signed the oath and filed the application, the inventor retains the right to narrow the scope of claims to be negotiated by the grantee.

With regard to this Petition, Dr. Kearns remained the inventor throughout the benefit that Chrysler received and spent. Chrysler received the benefit of being relieved of validity-litigation expense and troubles. Dr. Kearns is estopped from causing Chrysler validity-litigation expense and troubles.

Dr. Kearns, as inventor and signer of the oath, retains the right to oppose the broadening of his patent claims beyond that of the state-of-the-art where he negotiated them.

Chrysler's right to seek a narrowing of the Kearns claims was transferred to Ford in exchange for the benefit of the relief from validity-litigation expense and troubles. Ford, in behalf of Chrysler as well as itself, failed to narrow the scope of Dr.

Kearns' claims in six patents. Chrysler is estopped under fair dealing from narrowing the claims of Dr. Kearns' six (U.S. patent) claims.

Others, independently receiving the right to narrow Dr. Kearns' claims of the six patents, may seek to do so, at their validity-litigation expense and troubles. But there is no analogy under *Westinghouse* v. *Formica* for Chrysler to do so as it has already received and spent its benefit from Dr. Kearns.

Dr. Kearns answer to

Chrysler's Question (1)

> (1) Does the trial court in a patent infringement case have "discretion" to exclude evidence of prior art, offered by the defendant to construe the scope of the claims at issue, contrary to this Court's express holding in *Westinghouse Co.* v. *Formica Co.*, 266 U.S. 342 (1924), that even where the alleged infringer is precluded from challenging a patent's validity, such prior art evidence must be used to construe and narrow the claims of the patent so as not to invade the public domain?

The question (1) is clever in that in a single sentence it confuses a number of legal principles and the application of *Westinghouse* to this case. Dr. Kearns first fact is that *Westinghouse* has no effect on

> "an estoppel arising where man has done some act which the policy of the law will not permit him to gainsay or deny." 51 S.E. 514, 521. ('fair dealing')

Dr. Kearns' second fact is, to quote Chief Justice Taft in his *Westinghouse* opinion, beginning p. 351, line 7:

> Such evidence (that of construing and narrowing the claims of a patent from the state of the art) might not be permissible in a case in which the assignor made specific representations as to the scope of the claims and their construction, inconsistent with the state of the art, on the faith of which the assignee purchased; but that would be a special instance of estoppel by conduct. We are dealing only with the estoppel of an assignment based on the specifications and

claims without special matter *in pais*.

Dr. Kearns' third fact is that in *Westinghouse* the defendant construing the scope of the claims at issue was the assignor who assigned an invention to the assignee before the claims were negotiated between the assignee with the Patent Office.

Dr. Kearns' fourth fact is that in *Westinghouse*, after the assignment was made, the patent claims were expanded through assignee-Patent Office negotiation *ex parte* from the assignor.

Dr. Kearns' fifth fact is that all would admit that the trial court has the authority to enforce a stipulation entered into by the parties in a patent case to which he has been assigned.

Dr. Kearns' sixth fact is that Ford infringed the Kearns '836 and '374 patents with the Ford circuit (A. 29) that has the same components interconnected in the same way to achieve the same result as the circuit found infringed by Chrysler.

Chrysler's alleged Supreme Court 'express holding' is excluded from application here by the exclusionary clause stated in the opinion of Chief Justice Taft cited as the second fact above. In an analogy to the facts supporting this Petition, Dr. Kearns 'purchased' that Chrysler would be bound by the validity trial in *Kearns* v. *Ford* with the lawful tender 'that Dr. Kearns would not cause Chrysler Corp. further validity-litigation expense and troubles.' Under the 'just dealings' required by the first fact above, Dr. Kearns is estopped from 'causing Chrysler Corp. further validity-litigation expense and troubles' while Chrysler is estopped from reneging on being bound by the Kearns-patent-invalidity defense conduct of the Ford Motor Company and the validity-trial result achieved by the Ford Motor Company in *Kearns* v. *Ford*. In short, Chrysler has spent its benefit from the stipulation relying on Ford's expense and troubles suffered in the Kearns-patent-invalidity trial of *Ford* while Dr. Kearns has already suffered the Kearns-patent-invalidity trial expense and troubles of *Ford*.

Facts three and four in *Westinghouse* result in the patent claims being expanded to Formica's detriment without Formica being heard. Here Dr. Kearns' patent claims remained the same from before the stipulation to the present date and were always well-known to Chrysler and Ford. Moreover, the prior art was shared among the Kearns infringement case defendants. The prior art cited by Chrysler in support of its Petition here on pp. 4 - 6 was well known to Chrysler and the other Kearns infringement case defendants from before the signing of the Chrysler-Kearns stipulation. While unnecessary under the legal principles argued here, being *pro se* and cautious, Dr. Kearns distinguishes his patent claims from the prior art cited by Chrysler on pp. 4 - 6, later in this Opposition to show again that Dr. Kearns' claims are outside the prior art in the public domain.

All the above having been said, Judge Cohn was justified in enforcing the Chrysler-Kearns stipulation in this case.

In the facts supporting this Petition, after the stipulation was made, the patent claims were not expanded but remained as issued by the Patent Office.

The numbered claim element clauses of Dr. Kearns' patents found 'not to have been shown invalid' in *Kearns* v. *Ford* are given at A. 30.

With 25 claim element clauses for the '836 patent;

20 claim element clauses for the '374 patent;

and, 11 claim element clauses for the '790 patent;

Dr. Kearns knows there is no need to detail the infringement for this Court as for that many claim element clauses to be applicable to Chrysler's (so-called) circuit - it has to be a copy of Kearns' technology. (A. 30-38)

Dr. Kearns' answer to
Chrysler's Question #2

(2) Does a trial court in a patent infringement case have any "discretion" to preclude the defendant from showing that the

accused device is identical to the prior art in every respect relevant to the application of the patent claims allegedly infringed?

Two restrictive phrases make this question #2 unique. The first phrase is 'any' discretion. The second restrictive phrase is "identical to the prior art in every respect relevant."

In formulating the question, Chrysler attorneys' should know:

> "every element of claimed invention must be disclosed in single prior art reference to establish anticipation which would invalidate patent." *Solarex Corp.* v. *Arco Solar, Inc.*, 805 F.Supp. 252 (D.Del. 1992)

In support of such a difficult chore, Chrysler merely eludes at:

page	line	company	date	mechanism
5	5	Trico Corp.	1950's	engine vacuum diaphragm time delay mechanism & adjustable bleed valve
5	12	General Motors	1960's	bimetallic strip heated electrically
5	23	Motorola	1960's	
5	23	Lucas Industries	1960's	
5	23	Bosch	1960's	
5	23	Trico	1960's	"resistor-capacitor-transistor dwell interval"
5	23	General Motors	1960's	"resistor-capacitor-transistor dwell interval"
5	29	Mellor patent to Lucas Industries	1960's	"high-speed and low-speed continuous operation with low-speed parking"
6	1	Gute patent to General Motors	1960	"high- and low-speed continuous and low-speed intermittent"

page	line	company	date	mechanism
6	4	Moller patent to Bosch	1964	"electronic intermittent timing circuit in a two-speed system"
6	7	Japanese utility	1965	"electronic intermittent control ler with a two-speed motor"

Chrysler states:

> 6 33 "The verdict thus invaded the public domain by subject ing Chrysler to damages for using what was plainly available in the prior art. There is no real dispute about this point. Neither the trial court nor the Federal Circuit expressed any doubt that Chrysler's accused system was identical to the prior art for all purposes relevant to the application of the claims."
> (Emphasis added. - Wow!)

Dr. Kearns answers that his '836 claim 16 comprises 25 claim element clauses (A. 30); his '374 claim 6 comprises 20 claim element clauses (A. 32); and his '790 claim 14 comprises 11 claim element clauses (A. 36). Applying *Solarex*, *supra* let's review Chrysler's claim "Chrysler's accused system was identical to the prior art."

Starting with the bottom and rising through Chrysler's list we find and limiting the answer to only that required and pertinent:

Chrysler's IWW feature utilized the three-brush permanent magnet field wiper motor of Dr. Kearns' '790 patent while the translation from the Japanese contains no reference to usage of such a three-brush permanent magnet field wiper motor[8]. Moreover, notice there is no wiper-motor-driven switch shown or referred to in the Japanese disclosure. Thus, the blades wipe for a period of time (multiple wipes?) and dwell for a period of time with the blade stopping anywhere and at a different location within the wiping area during each dwell period. (Dr. Kearns views this

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[8] The translation from Japanese to English (A. 39-44) was done by the lady who translates from Japanese to English at the U.S. Patent Office.

Japanese system as unsafe and its use would increase the 55,000 fatalities that occur on USA roads each year.)

Chrysler's IWW feature utilized the three-brush permanent magnet field wiper motor of Dr. Kearns' '790 patent while the Moller patent to Bosch contains no reference to usage of such a three-brush permanent magnet field wiper motor. The operation would appear erratic with a dwell period not occurring after each cycle on a dry glass, for example.

Chrysler's IWW feature utilized the three-brush permanent magnet field wiper motor of Dr. Kearns' '790 patent while the Gute patent to General Motors contains no reference to usage of such a three-brush permanent magnet field wiper motor. A bimetal element can not deliver the short dwell periods required for safe visibility during wetter windshield weather conditions.

Chrysler utilizes a WWS that is intermittent. The patent of Mellor to Lucas Industries is not an intermittent system.

Chrysler's reference to (A. 268-272) is the Gute system already discussed by Kearns.

Chrysler's reference to (A. 251-267) is the Oishei system to Trico. Ford abandoned the Trico systems in favor of the Kearns technology. The reason was that the Trico system utilized engine vacuum from the internal combustion engine that was thought would interfere with the exhaust emission controls mandated by the U.S. government while the Kearns technology is independent of the engine and is dependent only on the battery. Through infringement of Dr. Kearns' technology, Ford was able to more completely integrate Ford's manufacturing operations by eliminating an outside-Ford supplier of windshield wiper controls and subsystems. Equitable relief to Dr. Kearns by this Court can still eliminate Ford's monopolistic advantage.

There is no further prior art for Dr. Kearns to answer. The New Yorker's *Annals of Invention: Windshield-wiper wars* "The Flash of Genius" at p. 44 of the January 11, 1993 issue concludes,

"Kearns' intermittent wiper was an elegant piece of engineering." (There must be some reason Dr. Kearns' technology is offered through infringement by every automobile assembler in the western world.)

Chrysler's claims to this Court "that the accused device is identical to the prior art in every respect relevant to the application of the patent claims" are simply not cogent.

Dr. Kearns' answer to
Chrysler's Question #3

> (3) Does Article 1, § 8, of the United States Constitution preclude the trial court in a patent case from permitting the jury to find infringement by construing a patent claim so broadly as to cover what is in the public domain?

In this *Kearns* v. *Chrysler Corp. and American Motors Corp.* patent case it has been shown *infra* that the prior art cited by Chrysler in its Petition does not permit Chrysler's infringement of Dr. Kearns' technology. Dr. Kearns believes that Chrysler's failure to include the moisture variable dwell time inventions of Dr. Kearns in its infringements contributes to an increase in automobile accidents on USA roads during wet-weather conditions. Chrysler's third question is not necessarily reached here.

* * *

35 U.S.C. § 283 injunction
for peace and trade

While the title of this response to Chrysler's Petition for a Writ of Certiorari is imposed upon the litigants as **Brief in Opposition**, Dr. Kearns would like to go on record in this response that he is not opposing the goals of the Chrysler Corporation: to market the 'best' automobile in the world; to market the 'safest' automobile in the world; and to market the 'classiest' cars, in the various age groups, in the world, and, all this at a profit to Chrysler Corporation shareholders and Kearns *Engineers* participants. In short, Kearns *Engineers* views Chrysler as their customer. Hopefully, Chrysler views Kearns *Engineers* as a

(potential) supplier having talent, patents and capabilities desirable to Chrysler Corporation stockholders.

Why would Chrysler management resort to having a young, inexperienced engineer, Mr. Orris, 'copy' Dr. Kearns' technology 19 days after a meeting with Chrysler's patent attorney, Mr. Santo, that occurred two months after Chrysler's production had started? Is the legal process helpful or harmful? To leave the safety features off the infringed invention for fear of making the inventor's case - seems counterproductive to Dr. Kearns. Can't our country field one team? Are we to destroy ourselves internally under the GATT treaty? Doesn't this Court have a role to play in promulgating the new rules?

Since the Chrysler infringement process failed to include the safety features that solve the inherent safety problems of IWWS, would Chrysler oppose having this Court return the 'limited times' consumed in the judicial process to Dr. Kearns in a § 283 injunction against Chrysler so that he would be enabled to supply such 'safe' IWWS to Chrysler products? Would the driving public oppose such as injunction? Would the U.S. Trade Representative oppose such an injunction?

Should this Court's Justices allow this opportunity to pass and the infringement result to stand (without including the safety features specified within the patents on Chrysler's products) would the Justices share in the responsibility for some of the continuing wet-weather accident deaths occurring on U.S. highways?

These are new times. These are times to be dominated by peace between nations. Competition between nations is to be expressed through trade. Not by trade directed toward obtaining an advantage over a competitor nation, but more in seeking to make this planet a nice place to live with each nation competing to contribute the 'most' to that goal through providing products and services at minimum 'cost' to all. These are the times of the General Agreement on Tariffs and Trade ("GATT") and the World Trade Organization ("WTO"). These are the times of adapting our

national laws to the deterrence of infringement of intellectual property rights while enlightened participating nations gain the improvements in their citizens' standard-of-living.

Does the Constitutional admonition to provide for the general Welfare and the promotion of science and the useful arts arising under the Constitution provide jurisdiction to enable the Justices of this Supreme Court to cite the civilized rule applicable to adjudged infringers who have reduced the wet-weather driving safety of their customers through the process of unlawfully acquiring and selling products based on unexpired IWWS patented art without utilizing as well, the moisture responsive dwell time solution to the inherent intermittent wiping wet-weather driving-safety problem solved in the same patents unlawfully acquired?

Petitioner has been adjudged the infringer of three of Dr. Kearns' patents which patent specifications contained solutions to the inherent safety problems for the use of intermittent windshield wiper systems on automobiles in wetter than misty weather. The patents were infringed by Chrysler without the infringement of the claims applicable to the solutions for the inherent safety problems. However else this practice may be described, such partial infringement plainly proffers causes of action by those suffering such accidents in wetter weather. The problem of partial infringement of U.S. patents containing safety features for their proper use is a problem worthy of this Court's rule making wisdom.

* * *

Civil actions for a remedy
to the inventor **and** the public
arise under the U.S. Constitution

That so many 'ticking' accidents are out there on the roads via publications arising out of Const. Art I § 8 Cl 8 is a perverse result from Dr. Kearns' 31 years of lawyer expense and troubles.

The unusual profits went to whom?

The automobile assemblers of the western world are in U.S. Federal Courts for the taking of partial solutions from the patent specifications that constitute full infringement of some of the patent claims of the same said U.S. patents. The partial-solutions appropriated into their "protected market" model-segment capture the inventor's "opportunity for **unusual profit** necessary to justify the heavy investment in time, effort, and capital necessary to bring the improvement to the public". Court records show Ford made an 80% profit on Intermittent Windshield Wiper receipts while Chrysler made an 82% profit on Intermittent Windshield Wiper receipts. (A. 45)

The competition drove the distribution of the external feature of the art while the part of the patent art specification offering 'best-mode' improved-safety in the use of the feature was ignored by the infringers.

The public is left with the traffic deaths and need for a remedy through the patentee[9].

§ 281 proffers a remedy only to the inventor but the following cases cite that the public interest is dominant or of equal importance with the inventor's interest.

> "[I]t is not the private use but ... the public interest which is dominant in the patent system[10]." *Mercoid Corp.* v. *Mid-Continent Co.*, 320 U.S. 661, 665.

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[9] Title 35 U.S. Code
§ 281. Remedy for infringement of patent
"A patentee shall have remedy by civil action for infringement of his patent."

[10] *Pennock* v. *Dialogue*, 2 Pet. 1; *Kendall* v. *Winsor*, 21 How. 322, 329; *Adams* v. *Burke*, 17 Wall. 453; *Motion-Picture Co.* v. *Universal Film Co.* 243 U.S. pp. 510-511; *Morton Salt Co.* v. *G.S. Suppiger Co.*, 314 U.S. 488, 493; *United States* v. *Masonite Corp.*, 316 U.S. 265, 278 ... The patent is a privilege. But it is a privilege which is conditioned by a public purpose ..."

Dawson Chem. Co. v. *Rohm and Haas Co.*, 448 U.S. 176, 221 (1980), reflects a shift towards recognition that the patent holder's rights and the public interest should be accorded equal weight in deciding patent cases.

The only remedy the patent law provides against infringement is to the patentee under §281. The patentee can only receive **§283 Injunction** relief and **§284 Damages** relief. **§284 Damage** relief is money to the inventor. Neglecting taxes, that money to the inventor does not return to the USA public its interest in the USA invented-product.

Where the invented-product is infringed and sold in high volume in a market segment controlled by the infringer within the worldwide market, the only place left for the public to gain its rightful interest from the invented-product under 35 U.S.C. is through a **§283 Injunction** remedy to the inventor.

Thus far in his civil action remedy trials, Dr. Kearns has completed two trials. Since § 283 is discretionary, in the first instance with the District Court, Dr. Kearns has been denied in both instances, a hearing at which he would present evidence supporting his right (and that of the public) to a § 283 injunction.

This perverse tragedy was not foreseen by the Founding Fathers

This perverse result from promoting the "useful arts" was not foreseen by the Founding Fathers.

Kearns *Engineers* (honestly) supplying through export the patented (worldwide) Intermittent Windshield Wiper Systems market via sub-assemblies would make a difference of +4.8% in USA exports.(A. 46)

CONCLUSION

Since Dr. Kearns has been denied § 283 relief in both the *Ford* and *Chrysler* trials and by the panel in the CAFC, there remains only this Supreme Court to intervene and attain the public interest.

APPENDIX

BEST AVAILABLE COPY

Kearns Design
Chrysler Design

DD/Aコンバータ
MODEL 840

新製品

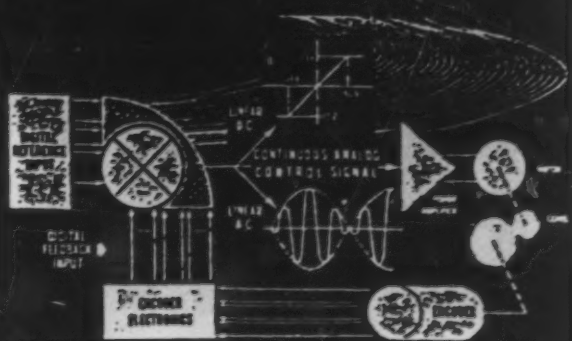
デジタル量の差を
アナログ量に
変換する装置

■超高精度

$\frac{1}{12億}$ %

■変換時間

2μsec.



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LIST OF CASES

Cases in the U.S. District Court for the Eastern District of Michigan Southern Division:

LITIGANT	CIVIL NO.
Kearns v. *Wood Motors, Inc.* *Daimler-Benz Akatiengesellschaft, and* *Dr. Ing. h.c.f. Porsche A.G.*	78-70642
Kearns v. *Ford Motor Company*	78-70740
SWF - Specialfabrik fur Autozebehor v. *Kearns* *Gustav Rau G.m.b.H.*, a corporation of the Federal Republic of Germany	79-74451
Kearns v. *Fred Lavery Porsche,* *Wood Motors, Inc.,* *Volkswagen Werks A.G., Wolfsburg, and* *Ausi NSU Union, A.G.*	82-70749
Kearns v. *Ferrari S.p.A.,* *AB-Volvo,* *Alfa Romeo, S.p.A.,* *Automobiles-Citroen, S.A.,* *Bayerische Motoren Werks, A.G.,* *B-L PLC (British Leland),* *Fuji Heavy Industries, Ltd.,* *Group Lotus Cars Co.,* *Honda Motor Co.,* *Isuzu Motor Co., Ltd.,* *Mitsubishi Motors Corp.,* *Nissan Motor Co., Ltd.,* *Officiene Alfiere Maserati,* *Peugeot, S.A.,* *Regie Nationale Renault,* *Rolls Royce Motors, Ltd.,* *Saab-Scania AB,* *Toyo Kogyo Co., Ltd.* (Mazda), *Toyota Motor Co., Ltd.,*	85-70459

LITIGANT	CIVIL NO.
Dealers in the Detroit area: *Barnett Pontiac-Datsun, Inc.*, *Bavarian Motor Village, Ltd.*, *Dagliesh Cadillac-Peugeot*, *Joe Dwyer Subaru Volvo, Inc.*, *Falvey of Troy*, *Grosse Pointe AMC-Jeep Renault*, *La Fontaine Toyota*, *Seaway Motors Inc.*, *Sports Car Exchange, Inc.*, *Tamaroff Buick-DMC-Honda-Rolls Royce*, *and Wood Motors, Inc.*	
Kearns v. *General Motors Corp.*	85-70461
Kearns v. *United Technologies Corp.* & *United Technologies Automotive, Inc.*	92-71408
Other cases:	
Kearns v. *United States*	U.S. Claims 436-84C
Kearns v. *United States*	U.S. Court of Appeals for the Federal Circuit 84-1849
Kearns v. *United States*	U.S. Supreme 85-645
Kearns v. *Fred Lavery Porsche Audi Co.*, *Wood Motors, Inc.*, *Volkswagenwerk, A.G.*, and, *Audi NSU Auto Union, A.G.*	U.S. Court of Appeals for the Federal Circuit 84-655

LITIGANT	CIVIL NO.
Kearns v. *Ford Motor Company, Wood Motors, Inc., Robert Bosch Corp., Daimler-Benz Aktiengesellschaft, Porsche, A.G., SWF-Specialfabrik fur Autozebehor Gustav Rau, G.m.b.H.*	U.S. Court of Appeals for the Federal Circuit 87-1356
Kearns v. *Chrysler Corp.* and *American Motors Corp.*	U.S. Court of Appeals for the Federal Circuit 92-1531

RECEIVED JAN 11 1980
WHITTEMORE, HULBERT & BELKNAP

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. CIVIL ACTION
NO. 78-70642

WOOD MOTORS, INC.
DAIMLER-BENZ AKTIENGESELLSCHAFT
and DR. ING. h.c.f. PORSCHE A.G.,

Defendants.,

MEMORANDUM OPINION AND ORDER
REGARDING PLAINTIFF'S MOTION
FOR A PRELIMINARY INJUNCTION

Plaintiff Dr. Robert Kearns is the owner of seven United States patents dealing with transistorized windshield wiper control systems. Kearns brought this action against three defendants for patent infringement in violation of 35 U.S.C. §271 (a) and 271 (b). This suit was begun on March 21, 1978, over 17 months later, plaintiff filed the instant Motion for a Preliminary Injunction. In this motion plaintiff requests that the defendants and their officers and agents be enjoined from infringing one of the seven patents.[1]

The parties have submitted extensive briefs on the propriety of a preliminary injunction in this case and have argued their positions orally. The primary point of contention between the parties concerns the standards which must guide the Court in considering a request for preliminary relief in a patent case. It is

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[1] The patent at issue in this motion is U.S. Patent No. 3,564,374 an intermittent control device. Dr. Kearns originally applied for this patent on December 1, 1964 and the patent has a date of issue of February 16, 1974.

this threshold question that the court must first turn.

Plaintiff has argued in its various submissions that the factors which govern the Court's exercise of discretion in every other preliminary injunction request are also fully applicable in patent litigation. Defendants on the other hand suggest that plaintiff in such motions faces a far stricter standard than that which obtains in the ordinary case.

To a certain extend plaintiff has correctly stated the law. As in other cases, the Court, in deciding such a motion, is required to weight four factors: plaintiff's probability of success on the merits; the irreparable injury suffered by plaintiff as a result of defendants' actions; the balancing of harm to the plaintiff if such relief is granted relative to the harm suffered by defendants if a preliminary injunction issues; and the public interest in granting or denying the injunction. However, in giving substance to these generalities, federal courts have attached various rules in patent cases which operate to make plaintiff's burden substantially greater.

This stricter standard is particularly apparent in examining plaintiff's probability of ultimate success. To establish this element plaintiff must prove his title to the patent, the patent's validity, and infringement on the part of defendant. But while in the ordinary preliminary injunction request plaintiff would have to prove these elements sufficiently to establish a strong or substantial likelihood of success on the merits, *see e.g., Mason County Medical Assn.* v. *Kneel*, 569 F.d 256 (6th Cir. 1977), this standard is not applicable in patent cases. Instead, the widely accepted rule is that entry of an injunction in patent litigation requires that title, validity, and infringement be established "beyond question" or "beyond a reasonable doubt". *See Mayview Corp.* v. *Rodstein*, 480 F.2d 714 (9th Cir. 1973); *Eli Lilly and Company, Inc.* v. *Generix Drug Sales, Inc.*, 460 F.2d 1096 (5th Cir. 1972); *Carter-Wallace, Inc.* v. *Davis-Edwards Pharmaceutical Corp.*, 443 F.2d 867 (2d Cir. 1971), *cert den.* 412 U.S. 929 (1973); *Leavitt* v. *McBee*, 124 F.2d 938 (1st Cir. 1942); 8 *Walker*

on Patents § 686 (Deller 2nd Ed., 1973.).[2]

Federal courts have recognized that validity and infringement can be established beyond question if there has been a prior adjudication of the patent in question or if there has bveen public acquiescence in the patent. Defendants have argues here that proof of either of these two elements is a prerequisite to injunctive relief in any patent case. It is therefore argues that because there has been no prior adjucication of the patent or prior acquiescence this motion must be denied.

The Court agrees that plaintiff cannot claim either of the two exceptions,[3] but the Court is unable to acdept the argument that proof of acquiescence or prior adjudication is a necessary precondition to the granting of prelimminary relief. The federal courts appear to have reached contradictory conclusions on this subject,

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[2] It has been suggested that the Sixth Circuit does not require such a high standard of proof. See Dorr and Duft "Patent Preliminary Injunction Relief" 60 J.Pat.Off.Soc. 597, 632 fn. 7 (hereinafter Dorr & Duft). The authors of that article reach that conclusion based on indications gleaned from the text of *City of Grand Rapids* v. *Warren Bros., Inc.*, 196 F. 892 (6th Cir. 1912), *Crescent Specialty Co.* v. *National Fireworks Dist. Co.*, 219 F. 130 (6th Cir. 1915) and Blount v. Societe' Anonyme Du Filtre, 53 F. 98 (1892). This conclusion is open to question in light of the near unanimity in the other federal courts favoring the stricter standard in cases for more recent than these three Sixth Circuit cases. See Dorr & Duft, *supra* at 632. Furthermore, drawing a firm conclusion from these cases is difficult because of an apparent inconsistency between the three holdings. The two earliest cases, *Blunt* and *City of Grand Rapids* may indeed be read as incorporating traditional preliminary injunction standards into patent litigation. The third case however casts some doubt on this reading. In *Crescent Specialty*, the Court stated that a preliminary injunction could be ordered where title was clear, plaintiff demonstrates a fair probability that the patents are valid, and "there is sufficient showing of public acquiescence therein", *id.* at 132. This seemingly mandatory proof of public acquiescence is surely not consistent with the Sixth Circuit's earlier rulings that traditional equitable principles would govern patent cases.

[3] Plaintiff has asserted that the officers of Daimler-Benz and Porsche made offers to settle this case shortly after the suit was filed. Plaintiff contends that this demonstrates that these defendants impliedly acknowledged these patents to be valid. The settlement offers are of little or no value in proving that defendants conceded validity or infringement, for they merely reinforce the position defendants have taken throughout this litigation, i.e., the costs of 2defending this suit exceed and possible liability for infringement they may have.

but in this Court's view the better rule of law is contained in the Fifth Circuit's decision in *Eli Lilly* v. *Generix Drug Sales, supra,* where the court held that plaintiff's burden of establishing validity and infringement beyond question "is ameliorated where the patent at issue has been the subject of long acquiescence or has been adjudicated to be valid". *Id.* at 1099. Thus while acquiescence or prior adjudication are not prerequisites to a preliminary injunction, absent proof of one of these elements; plaintiff has the difficult task of demonstrating validity and infringement beyond question by other evidence. Since plaintiff has presented no evidence of prior adjudication or acquiescence, it is this high standard which controls the Courts consideration of the motion for preliminary injunction.

In this memoranda in opposition to the plaintiff's motion defendants have argued that plaintiff is unable to prove validity or infringement beyond a reasonable doubt for any number of reasons. Of principal concern to the Court is the claim that the patent at issue here is invalid under 35 U.S.C. § 102(b) since it was "on sale" more than one year before the December 1, 1964 application filing date. Section 102 (b) of Title 35 provides that a person may be entitled to a patent unless:

> "the invention was ... on sale in this country more than one year prior to the last date of application for patent in the United States."

Defendants have asserted that one year before his application, dr. Kearns demonstrated a working model of his system to several employees and agents of the Ford Motor Company. Defendants have also submitted affidavits signed by Dr. Kearns and testimony given by Kearns in prior litigation which, in defendants' view, imply that these demonstrations were intended as a solicitation for the sale of the invention.

Plaintiff on the other hand has suggested that the demonstration of the patent before the Ford employees was designed for personal informational purposes only. It is claimed that the intermittent windshield wiper control system was not operational at this time, particularly in light of the fact that the system when house in the

automobile would have to withstand temperatures which might adversely affect the operation of the system which was demonstrated to the Ford engineers.

The Court has reviewed carefully the submissions of counsel on this issue and it must conclude that defendants have raised a reasonable doubt as to the validity of the patent under 35 U.S.C. § 102(b). A logical inference which can be drawn from statements made by plaintiff himself in prior testimony and affidavits is that he was most interested in becoming the Ford supplier for such wiper systems and that this was his direct goal in conducting the demonstration. It further appears from Dr. Kearns' testimony that the system was at the time of the demonstration in a marketable state.

It is neither necessary or prudent for the Court to go into great depth into the relative merits of the parties' position or the question of § 102(b)'s application. The ultimate disposition of this question of validity of the Kearns' patent must be left to a later time. But, in the present procedural context the Court is only concerned with whether plaintiff has established the validity of his patent beyond question. The Court must conclude that he has not.

Regardless of its conclusion on the merits of plaintiff's claim, the Court would be constrained go deny the instant motion because of plaintiff's failure to establish irreparable injury. As noted by the Supreme Court in *Sampson* v. *Murray*, 415 U.S. 61 (1974), "[t]he basis of injunctive relief in the federal courts has always been irreparable harm and inadequacy of legal remedies." *Id.* at 88.

Plaintiff has claimed several examples of irreparable harm which would result if a preliminary injunction is not issued. Plaintiff's primary argument is premised on his contention that, except for the defendants' infringement of his patents, plaintiff would be the major manufacturer and supplier of these systems. He has therefore argued that this status is being denied him while defendants continue infringing his patents. Plaintiff further claims that he may be forever denied a foothold in the market as a supplier of these goods since the patent at issue here expires in four years.

The Court notes that plaintiff's inability to become a supplier of defendants' allegedly unlawful use of plaintiff's patent does not establish irreparable harm. Such claims for lost profits if proved with sufficient definition at trial, could be the basis for a damage award which would fully recompense plaintiff for the violations. *See Panduit Corp.* v. *Stahlin Bros. Fibre Works*, 575 F.2d 1152 (6th Cir. 1978); *H.K. Porter Co., Inc.* v. *Goodyear Tire & Rubber Co.*, 536 F.2d 1115 (6th Cir. 1976).

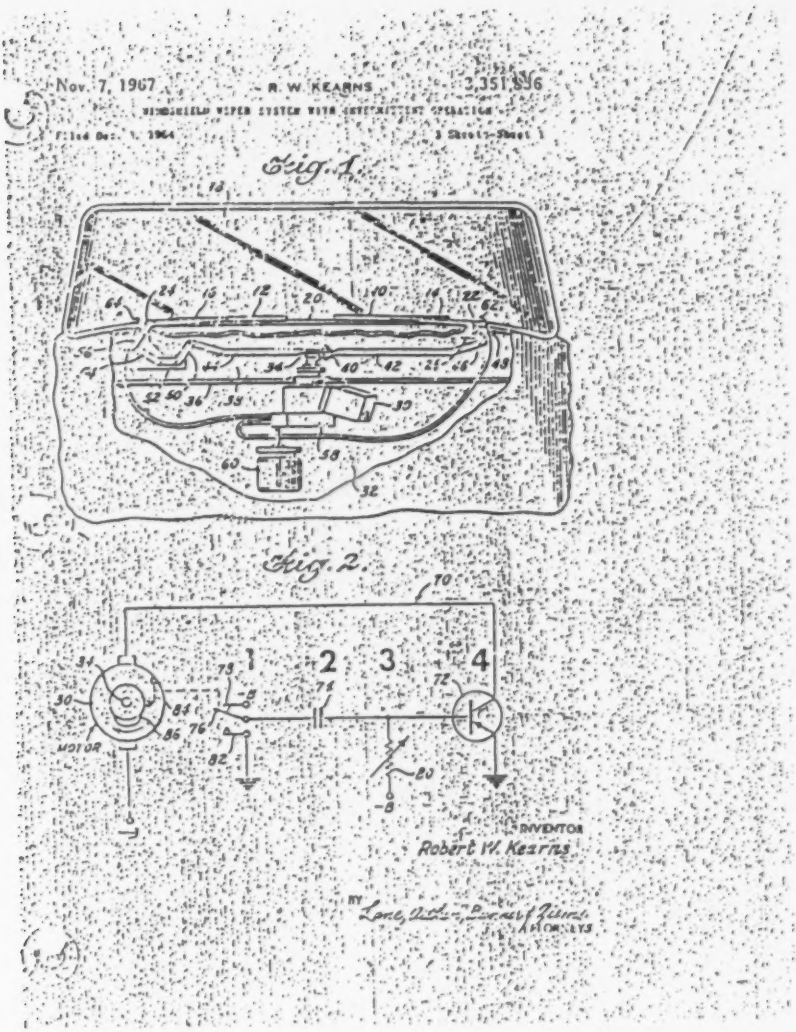
It is true that if plaintiff's patent were to expire prior to a decision finding the patent valid and infringed, the plaintiff's anticipated position as a major supplier of the windshield wiper systems would be under mined. The short answer to this contention is that this action will be completed before the expiration date of plaintiff's patent. The Court would therefore be able to enjoin the infringement of this patent if plaintiff is successful on the merits and plaintiff would be allowed the marketing foothold which he fears would otherwise be lost.

Pursuant to the foregoing, the Court will deny plaintiff's Motion for a Preliminary Injunction.

IT IS SO ORDERED.

/s/ Philip Pratt
PHILIP PRATT
United States District Judge

Dated: January 10, 1980
Detroit, Michigan


Nov. 7, 1967
R. W. KEARNS
3,351,836
Fig. 1.
Fig. 2.
MOTOR
INVENTOR
Robert W. Kearns

CONTROL AND INSTRUMENTATION

20524 RUTHERFORD AVENUE
NEAR EIGHT MILE & LODGE FREEWAY
DETROIT, MICHIGAN 48235
313 - 837-5515

PROPOSED CHRYSLER CIRCUITS

with

PATENTABLE FEATURES REPORT

Submitted to

Tann Controls Company

May 7, 1968

P 03979

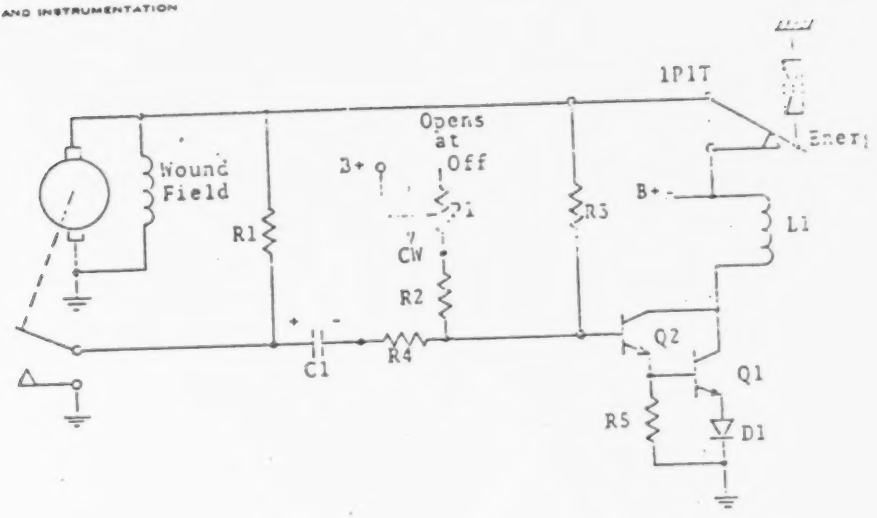
Submitted by:

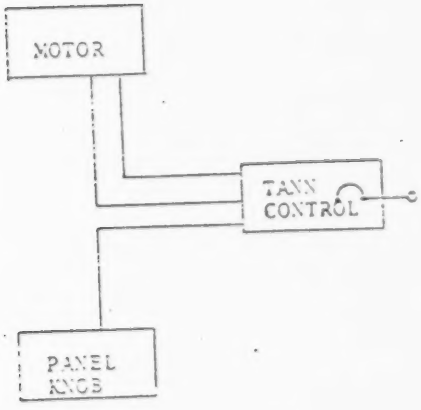
Robert W. Kearns, Ph.D.
Professional Engineer

CONFIDENTIAL

154 SUBJECT TO PROTECTIVE ORDER

A. 13





Price List

C1	11¢
D1	5¢
R1-R5	10¢
1P1T	35¢
Q1	9¢
Q2	9¢

Prt. Ckt. 13¢
Labor 13 min
Mount in Relay 92

FIGURE I-1

CONTINUOUS-TO-INTERMITTENT RELAY SYSTEM
WOUND FIELD MOTOR

P 039799

Inter Company Correspondence 7/69

File Code Date 6/27/75

	Division	Post Office	Code Number
C.E. THOMPSON	5727		
M.B. GRIFFIN	5727		

Subject EVALUATION OF INTERMITTENT WIPER CONTROL CIRCUITS

CENTRAL ENGINEERING'S PROPOSED INTERMITTENT WIPER CONTROL CIRCUITS "A" AND "B" HAVE BEEN BUILT AND EVALUATED. TESTS INCLUDED POSITIVE AND NEGATIVE TRANSIENTS AS WELL AS SUPPLY REVERSAL. ALL TESTING WAS DONE AT 25°C AMBIENT TEMPERATURE. THE FOLLOWING PROBLEMS WERE NOTED:

1. CIRCUITS WILL NOT SURVIVE -300 VOLT TRANSIENTS. (FAIL AFTER ONE PULSE)

2. THE SMALL SIGNAL NPN TRANSISTOR IN THE TIMING CIRCUIT IS SUBJECTED TO HIGH BASE CURRENT PULSES. (1.5 AMPS PEAK HAS BEEN MEASURED)

3. RELAY CLOSURE DURING POWER UP IS PROBABLY NOT LONG ENOUGH TO GUARANTEE MOTOR STARTING AND DWELL SWITCH ACTUATION. (RELAY CLOSURE IS ABOUT 60 MILLISECONDS)

4. NEITHER CIRCUIT CAN WITHSTAND SUPPLY REVERSAL.

5. SMALL POSITIVE TRANSIENTS OF 2 TO 5 VOLTS DURING DELAY INTERVAL CAUSE FALSE START UP.

DEFENDANT'S EXHIBIT 201

ICC
6/27/75

370

6. BOTH TRANSISTORS COMMON TO "A" AND "B" MUST BE HIGH GAIN PARTS. THE PNP'S MINIMUM GAIN IS ABOUT 100 WHILE THE NPN'S MUST BE GREATER THAN 500.

C.C. J.L. WEBSTER

United States Patent

[11] 3,581,178

[72] Inventor: Robert W. Kearns
20524 Rutherford, Detroit, Mich. 48235

[21] Appl. No. 815,060
[22] Filed Apr. 10, 1969
[45] Patented May 25, 1971

[54] WINDSHIELD WIPER CONTROL DEVICE
10 Claims, 4 Drawing Figs.

[52] U.S. Cl. 318/443
[51] Int. Cl. B60s 1/08
[50] Field of Search 318/443
(WW); 15/250.12, 250.02, 250.2

[56] References Cited
UNITED STATES PATENTS

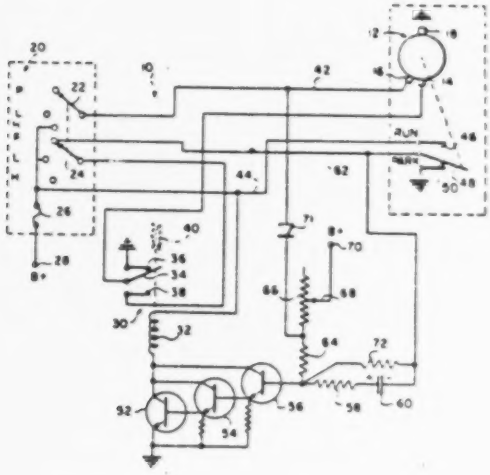
3,333,174	7/1967	Moller et al.	318/443
3,339,123	8/1967	Riessner	318/443

FOREIGN PATENTS

1,093,430	11/1954	France	318/339
1,285,849	1/1962	France	318/443

Primary Examiner—Oris L. Rader
Assistant Examiner—Robert J. Hickey
Attorney—Lane, Aitken, Dunner & Ziems

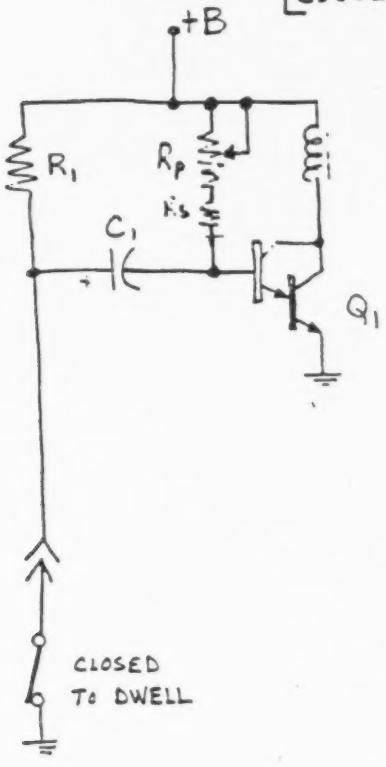
ABSTRACT: An electric control device controlling a wiper motor to operate windshield wiper blades intermittently with a dwell period between successive wiping cycles. The wiper motor current is carried by relay contacts and a solid state timing circuit controls the energization of the relay coil.



A. 17

INTERMITTENT WIPER CONCEPT 7-29-75

[CLOSED TO DWELL]



PLAINTIFF'S EXHIBIT 269

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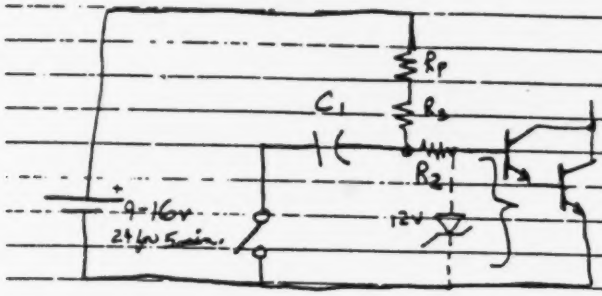
INTERMITTENT WIPER CONCEPT cont. 7-29-75

CASE I : Discharge C_1 thru dwell switch, battery and $R_p + R_s$

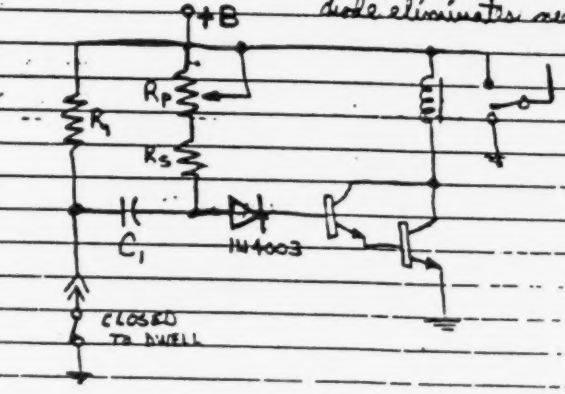


Max charge on C_1 = 24 VOLTS (WORST CASE) TRANSIENT COND.

In order to protect Q_1 → effectively a 12v zener in reverse condition R_2 is added to limit load current

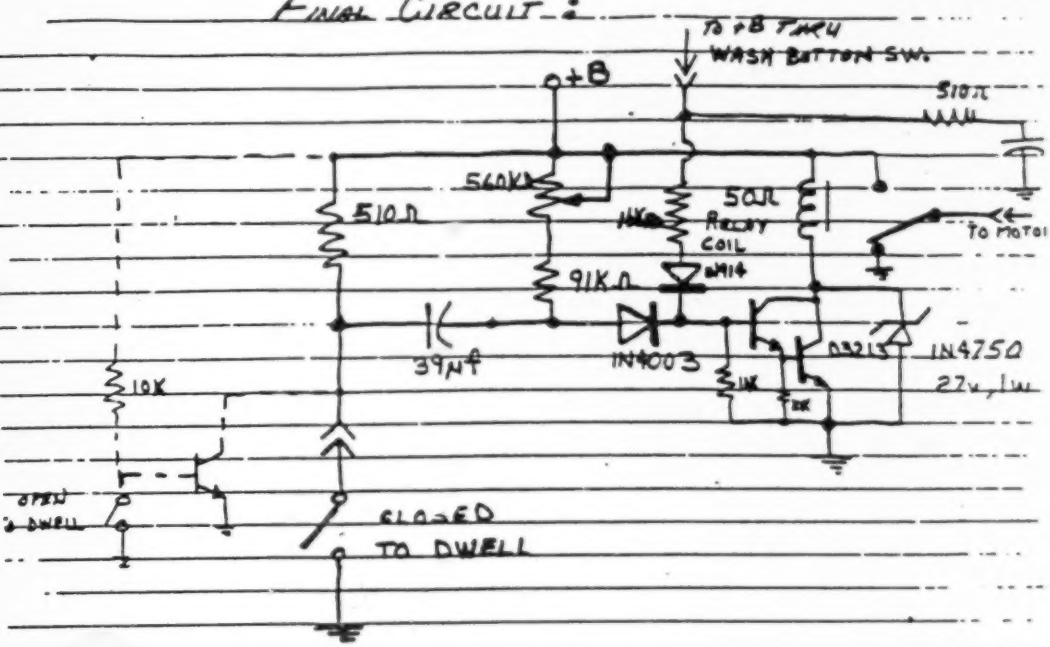
CASE II : DISCHARGE C_1 ⇒ TRANSISTOR will effect delay time if voltage is greater than 12 VOLTS

SOLUTION : ~~ADD~~ HIGH VOLTAGE ~~BREAK~~ DOWN DIODE diode eliminates need for R_2

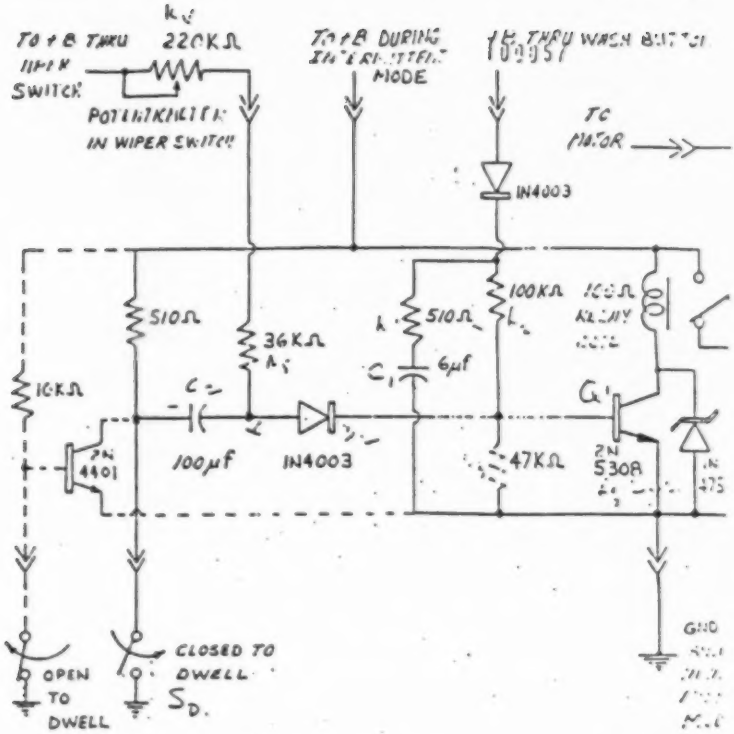


86

FINAL CIRCUIT :



91



INTERMITTENT WIPE CONTROLLER I

Symbiosis Plus
Steubenville, Ohio
8-11-75

8-11-75

A. 21

Safety teachings by R. W. Kearns
in his U.S. Patent 3,351,836

Col. 1, lines 47 - 53:

However, when the water on the windshield increases due to increased rain, or wheel spray from a vehicle which is being passed, it is very desirable to sense this change in condition of the windshield, automatically switch the wiper system to continuous operation whole this condition prevails and automatically switch back to intermittent operation when the condition no longer prevails.

Col. 1 lines 69 - Col. 2 line 4:

The present invention provides an intermittent windshield wiper system which is truly responsive to the condition of the windshield by utilizing the drag encountered by the wiper blade moving over the windshield to determine whether the wiper blades are stopped for a dwell period at the end of each cycle or whether the dwell period is skipped to provide continuous operation.

Col. 2 lines 4 - 34:

In accordance with one embodiment of the invention involving an electric windshield wiper system for automotive vehicles, the electric motor is deenergized at a predetermined point near the end of each wiping cycle to initiate a deceleration period during which the motor continues to rotate through a small angle due to the momentum of the system. During the decelerating period, the drag encountered by the wiper blades moving over the windshield exerts braking force on the motor which varies with the condition of the windshield. When the wiper blades are operating over a set windshield, such as during a heavy rainfall, they are well lubricated and the braking force is very small. When the braking force is significantly greater and decelerates the windshield wiping system faster during the decelerating period so as to bring the motor to a complete stop in a few number of degrees as compared to a wet windshield. By selecting a number of degrees (theta) between these two position and automatically re-energizing the motor after (theta) degrees, an effective degree-of-dryness control

is achieved. When the windshield is very wet, the motor is re-energized to start another wiping cycle before the windshield wipers come to a complete stop during the decelerating period. This skips the dwell period and provides continuous operation. When the windshield is wet-dry or dry, the windshield wipers come to a compete stop during the decelerating period before the rotor rotates through (theta) degrees. This starts a dwell period and suitable means is provided for energizing the motor at the end of the dwell period to start another cycle of operation.

Col. 2 lines 58 - 69:

The transistor is shut OFF when the motor is deenergized near the end of each wiping cycle and automatically turned back ON by an RC time constant circuit to re-energize the motor after a predetermined dwell period if the system stops for a dwell period in response to the condition of the windshield. If the condition of the windshield dictates that the dwell period be skipped by re-energizing the motor before the system comes to a compete stop as described above, the transistor is automatically turned back ON after (theta) degrees of rotation to re-energize the motor and start the next cycle.

Col. 3 lines 24 - 27:

It is another object of the invention to provide a windshield wiper control system for automatically operating windshield wipers intermittently or continuously in response to the degree-of-dryness of the windshield.

Col. 3 lines 37 - 43:

It is a still further object of the invention to provide a windshield wiper control system wherein the wiper motor is deactivated for (theta) degrees near the end of each wiping cycle and the drag encountered by the wipers on the windshield determines whether the wipers stop at the end of a cycle for a dwell period or continue into the next wiping cycle.

Col. 5 lines 58 - 60:

In the event a heavier rainfall is encountered, or water is sprayed

on the windshield from a vehicle being passed, the dwell period is automatically skipped.

Col. 5 lines 70 - Col. 6 line 2:

However, as soon as the rainfall decreases, or the vehicle is passed so that water from the road is no longer sprayed onto the windshield, the wiper blades will automatically stop for a predetermined dwell period at the end of each wiping cycle.

Col. 6 lines 58 - 62:

By adjusting the system so that the motor 30 does not stop in (theta) degrees under wet windshield conditions, but does stop in (theta) degrees under wet-dry windshield conditions, the desired continuous or intermittent operation is achieved automatically.

Col. 7 lines 21 - 30:

For example, a spring or other type of biasing force could be positioned to engage an element of the wiper system at a predetermined point in each wiping cycle to apply a controlled mechanical decelerating force thereto during the decelerating period to assist the drag on the wiper blades on the windshield in bringing the motor to a complete stop when the windshield is in a wet-dry condition to start a dwell period, and to skip the dwell period when the windshield is in a set condition.

Col. 9 lines 44 - 52:

Depending upon the degree-of-dryness of the windshield the motor will either continue to rotate through the angle (theta) and thereafter release the movable contacts **76** and **92** to re-energize the motor to start another wiping cycle (continuous operation), or the motor will come to a stop before the movable contacts **76** and **92** are released so that the wiper blades will dwell for a period determined by the length of time the transistors **122-126** are OFF.

Col. 12 lines 32 - 38:

If the mechanical braking, together with electrodynamic braking, is insufficient to stop the motor in (theta) degrees (the decelerating period) the contacts **76** and **92** return to the position illustrated and automatically reenergize the motor in the same manner as the

circuit of FIG. 4 to skip the dwell period.

Col. 12 lines 49 - 51:

Thus a decrease in the value of the resistor **184** will cause automatic switch between continuous and intermittent to take place when the windshield is drier.

Safety teachings of R. W. Kearns
in his U.S. Patent 3,564,374

'374 ABSTRACT OF THE DISCLOSURE

Col. 1, lines 18 - 20:

In the intermittent operation the wiper blades are responsive to the condition of the windshield.

BACKGROUND OF THE INVENTION

Col. 2, lines 3 - 9:

However, when the water on the windshield increases due to increased rain, or wheel spray from a vehicle which is being passed, it is very desirable to sense this change in condition of the windshield, automatically switch the wiper system to continuous operation while this condition prefails and automatically switch back to intermittent operation when the condition no longer prevails.

Col. 2, lines 14 - 63:

The patent to Oishei et al. 3,110,056, discloses a cam actuated switching arrangement for causing a windshield wiepr system to dwell at the end of each wiping cycle and provides an additional control responsive to acceleration of the vehicle for changing the intermittent operation to continuous operation. The latter control ;includes a switch mounted for actuation by the accelrator pedal of the vehicle or means responsive to the engine intake manifold vacuum. Thjerefore it is apparent that this arrangement is not responsive to the condition of the windshield.

I have found that n intermittent windshield weiper system which is truly responsive to the condition of the windshield can be

provided by utilizing the drag encountered by the wiper blades moving over the windshield to determine whether the wiper blades are stopped for adwell period at the end of each cycle or whether the dwell period is skipped to provide continouous operation. In accordance with one embodiment involving an electric windshield wiper system for automotive vehicles the electric motor is ded-energized at a predetermined point near the end of each wiping cycle to initiatte a declerating period during which the motor continues to rotate through a small angle due to the momentuym of the system. During the decelerating period, the drag encountered y the wiper bladesd moving over the windshield exerts a braking force on the motor which faries with thte conidition of the windshield. When the wiper lades are operarting over a wet windshield, suhj as during a heavy rainfall, they are well lubricated and the braking force is very small. When the wiper glades are operating over a wet-dry windshield, the braking force is significantly greater and decelerates ther windshield wiping systewm faster during the decelerating period so as to bring the motor to a complete stop in a fewer numvberr of degrees as compared to a wet windsheield. By selecting a number of degrees (theta) between these two positions and automatically re-energizing the motor after (theta0 degrees an effective degree-0f-dryness control is achieved. When the windshield is very wet, the motor is re-energized to start another wiping cycle before the windshield wipers come to a complete stop during the decelerating period. This skips the dwell period and sdprovides continuous operation. When the windshield is wet-dry or dry, the windshield wipers come to a complcte stop during t hde decelerating period before the motor rotates through (theta) degrees. This start a dwell period and suitable means are provided for energizing ;the motor at the end of the dwell p[eriod to start another cycle of operation.

In order to reduce the movement of th4e windshield wiper system during the decelerating period after the motor is de-energized near the end of a wiping cycle (that is, to reuduce the angle theta), additional means may be provided for decelerating the windshield wiper system. This can take the forjm of spring

elements positioned to cooperativsedly engage elements of the windshield wiper system to absorg some of the kinetic energy of the system during dthe decelrating period,d or electrical or maechanical braking meansw associated with the motor ror oth4er elements of the system. In the preferred emvbodiment, the motor is electrically braked by cosdnnecting a braking resistor thereacr-soss to dynamically brake the motor during the decelerating period. Th3 value sof the resistor is carefully selected so as to cooperate with thedrag ewncxountered by the windshild wipers moving across the windshield to bring the system to a stop in a small number of degrees after the motor is de-energized, but still at different angular position depending ont he condition of the windshield. This in effect reudced the aforementioned angle theata.

In a;ccordance with another important feature, a transistor is employed in the control circuit for controlling the operation of the windshield wiper system. The transistor is shut OFF when the motor is de-energized near the end of each wiping cycle ;and automatically turned back ON by an RC time contant circuit to re-energize the motor after a prerdetermined dwell period if the system stops for a dwell period in response to the condition of the windshield. If the condition of the windshield dictates that the dwell period be skipped by re-energizing the motor before the system comes to a compete stop as described above, the transistor is automatically turned back ON after theta degrees of rotation to re-energize the motor and start the next cycle. The lebngth of thedsdwell period is very conventient;y controlled by a variable resistor in the RC time constant circuit.

Col. 6 lines 29 - 31:

In the event a heavier rainfall is encountered, or water is sprayed on the windshield from a vehicle being passed, the dwell period is automatically skipped.

Col. 6 lines 42 - 44:

However, as soon as the rainfall decreases, or the vehicle is passed so that water from the road is no longer sprayed onto the windshield, the wiper blades will automatically stop for a predeter-

mined dwell period at the end of each wiping cycle.

Col. 7 lines 29 - 34:

By adjusting the system so that the motor 30 does not stop in (theta) degrees under wet windshield conditions, but does stop in (theta) degrees under wet-dry windshield conditions, the desired continuous or intermittent operation is achieved automatically.

Col. 7 lines 66 - Col. line 1:

For example, a spring or other type of biasing force could be positioned to engage an element of the wiper system at a predetermined point in each wiping cycle to apply a controlled mechanical decelerating force thereto during the decelerating period to assist the drag on the wiper blades on the windshield in bringing the motor to a complete stop when the windshield is in a wet-dry condition to start a dwell period, and to skip the dwell period when the windshield is in a set condition.

Col. 10 lines 13 - 20:

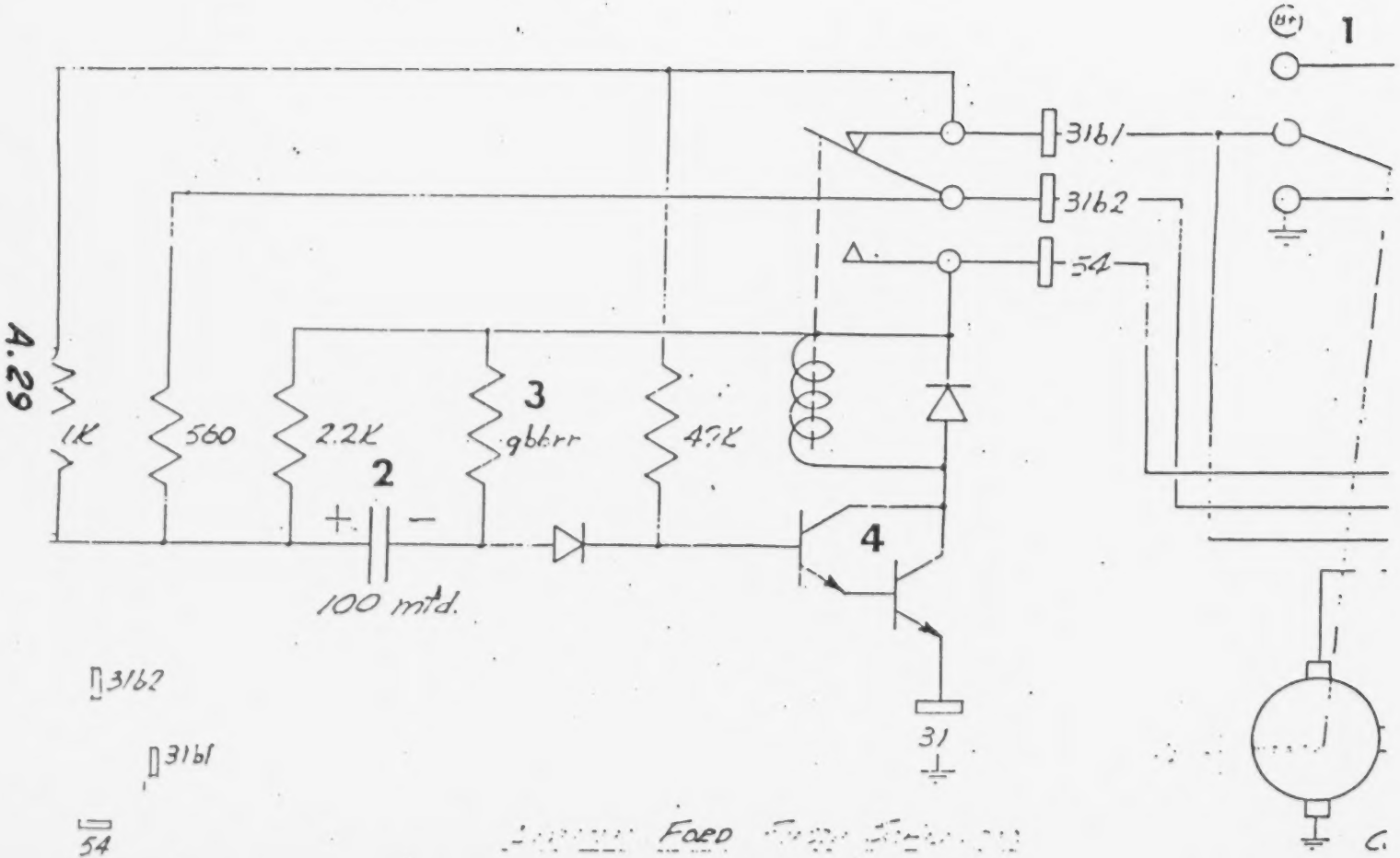
Depending upon the degree-of-dryness of the windshield the motor will either continue to rotate through the angle (theta) and thereafter release the movable contacts **76** and **92** to re-energize the motor to start another wiping cycle (continuous operation), or the motor will come to a stop before the movable contacts **76** and **92** are released so that the wiper blades will dwell for a period determined by the length of time the transistors **122-126** are OFF.

Col. 13 lines 11 - 17:

If the mechanical braking, together with electrodynamic braking, is insufficient to stop the motor in (theta) degrees (the decelerating period) the contacts **76** and **92** return to the position illustrated and automatically reenergize the motor in the same manner as the circuit of FIG. 4 to skip the dwell period.

Col. 13 lines 29 - 32:

Thus a decrease in the value of the resistor **184** will cause automatic switch between continuous and intermittent to take place when the windshield is drier.


A.29
1K
560
2.2K
3
9bbrr
47K
2
+
−
100 mfd.
4
(B+)
1
3161
3162
54
31
3162
3161
54

The numbered claim element clauses of Dr. Kearns' patents found 'not to have been shown invalid' in *Kearns* v. *Ford*

CLAIMS OF KEARNS' PATENTS

U.S. PATENT 3,351,836

Claim 16 of the '836 patent

No.	Claim element clause
12.	
1.	In a windshield cleaning system,
2.	electric motor driven windshield wiper drive means for driving wiper blade means across the windshield in repeating wiping cycles, and
3.	automatic control means for energizing said motor intermittently to produce complete wiping cycles with each wiping cycle followed by a a predetermined dwell period,
4.	said control means including
5.	transistor switch means for energizing said motor to initiate a wiping cycle and
6.	deenergizing said motor to terminate a wiping cycle,
7.	timing means to determine said predetermined dwell period, and
8.	switch means responsive to the position of said drive means for conditioning said timing means to bias said transistor switch means off

No.	Claim element clause
9.	at the end of each wiping cycle for said predetermined dwell period.
16.	The invention as defined in claim 12 wherein said automatic control means includes
10.	manually activated switch means for selectively connecting said drive means and transistor switch means in a continuous position for continuous operation of the drive means without dwell periods and
11.	in an intermittent position for said intermittent operation of said drive means.

CLAIMS OF KEARNS' PATENTS (Con't.)

U.S. PATENT 3,564,374

Claim 6 of the '374 patent

No.	Claim element clause
Claim 3.	
1.	A control device for activating motor driven windshield wiper drive means for driving wiper blades across a windshield in repeating wiping cycles comprising:
2.	(1) a timing circuit for determining repeated spaced time intervals comprising
3.	a capacitance,
4.	a resistance, and
5.	circuit means to charge said capacitance between said time intervals to provide a voltage across said capacitance at the start of each of said intervals and to connect said resistance to one side of said capacitance in an RC circuit during said intervals,
6.	said circuit jumping the potential applied

No. Claim element clause (Con't)

to the other side
of said capacitance
at the start
of each of said intervals
in a direction
to increase the voltage
across said resistance,

7. said circuit means
terminating said intervals
when the voltage
across said resistance
drops to a predetermined level,
and

8. (2) activating means
including said timing circuit
for activating said drive means
intermaittently
to provide dwell periods
between successive wiping cycles,

9. said activating means
terminating each dwell period
to initiate a wiping cycle
when the circuit means terminates
a time interval
determined by said timing circuit.

Claim 5.

A control device
as recited in claim 3
wherein
said circuit means includes

10. an electronic valve
having a first conductive condition
and a second conductive condition,

No. Claim element clause (Con't)

11. said circuit means
connecting said electronic valve
to said resistance
during said intervals
in a manner to switch
said electronic valve
from said first condition
to said second condition
to terminate each of said intervals
in response to the voltage
across said resistance
dropping to said predetermined level.

Claim 6. A control device
as recited in claim 5
wherein

12. said circuit means
includes a DC source,
wherein

13. the switching
of said electronic valve
from said first condition
to said second condition
is in response to the voltage
between a pair of electrodes
of said electronic valve
having a predetermined polarity
and reaching a predetermined level,
and

14. wherein during said intervals
said circuit means
connects said resistance
between one side of said capacitance
and one side of said DC source,

No. Claim element clause (Con't)

15. connects one of said electrodes
to the other side of said DC source,
and

16. connects
the other one of said electrodes
to said resistance,
whereby

17. the voltage
between said electrodes
will reach the predetermined level
with said predetermined polarity

18. to cause said electronic valve
to switch

19. from said first condition
to said second condition
when the voltage
across said resistance
drops to the predetermined level

20. at which said circuit means
terminates said intervals.

CLAIMS OF KEARNS' PATENTS

U.S. PATENT 3,672,790

Claim 14 of the '790 patent

No.	Claim element clause
Claim 9	
1.	A windshield wiper system for automotive vehicles comprising
2.	a DC motor connected to drive at least one windshield wiper blade through wipe cycles on an automotive vehicle windshield,
3.	said motor having three brushes so that
4.	the greater portion of said armature winding is energized when voltage is applied between a first pair of said brushes
5.	than is energized when voltage is applied between a second pair of said brushes so that
6.	said motor will run at a higher speed when energized between said second pair of brushes,
7.	motor control means having
8.	first and
9.	second conditions and

No. Claim element clause (Con't)

10. energizing said motor
between said first pair of brushes
in said first condition
and

11. energizing said motor
between said second pair of brushes
in said second condition,

12. said motor control means
in only one
of said first and second conditions

13. being operable to energize said motor
intermittently to drive said wiper
blade through repeated wipe cycles

14. with a dwell period occurring automatically at the end
of each of said wipe cycles,
and

15. a switch control movable between
first
and

16. second positions
to place said motor control means
in said first condition
or in said second condition.

13. A windshield wiper system
as recited in claim 9
wherein

17. said motor control means
comprises

18. a capacitance,

19. a resistance,

No. Claim element clause (Con't)

20. a circuit
connected to vary the charge
on said capacitance
by current flowing through
said resistance
during said dwell period,
and

21. means
responsive to the charge
on said capacitor
reaching a predetermined level
to energize said motor
to end said dwell period.

14. A windshield wiper system
as recited in claim 13
wherein

22. said means responsive
to the charge in said capacitance
reaching a predetermined level
to energize said motor
comprises

23. a solid state electronic valve
connected in a circuit

24. to become conductive
when said capacitance
reaches said predetermined level
and

25. means responsive to
said electronic valve
becoming conductive
to energize said motor.

Translation of Japanese Utility Model Patent
Publication No. 40-11768,
published April 28, 1965;
application No. 38-9445,
filed February 16, 1963;
inventor Takenori Suzaki.

AUTOMOBILE WIPER OPERATING DEVICE

Figure:

Figure is the circuit diagram of this invention.

Specification:

Usually, the movement speed of wiper for wiping automobile windshield is set as the two steps of high and low speed. But, in the case of drizzling rain, it is annoying for the eyes even by the slow speed movement of wiper. But the wiper of this invention was contrived as to move intermittently during drizzling rain without having said disadvantage.

Now, this invention is explained by figure. (W) is the wiper and moves right and left (both sides) by the motor (M) in a casing (G). (D) is the switch-box, which adjusts the speed of wiper (W), and contact-points (C_5, C_8, and C_{10}) and contact points (C_6, C_7 and C_9) are oppositely provided, respectively. An operating lever (L) is in and out movably inserted at the middle. By pulling out said lever toward F' direction, the contact piece (P) of lever end changes the contact position (II), which contacts contact points (C_5 and C_6) and the contact position (III) which contacts contact points (C_9 and C_{10}), successively. A position (I) indicates the starting position, which the contact-piece (P) is not contacted with any of contact points. Also contact points (C_6 and C_7) are short-circuited.

The contact point (C_5) is inserted in the low speed circuit of motor (M), and the contact point (C_8) is inserted in the high speed circuit of motor (M). The contact point (C_{10}) is earthed. Also, the contact point (C_7) is connected to an electric source (B).

(A) is a timing circuit containing a transistor (T), and (E) is a relay, which is operated by said timing circuit. The base (B) of transistor (T) in the timing circuit is connected at the contact point (C_9) through resistance (R_1) and condenser (C). The unipolar of electric source (B) is connected to an emitter (E) and a movable contact piece (P_1). The middle of contact point (C_9) and condenser (C) is connected at the one end of relay coil (F) also is connected with the movable contact piece (P_2). Usually, the contact pieces (P_1) and (P_2) are maintained at the solid line position by the action of spring and connected to the contact points (C_1 and C_3). But when the relay coil (F) is excited, it is drawn in and moves to the position of dotted line, respectively. The contact piece (P_1) connects to the contact point (C_2), and the contact piece (P_2 contacts to a stop (C_4).

The contact point (C_2) connects to the middle of motor (M) and the contact point (C_5). The other end of relay coil (F) has been connected to the collector (C) of transistor. The middle of resistance (R_1) and the condenser (C) has been connected to the contact point (C_3) via resistance (R_2).

The resistances (R_1) and (R_2) are combined with the condenser (C) and decide the time constant. At the same time, the resistance (R_1) acts as the resistance of transistor and base (B).

Now the function of this device is explained.

(a) In the case of operating lever (L) locating at the position (I) in the switching box (D), the wiper (W) is in the stop condition.

(b) In the case of the operating lever (L) locating at the position (II), the low speed circuit of wiper motor (M) works because the contact piece (P) short circuits the contact points (C_3) and (C_5), and the wiper (W) continuously swings right and left (both sides) by low speed.

(c) In the case of the operating lever (L) locating at the position (III), the contact piece (P) short-circuits the contact points (C_7) and (C_8), and the high speed circuit of motor (M) works. Then, the wiper (W) continuously swings by high speed.

(d) When the operating lever (L) reaches to the position (IV), the contact piece (P) short-circuits with the contact point $(C_9)_2$ and places the timing circuit (A) at the working condition. Then, an electric current flows from the circuit of the electric source (B) → transistor, emitter (E) → base (B) → resistance (R_1) → condenser (C) → contact points (C_9), (C_{10}) → earth (⏚).

Therefore, the transistor (T) enters to the working condition, and the relay coil (F) excites by the circuit of emitter (E) → collector (C) → relay coil (F) → contact points (C_9), (C_{10}) → earth (⏚). Then, the contact pieces (P_1) and (P_2) are drawn to the dotted line position, respectively. Consequently, the wiper (W) starts the sweeping movement by the circuit (⎍) of electric source (B) → contact point (C_2) → motor (M) → earth (⏚), and a short while after the condenser (C) is charged. Then circuit (T) current stops, at the same time, the plus side of condenser charging voltage becomes to the reverse bias to the transistor. Then, the transistor (T) becomes inactivity. Also, the circuit (⎍) becomes inactivity. Therefore, the relay coil (F) excites, and the connect pieces (P_1) and (P_2) return to the solid line position, respectively. At the same time, the current of circuit (⎍) stops, and the swinging movement of wiper (W) stops. Then the charging voltage of condenser (C) starts to discharge from the resistance (R_2) → connect piece (P_2) → earth, and the reverse bias of base of transistor is removed. And again the transistor works, and said circuits (⎍) (⎍) (⎍) work, successively, and the movement of wiper starts.

As explained above, the wiper (W) intermittently swings by time constant by combining the resistances (R_1) (R_2) and the condenser (C). Therefore, the annoyance of eyes by the wiper movement is eliminated. At the same time, because of using timing circuit of transistor by this invention, the structure is simple and the capacity of device is small. Also, the cost of maintenance is low.

Moreover, if a variable resistance is used for the resistances (R_1) and (R_2), the spacing time of wiper movement and stop is expectedly adjustable.

Claim.

An automobile wiper operating device provided the contact points for high speed driving and low speed driving of wiper in a switching box (D), also the contact points (C_9) and C_{10}) were provided, which allowed the insertion of circuit (A) when the transistor was used. Also, the contact point (C_{10}) was earthed (⏚), and the contact point (C_9) was connected to the transistor base via the condenser (C) and the resistance (R_1), and the electric source (B) was connected to the emitter and the movable contact piece (P_1). The middle of contact point (C_2) and the condenser (C) was connected to one end of relay coil (F) and the movable contact piece (P_2). The other end of relay coil (F) was connected to the transistor collector. Usually the movable contact piece (P_1) is at "off" position, and the movable connect piece (P_2) is connected at the middle of resistance (R_1) and the condenser (C) via the resistance (R_2). Then, the movable contact piece (P_1) connects to the motor circuit by the excitation of relay coil, and the movable contact piece (P_2) is as to move at the "off" position.

特許庁　　実用新案出願公告
00 H 5　　実用新案公報　　昭40-11763
公告　昭40. 4. 23
（全2頁）

自動車ワイパー操作装置

実願　昭 38-94465
出願日　昭 38. 2. 16
考案者　出願人に同じ
出願人　鈴木良利
東京都大田区久ヶ原町356
代理人　弁理士　斉井秋雨

図面の簡単な説明

図面は本考案装置の回路図である。

考案の詳細な説明

普通、雨天に際し自動車の窓ガラスを拭拭するワイパーの運動速度を高速2段に変更できるようになつているが、微雨の場合、この速度でもワイパーの動きが目に煩わしいことが多い。本案によると、此の欠点を除き、微雨に際してはワイパーを間歇的に動かすように工夫した。

今、図面に就き説明すると、図中Wはワイパーでケーシング C 内のモーター M により左右運動する。D はワイパーW の運転速度を変速するスイッチ函で、その内面に接点 C_1、C_2、C_{10} と接点 C_3、C_7、C_9 をそれぞれ対設し、中間に操作杆 L を出し入れ自在に挿入し、該杆を矢 F′ の方向へ引出すことにより杆端の接片 P が接点 C_1、C_2 と接触する位置 I、接点 C_7、C_8 と接触する位置 II 及び接点 C_9、C_{10} と接触する位置 III と順次接触位置を変更する。尚位置 I は接片 P が何物にも接触していない最初位置を示す。又接点 C_8、C_9 に短絡されている。

接点 C_1 はモーター M の低速巻線内に、接点 C_2 はモーター M の高速巻線内に挿入され接点 C_{10} はアースされている。又、接点 C_7 は電池 B に接続している。

A はトランジスター T を含む時限回路、又 B は整流整圧器により操作されるリレーである。尚図面に於てトランジスター T のベース B は抵抗 R_1 とコンデンサー C を介し接点 C_3 に接続し、電池 B の一極はエミッター E と可動接片 P_1 に接続し、接点 C_4 とコンデンサー C の中間はリレーコイル F の一端と接続し又可動接片 P_2 とも接続している。尚両接片 P_1、P_2 は夫々位置にスプリング作用により保持され、接点 C_1、C_2 と接触しているがリレーコイル F が励磁すると、之れにより吸引されそれぞれ点線位置へ動き接片 P_1 は接点 C_2 に、又接片 P_2 はストップ C_4 と接触する。

接点 C_3 はモーター M と接点 C_4 の中間に接続しリレーコイル F の他端子はトランジスターのコレクター C と接続している。抵抗 R_1 とコンデンサー C の中間に抵抗 R_2 を介し接点 C_3 と接続している。

抵抗 R_1、R_2 はコンデンサー C と組合わされて時定数を決定すると共に抵抗 R_1 はトランジスター、ベース B 抵抗として作用する。

次に本考案の作動を説明すると、

（a）スイッチ函 D に於て操作杆 L が位置 I にある場合はワイパー W は停止状態にある

（b）操作杆 L が位置 I にある場合は接片 P が接点 C_1、C_2 を短絡するのでワイパーモーター M の低速回路が作動しワイパー W は低速で左右往復的に運動する。

（c）操作杆 L が位置 II にある場合、接片 P は接点 C_7、C_8 を短絡しワイパー M の高速回路が作動し、ワイパー W は高速で往復的に運動する。

これまでは現行のワイパー操作装置の作動と全く同じであるが、

（d）操作杆 L が位置 III に来ると接片 P が接点 C_9、C_{10} と短絡して時限回路 A を作動状態に置き電池 B ー トランジスタ、エミッター E ーベース B ー抵抗 R_1 ーコンデンサー C ー接点 C_3、C_{10} ーアース（イ）の回路に電流が流れるからトランジスター T が作動状態に入りエミッター E ーコレクター C ーリレーコイル F ー接点 C_4、C_{10} ーアース（ロ）の工路によつてリレーコイル F が励磁し接片 P_1、P_2 をそれぞれ点線位置へ吸引するから

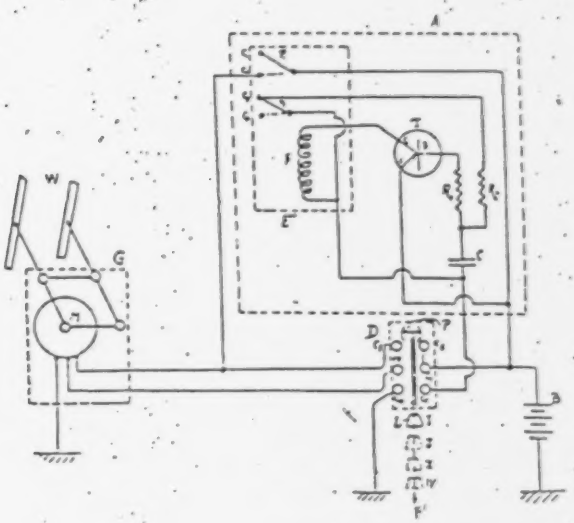
電池 B ー接点 C_3 ーモーター M ーアース（ハ）の回路によつてワイパー W が低速運動を開始すると同時にコンデンサー C が充電され（イ）回路電流が停止すると共にコンデンサー充電電圧のプラス側がトランジスターに対し逆バイアスとなるのでトランジスター T は不作動となる。従て（ロ）回路も不作動となるためリレーコイル F は復旧するから接片 P_1、P_2 はスプリング作用によりそれぞれ実線位置へ復帰すると共に（ハ）回路の電流も停止し、ワイパー W の運動が停止する。そ

してコンデンサーCの充電電圧に抵抗 R_1 一接片 P_1 ーアースと位置を占め トランジスター のベース逆バイアスが除かれトランジスターが再び作動し、(第2 (イ)、(ロ)、(ハ) 図)が同様に作動してワイパー作動が開始する。

以上の如くしてバイラーWは抵抗 R_1、R_2 コンデンサーCの組合せによる時定数により間欠的に回転するからワイパーの動作が目を遮わす流れを除去できると共に、本案によるとトランジスター ノ増幅回路を利用するもの故、微速回転且微回転容量が小であり更に起動力が極端である又抵抗 R_1 R_2 に可変抵抗を利用するとワイパー運動と停止との間隔時間を希望通り調整出来る効果がある。

実用新案登録請求の範囲

スイッチ面D内にワイパー低速回転用接点と高速回転用接点を設置する以外にトランジスターを使用した時間路Aの挿入を許す接点 C_1、C_2 を設け接点 C_1 をアースし、接点 C_2 をコンデンサー Cと抵抗 R_1 を介しトランジスターベース、電源 Bをエミッター並可動接片 P_1 に接続し、接点 C とコンデンサー C の中間をレーヨイルFの一端と可動接片 P_2 に接続しリレーコイルFの他端をトランジスターコレクターに接続し固定可動接片 P_3 はオフ又可動接片 P_4 は抵抗 R_2 を介し抵抗 R とコンデンサー C の中間にそれぞれ接続しリレーコイルFの動作に際し可動接片 P_3 にモーター回路に接続し可動接片 P_4 にオフ位置に回路オフするようにした自動車ワイパー装置。



A. 44

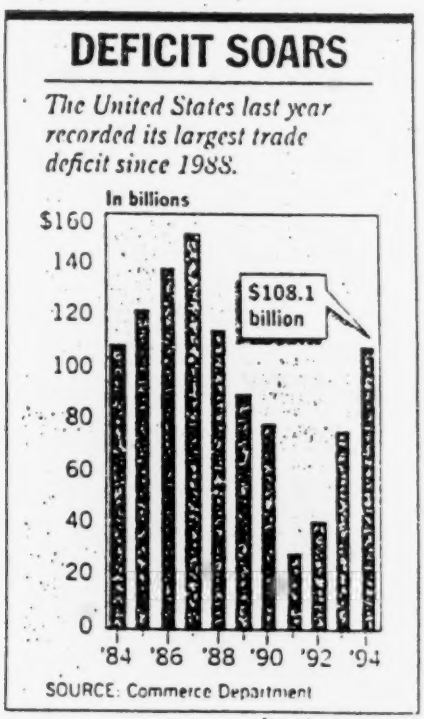
Plaintiffs 956 Exhibit	Intermittent Windshield Wipers **Profit as a Share of Revenues** All U.S. and Canadian Vehicles 1978 - 1988			
Year	U.S.		Canada	
	Variable Profit	Net Profit	Variable Profit	Net Profit
1978	0.80	0.76	0.90	0.89
1979	0.86	0.83	0.87	0.85
1980	0.86	0.82	0.87	0.83
1981	0.81	0.73	0.83	0.75
1982	0.84	0.76	0.86	0.79
1983	0.85	0.81	0.87	0.86
1984	0.86	0.82	0.85	0.80
1985	0.87	0.84	0.85	0.81
1986	0.85	0.81	0.84	0.80
1987	0.86	0.85	0.83	0.82
1988	$0.93	$0.92	$0.93	$0.92
Weighted Average	0.85	0.82	0.87	0.83
Weighted Average All U.S. and Canada			0.85	0.82

The Washington Post

SATURDAY, FEBRUARY 18, 1995

U.S. Trade Deficit Rose Sharply Last Year

$108.1 Billion Is Largest Imbalance Since '88



A. 46

Plaintiffs
955
Exhibit

Intermittent Windshield Wipers
Variable and Net Profit
All U.S. and Canadian Vehicles 1978 - 1988

Year	U.S.		Canada	
	Variable Profit	Net Profit	Variable Profit	Net Profit
1978	$20.35	$19.31	$46.47	$46.19
1979	$25.99	$25.15	$27.79	$27.24
1980	$28.01	$26.58	$29.64	$28.38
1981	$27.90	$25.05	$30.98	$28.00
1982	$32.17	$29.28	$37.20	$34.15
1983	$36.03	$34.31	$41.53	$41.19
1984	$37.38	$35.64	$34.18	$32.21
1985	$38.61	$37.12	$32.85	$31.12
1986	$37.93	$36.25	$32.75	$31.08
1987	$41.33	$41.08	$31.32	$30.98
1988	$45.12	$44.54	$41.37	$40.93
Weighted Average	$31.16	$29.59	$34.68	$33.33

Weighted Average All U.S. and Canada	$31.46	$29.91

DEFENDANT'S EXHIBIT 952

5-20-92 MODIFIED

Intermittent Windshield Wiper "Profit" Analysis

Year	Price per IWW	Number of Units[1] in Chrysler Exhibit D 592	Number of Units[1] Stipulated Kearns v. Chrysler	Maximum Total Revenues from IWW per Exhibit D 952	Maximum Total Revenues from IWW as Stipulated Kearns v. Chrysler
1977	$28.32	26,771	26,771	$758,154.72	$758,154.72
1978	$28.32	516,955	553,452	$14,640,165.60	$15,673,760.64
1979	$30.38	606,671	575,316	$18,430,664.98	$17,478,100.08
1980	$32.68	485,986	282,276	$15,882,022.48	$9,224,779.68
1981	$34.45	375,275	344,900	$12,928,223.75	$11,881,805.00
1982	$38.83	445,864	415,042	$17,312,899.12	$16,116,080.86
1983	$42.97	592,012	763,158	$25,438,755.64	$32,792,899.26
1984	$42.95	752,668	1,241,431	$32,327,090.60	$53,319,461.45
1985	$43.81	912,842	1,632,542	$39,991,608.02	$71,521,665.02
1986	$44.47	954,075	1,654,450	$42,427,715.25	$73,173,161.50
1987	$47.91	502,667	1,724,189	$24,082,775.97	$82,605,894.99
1988	$48.24	249,273	1,789,465	$12,024,929.52	$86,757,951.60
1989	$48.24	68,133	337,729	$3,286,735.92	$16,292,046.96
	Total	6,489,192	11,340,721	$259,531,741.57	$487,595,761.76

[1] Chrysler Automotive North America only; AMC 1,223,386 stipulated units omitted because Exhibit D 952 does not include AMC units.

PLAINTIFF'S EXHIBIT 1009

A. 48

MOTION FILED
FEB 27 1995

(3)

No. 94-1131

In The
Supreme Court of the United States
October Term, 1994

Chrysler Corporation,
Petitioner,
v.
Robert W. Kearns,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT

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No. 94-1131

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Robert W. Kearns,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Arnold, White & Durkee ("AW&D"), a Texas corporation, is a 120-attorney law firm with a national practice principally devoted to intellectual property litigation, including patents, trademarks, copyrights, and trade secrets. The respondent, Dr. Robert W. Kearns, is proceeding *pro se* in this action. AW&D retains a contractual contingent fee interest in Dr. Kearns' recovery in this case. For the following reasons, AW&D believes that its appearance to support the judgment below and to urge denial of the above petition will be of material benefit to the Court.

This case arises out of patent infringement litigation concerning Dr. Kearns' patents on intermittent windshield wiper control systems for automobiles. AW&D served as counsel to Dr. Kearns in a bellwether case against Ford Motor Company involving the same patents that are at issue in this case. AW&D also served as counsel to Dr. Kearns in the present case until one week before the trial was scheduled. Dr. Kearns retained another law firm, Reed, Smith, Shaw & McClay ("RSS&M"), to represent him during the infringement portion of the latter trial against Chrysler, but discharged that firm after Chrysler's infringement was established. Dr. Kearns then proceeded *pro se* during the damages phase of the Chrysler trial.

During the post-judgment motion period in this case, the District Court (E.D. Mich.) (Cohn, J.) requested that AW&D and RSS&M participate as amicus curiae in response to a 167-page motion by Chrysler to set aside the judgment or for a new trial. As amici, AW&D and RSS&M filed an extensive brief in the trial court that addressed the legal issues raised by Chrysler. In his 76-page post-trial opinion, Judge Cohn relied largely on the amicus brief, finding Dr. Kearns' two opposition briefs to be "unfocused and of little help." Pet. App. C-4. Judge Cohn's opinion concluded by stating that "[w]ithout the contribution of the amicus brief, the Court would still be struggling to come to a conclusion." *Id.* at C-78.

On Chrysler's appeal to the United States Court of Appeals for the Federal Circuit, AW&D was granted leave to participate as an amicus curiae and the Court of Appeals further granted AW&D leave to file a 50-page brief rather than the customary 20-page amicus brief. Thus, as previously and correctly recognized by both the trial court and the Federal Circuit, AW&D is a proper amicus curiae whose continued participation in this case should materially assist this Court in reaching a proper and just final resolution.

Counsel for petitioner Chrysler Corporation has consented to the filing of this brief; however, Dr. Kearns declined to give his consent. For the reasons set forth above, this motion for leave to file as amicus curiae should be granted.

Respectfully submitted,

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT

STATEMENT OF INTEREST OF AMICUS CURIAE

Arnold, White & Durkee ("AW&D"), a Texas corporation, is a 120-attorney law firm with a national practice principally devoted to intellectual property litigation, including patents, trademarks, copyrights, and trade secrets. The respondent, Dr. Robert W. Kearns, is the inventor of several patents concerning intermittent windshield wiper control systems for automobiles that are the subject of the present case. Dr. Kearns is currently proceeding *pro se* in this action, in which he charged Chrysler Corporation ("Chrysler") with infringing four of his patents.

AW&D served as counsel to Dr. Kearns in a bellwether case involving the same patents-in-suit, *Kearns v. Ford*

Motor Co., Civil Act. No. 78-70740 (E.D. Mich.) ("the *Ford* case"). That earlier case is significant here because, in order to stay proceedings in the present lawsuit, Chrysler agreed to be bound by a judgment against Ford as to the validity and enforceability of the same patents at issue here. AW&D was also Dr. Kearns' trial counsel in the present action until one week before the trial was scheduled. Following that trial, AW&D served at the specific request of the District Court as an amicus curiae throughout the post-trial motions phase of this case. AW&D later participated as an amicus curiae during Chrysler's appeal to the Court of Appeals for the Federal Circuit. AW&D has a direct stake in the outcome of this litigation because it retains a contractual contingent fee interest in Dr. Kearns' recovery in this case.

STATEMENT OF THE CASE

Because Chrysler's petition omits pertinent details surrounding the *Ford* case and regarding the stipulation by which Chrysler agreed to be bound by validity and enforceability determinations regarding Dr. Kearns' patents in that case, AW&D presents the following Statement of the Case. When the more complete facts are known, it becomes clear that Chrysler's petition should be denied.

I. Chrysler's Stipulation And The *Ford* Case

In his 1982 complaint, Dr. Kearns charged Chrysler with infringing four of his patents covering intermittent windshield wiper control systems for automobiles. In October 1982, this case was stayed by a district court order pursuant to the stipulation between Chrysler and Kearns in which Chrysler agreed to be bound by a "judgment as to the validity" of the same patents. Pet. App. A-2. In late 1989, before the *Ford* case went to trial, Chrysler and Kearns agreed to a second stipulation providing that "Chrysler shall be bound by the judgment (excluding a consent judgment) in the Kearns v. Ford case, C.A. No. 78-70740 as to the validity and enforce-

ability of the patents in that action that are also involved in this action." Pet. App. A-2 to -3. That stipulation was entered by the district court on February 15, 1990. *Id.* at A-3.

Chrysler agreed to the second stipulation on the condition that Dr. Kearns' suit against Chrysler be stayed until after the *Ford* case was completed. Pet. App. A-2. The liability phase of the Ford trial occurred in January 1990 and lasted over two weeks. Ford had access to and had identified all of the prior art references that Chrysler now complains were wrongfully excluded in this case. Even though Ford relied upon that prior art for its defenses, the jury returned a unanimous verdict that the contested claims of Dr. Kearns' patents were not invalid or unenforceable. Pet. App. A-3. Based on the jury's verdicts, District Judge Cohn entered a partial judgment that specified claims of Dr. Kearns' patents were valid, enforceable, and infringed by Ford. *Id.*

The first damages trial in the *Ford* case failed to achieve a unanimous verdict. After a second damages trial resulted in a verdict of $5,163,842 for the period of April 3, 1978 through 1988, Ford and Dr. Kearns later reached a settlement as to Ford's total liability from 1972 to 1988. Judge Cohn then entered a Final Judgment which stated that the prior partial judgment entered on the jury's verdicts of validity and enforceability was "made final." Pet. App. A-3. No appeals were taken.

II. The Trial Proceedings In This Case

Shortly before this trial was to commence (several months after the final judgment in the *Ford* case), Chrysler moved to add an invalidity defense, arguing that the settlement in the *Ford* case meant that the judgment on validity and enforceability was actually a consent judgment. Pet. App. A-4. Judge Cohn ruled that the *Ford* judgment on validity was actually litigated and that the liability issues had been "hotly," "vigorously," and "fully,"

contested during a lengthy jury trial. *See* Pet. App. A-8. The district court further stated that Chrysler's stipulation did not obligate Ford to have pursued all possible post-trial motions and have exhausted all rights of appeal. *Id.* at A-7 to -8.

After a four-week trial, the jury in this case found that Chrysler had infringed Dr. Kearns' patents and answered a multitude of special questions supporting its verdicts. In reviewing Chrysler's post-trial motion, the district court considered the claims, the jury instructions, the verdicts and the evidence in the record in reaching a 76-page decision that substantial evidence supported the jury verdicts. Pet. App. C.

The district court observed that "Chrysler's arguments regarding evidentiary rulings is [sic] difficult to discuss because they are long on law but short in describing the precise rulings to which exceptions were taken." Pet. App. C-55. The district court also noted that "Chrysler ignores the rule that entitlement to a new trial because of a wrong ruling on a matter of evidence requires a showing of prejudice." *Id.* In rejecting Chrysler's complaints, the court noted:

> Suffice to say, the Court did not exclude prior art as an aid to claim interpretation but rather excluded discussion of prior art in circumstances in which Chrysler was obviously trying to challenge the validity of the patents-in-suit.

Pet. App. C-56. Finally, the jury in this case was specifically instructed that the prior art evidence at trial could be used to determine the meaning of the terms in a claim. *Id.* at C-57.

With respect to the jury instructions in this case, the district court recounted the long and contentious process by which the jury instructions had been formulated among Chrysler, Dr. Kearns, and the court. Pet. App. C-35 to -43. Judge Cohn held that Chrysler had not complied

with the requirements of Fed. R. Civ. P. 51 that a party "stat[e] distinctly the matter objected to and the grounds of the objection." Moreover, he noted that Chrysler did not offer "any alternative text" for the instructions that had been objected to nor propose any instructions which interpreted the claims as having other than the plain meaning of the words of the claims. Pet. App. C-40, -42. After reviewing Chrysler's objections, the district court discerned no error or prejudice to Chrysler that justified a new trial.

III. Chrysler's Appeal To The Federal Circuit

Most importantly for present purposes, the Federal Circuit "reject[ed] Chrysler's attempts to avoid the consequences of its stipulation by redefining its terms." Pet. App. A-6 to -9, at A-8. Holding that neither Ford nor Dr. Kearns had "settled or agreed" on the issues of validity or enforceability, the Court of Appeals held that the *Ford* judgment was not a consent judgment as referred to in the stipulation. *Id.* at A-9 (citing Restatement (Second) of Judgments § 40 (1982)). Notably, Chrysler's present petition to this Court no longer disputes that the 1989 pretrial stipulation was properly construed to foreclose Chrysler from contesting the validity and enforceability of Dr. Kearns' patents in this case. *See* Pet. 7-8, 10.

The Court of Appeals also found no abuse of discretion in the exclusion of prior art evidence allegedly offered by Chrysler to interpret the claims. Pet. App. A-10. The Federal Circuit noted that "when claim language is clear and unambiguous on its face, resort to the prior art may be unnecessary." *Id.*

> The district court . . . concluded that the claims could be construed according to their plain meaning and that reference to prior art was not required. Moreover, and highly significant here, the district court believed that Chrysler's attempts to offer such evidence constituted a disguised, "back door" attack on

> the validity of the patents, which was expressly proscribed by the binding stipulation.

Id. at A-11 (footnote omitted). As explained in that footnote by the Court of Appeals, prior art is not needed to interpret limitations in "means-plus-function" format under 35 U.S.C. § 112, ¶ 6 (1988) because the presence of the same or equivalent structure in the prior art does not limit the scope of the claim. *See* Pet. App. A-11 n.7 (citing *Intel Corp. v. U.S. Int'l Trade Comm'n.*, 946 F.2d 821, 842 (Fed. Cir. 1991)).

When prior art is not required to interpret the claims, "[s]uch evidence is by definition 'irrelevant' and need not be admitted by a trial court." Pet. App. A-10 (citing Fed. R. Evid. 401, 402). The Court of Appeals concluded that the "district court's reasoning adequately supports its refusal to admit the proffered evidence." Pet. App. 11.

> Moreover, even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced.

Pet. App. A-11. On those multiple grounds, the Federal Circuit affirmed the denial of Chrysler's motion for a new trial. *Id.* The Court of Appeals also rejected Chrysler's appeal from the denial of its motion for judgment as a matter of law on the issue of infringement. Pet. App. A-11 to -14. The infringement issue is not part of Chrysler's current petition.

SUMMARY OF THE ARGUMENT

Because Chrysler's petition does not raise any factual or legal issues with importance beyond the resolution of the parties' controversy, the petition should be denied. The discretionary evidentiary rulings made by the district court in this case result directly from the specific facts at issue between Chrysler and Dr. Kearns; *i.e.*, the meaning and effect of Chrysler's stipulation to be bound by the prior outcome on validity and enforceability in the *Ford* case. However, Chrysler no longer challenges the preclusive effect of its pretrial stipulation.

A decision to admit or exclude evidence at trial is only reviewed for an abuse of discretion and can only be reversed for substantive prejudice to the affected party. Chrysler's petition fails on both prongs. As to the former, Chrysler only makes the legally erroneous assertion that no discretion to exclude prior art evidence existed in this case at all. Not only is that position wrong, but Chrysler simply ignores that the Court of Appeals held, "even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced." Pet. App. A-11. Chrysler failed to show prejudice arising from any particular ruling. Because Chrysler's petition raises only one of the two pertinent prongs, it does not provide adequate grounds on which to grant review.

Not only does a trial court retain discretion to exclude evidence of prior art offered for purposes of claim construction, but affirmance of that basic proposition does not warrant granting certiorari in this case. Chrysler's contrary position is based on a misreading of a single case, *Westinghouse Elec. & Mfg. Co. v. Formica Insul. Co.*, 266 U.S. 342 (1924). However, the permissive terms in the *Westinghouse* opinion demonstrate that this Court intended there to be discretion as to the admissibility of prior art evidence. The facts of this case fit the Court's

rationale in *Westinghouse* and further parallel the very situation that this Court foresaw in 1924 as justifying the exclusion of prior art evidence. Finally, *Westinghouse* can have no effect on the proper method of interpreting the "means-plus-function" limitations in Dr. Kearns' patents because such limitations were first allowed by statute 28 years after that case was decided.

Because Chrsyler's petition is based on a faulty legal premise, it can only be denied. Where a party such as Chrysler agrees to be bound by the validity and enforceability outcomes in a prior lawsuit in which prior art evidence was admitted for purposes of claim interpretation, no prejudice results from foreclosing that party from having an unwarranted "second bite at the apple." In short, the courts below properly prevented Chrysler's ill-disguised "back door" attack on the validity of Dr. Kearns' patents.

Chrysler's remaining assertions merit little additional response. Nothing has been improperly removed from the public domain because the claims at issue were held to be valid in the *Ford* case during which all prior art known to Chrysler at the time was available as evidence. Indeed, Chrysler still has not made a specific showing of how any particular prior art would have read upon Chrysler's accused systems or how any excluded prior art evidence would have altered the result in this case. To the extent that Chrysler wishes it had requested detailed jury instructions in this case based on the outcome in the *Ford* case, such objections were never made at trial and have thus been waived.

ARGUMENT

I. CHRYSLER'S PETITION CAN BE DENIED BECAUSE IT DOES NOT RAISE ANY ISSUE WITH SIGNIFICANCE BEYOND THE DISPUTE BETWEEN THE PARTIES IN THIS CASE

The district court's evidentiary rulings at issue arose directly from Chrysler's pretrial stipulation to be bound by any prior judgment on the validity and enforceability of the patents-in-suit reached in the prior *Ford* case. *See* Pet. App. A-9 to -12. Without doubt, the interpretation and significance of that stipulation have no legal consequences apart from the present facts. Although Chrysler weakly tries to characterize the Federal Circuit as having given an erroneous "signal" as to the admissibility of prior art evidence in future patent cases, Pet. 12, Chrysler's petition actually presents nothing more than post-trial assertions that a district judge abused his discretion when excluding some of the losing party's evidence in a particular case.

Routine evidentiary rulings rarely merit further review by this Court, particularly where both lower courts are in agreement as to the propriety of the challenged rulings. This case is no exception. Moreover, the discretionary rulings challenged by Chrysler's petition have no precedential implications beyond their belated contribution to resolving the longstanding dispute between Chrysler and Dr. Kearns. *Cf. Rudolph v. United States*, 370 U.S. 269 270 (1962) (dismissing a writ as improvidently granted when the issue presented involved review of a factual matter that "would be of no importance save to the litigants themselves"). For that reason alone, Chrysler's petition should be denied.

II. CHRYSLER'S PETITION DOES NOT ADDRESS THE FINDING OF NO PREJUDICE TO CHRYSLER, WHICH IS AN INDEPENDENT BASIS FOR AFFIRMING THE JUDGMENT

A trial court's evidentiary decisions are reviewed for an abuse of discretion and, if such an abuse is shown, are only reversed where the exclusion prejudiced that party's substantive rights. *See* Pet. App. A-10 (and cases cited). Just as occurred before the district court, *e.g.*, Pet. App. C-55, Chrysler's petition to this Court ignores that proof of prejudice to Chrysler must be provided in addition to a showing of an abuse of discretion (or a lack of discretion).* By only seeking certiorari on the scope of the district court's discretion to exclude prior art evidence, Chrysler's petition is therefore insufficient on its face to allow this Court to grant the requested writ on the limited grounds requested. *See, e.g., The Monrosa v. Carbon Black Export, Inc.*, 359 U.S. 180 (1959) (deciding the ground upon which a grant of certiorari was premised was unnecessary where the underlying judgment was clearly correct on another ground).

There is no basis for overturning the district court's repeated findings that Chrysler was not prejudiced by the district court's evidentiary rulings concerning the admissibility of prior art evidence. *See* Pet. App. C-57 to -62. The same judge presided over the *Ford* case and over this case. Pet. App. A-8 n.6. Judge Cohn was well aware of the events and results in the *Ford* case, and knew that patent claims are to be given the same construction when considering infringement as when considering validity. *See, e.g., Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989); *see also White v. Dunbar*, 119 U.S. 47, 51-52 (1886) (a patent claim should not be treated like a "nose of wax"). No

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* As shown in section C *infra*, Chrysler also failed to convince the district court or the Court of Appeals of any abuse of discretion in this case, and has offered no reason to allow this Court to reach a different conclusion.

one was in a better position than Judge Cohn to ensure that the jury's claim interpretation and infringement findings in this case did not conflict with the prior jury's claim interpretations and findings in the *Ford* case. As confirmed by the Court of Appeals, no such conflict has been shown.

Not only did the district court and the Federal Circuit properly conclude that Chrysler was bound by its prior stipulation, but the Federal Circuit specifically held that the district court's decision to exclude certain prior art evidence was at most harmless error that did not prejudice Chrysler.

> Moreover, even if the [district] court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced.

Pet. App. A-11. Chrysler's petition barely acknowledges that separate and independent basis for upholding the district court's evidentiary ruling. *See* Pet. 10 n.8.

Claim construction is a matter of law which is reviewed *de novo* on appeal. *See, e.g., Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993). Chrysler has not challenged the Federal Circuit's conclusion that prior art was not required to interpret the plain language of the claims or the Federal Circuit's independent analysis of the claim language. Regardless of the merits of Chrysler's manufactured criticism of the district court's decision to exclude certain prior art evidence at trial on the basis of Chrysler's stipulation, there remains no basis on which to reverse the judgment in this case. Thus, even if this Court were to undertake a review of a particular result in an individual case, no such review would be warranted here.

III. THE *WESTINGHOUSE* DECISION FULLY SUPPORTS THE RULINGS AND JUDGMENT IN THIS CASE

Chrysler bases its petition on the misplaced premise that the Court of Appeals "misread" this Court's decision in *Westinghouse Elec. & Mfg. Co. v. Formica Insul. Co.*, 266 U.S. 342 (1924). Pet. 7-12. In doing so, Chrysler mischaracterizes *Westinghouse* as holding that a district court has no "discretion" to exclude any prior art evidence offered in a patent case for purposes of construing the claims of the patent(s)-in-suit. Pet. 12. No such rule was announced in *Westinghouse*. No such rule exists under the Federal Rules of Evidence. Thus, because it is only Chrysler that is guilty of misreading *Westinghouse*, there is no basis for granting certiorari in this case.

Westinghouse involved "assignor estoppel," a doctrine that operates to prevent an assignor-inventor from assigning a patented invention to another for value and then attempting to prove during subsequent litigation that the assigned patent is actually invalid (*i.e.*, worthless). *See, e.g., Shamrock Technologies, Inc. v. Medical Sterilization, Inc.*, 903 F.2d 789, 793-94 (Fed. Cir. 1990); *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir.), *cert. dismissed*, 487 U.S. 1265 (1988). While the present case does not involve assignor estoppel at all, the reasoning in *Westinghouse* shows that the Federal Circuit's analysis and the district court's actions in this case were entirely proper.

In concluding that prior art evidence could be admitted for claim interpretation purposes by an assignor who was foreclosed from directly challenging the validity of the patent-in-suit, this Court offered the following analysis in *Westinghouse*:

> We think, however, that the better rule, in view of the peculiar character of patent property is that the state of the art *may* be considered. Otherwise the most satisfactory means of measuring the extent of the grant the government intended and which the assignor as-

> signed would be denied to the court in reaching a just conclusion. Of course, the state of the art cannot be used to destroy the patent and defeat the grant, because the assignor is estopped to do this. But the state of the art *may* be used to construe and narrow the claims of the patent, conceding their validity. The distinction may be a nice one but seems to be workable. *Such evidence might not be permissible in a case in which the assignor made specific representations as to the scope of the claims and their construction*, inconsistent with the state of the art, on the faith of which the assignee purchased; but that would be a special instance of estoppel by conduct.

266 U.S. at 350-51 (emphasis added). When fairly read, the above passage proves that the Federal Circuit's decision is not in conflict with *Westinghouse* and that *Westinghouse* does not eliminate a district court's discretion to exclude prior art evidence in patent cases.

First, nothing in *Westinghouse* supports Chrysler's contention that all prior art evidence must always be considered. Indeed, the Court's use of the permissive terms "may" and "might" and "permissible" demonstrates that the Court recognized and intended that a district court would retain its usual discretion regarding the admissibility of trial evidence. *See, e.g., Haig v. Agee*, 453 U.S. 280, 294 n.26 (the term "may" expressly recognizes substantial discretion); *cf. Donovan v. Burlington Northern, Inc.*, 781 F.2d 680, 682-83 (9th Cir. 1986) (construing this Court's use of permissive "may assess attorneys' fees" rather than mandatory phrase in *Alyeska Pipeline Service Co. v. Wilderness Society*, 421 U.S. 240, 258 (1975), as a strong suggestion that the Court meant to entrust the issue to the sound discretion of district courts).

As recognized by the Court of Appeals, a trial judge always has discretion to admit or exclude evidence at trial on multiple grounds, such as relevancy, authenticity, prejudice, or redundancy. Pet. App. A-10. Patent cases are the same as any other type of case, and *Westinghouse*

offers no overriding maxims to alter that discretion. Moreover, the claims at issue use limitations written in "means-plus-function" format under 35 U.S.C. § 112, ¶ 6 which do not need any consideration of prior art for proper interpretation. *See* Pet. App. A-11 n.7. Although Chrysler ignores that footnote, it should be noted that section 112-6 was not enacted by Congress until 1952 (nearly thirty years after *Westinghouse*). Thus, nothing in the *Westinghouse* opinion should or can be construed as requiring a district court to allow a jury faced with construing "means-plus-function" limitations to consider prior art evidence that is not necessary as a matter of law.

The Court in *Westinghouse* specifically observed that "[prior art] evidence might not be permissible in a case in which the assignor made specific representations as to the scope of the claims and their construction." 266 U.S. at 351. That is fatal to Chrysler's current position. This Court would not announce a new "absolute" rule for admissibility of all prior art evidence while simultaneously describing a specific situation in which a district court could elect to exclude such evidence. Contrary to Chrysler's strained reading, not only does a district court retain the discretion under *Westinghouse* to determine when such evidence may or may not be admitted, but the Federal Circuit correctly found that no abuse of discretion occurred in this case.

Perhaps more importantly, the express exception cited in *Westinghouse* directly parallels the facts of the present case. In *Westinghouse,* this Court stated that an assignor that makes specific representations as to the scope of the assigned claims and their construction may be foreclosed from introducing evidence contrary to those representations. 266 U.S. at 351. In this case, Chrysler represented to Dr. Kearns and to the district court that the scope of the patent claims at issue would be as determined in the proceedings in the *Ford* case. Under the reasoning of *Westinghouse,* Chrysler cannot reap the value of its stip-

ulation and then be allowed to eliminate any value of that same stipulation to Dr. Kearns.

Chrysler is no different than one who assigns a patent for value and then attempts to negate that value in later litigation. In exchange for Dr. Kearns' agreement to the stipulation, Chrysler received the value of a nine-year stay of proceedings. Moreover, if Ford had succeeded in its validity or enforceability defenses against the Kearns patents, Dr. Kearns likely would not have been able to assert those same claims against Chrysler. *See Blonder-Tongue Lab., Inc. v. University of Illinois Found.*, 402 U.S. 313 (1971). When Ford did not succeed, however, Chrysler was properly foreclosed from contesting the validity and enforceability of those same claims as a result of the representations as to claim scope in its stipulation. The Court of Appeals correctly upheld the trial court's rulings that stopped Chrysler from making a "back door" attack on the validity of the patents as expressly proscribed by Chrysler's binding stipulation. Pet. App. A-11.

IV. THE CLAIMS AT ISSUE WERE FULLY CONSTRUED IN LIGHT OF THE PRIOR ART AND DO NOT TAKE ANYTHING AWAY FROM THE PUBLIC

Chrysler argues that subject matter has been improperly removed from the public domain. Pet. 12-14. That is simply not true. Dr. Kearns' patent claims were affirmed as being valid in the *Ford* case. Valid claims cannot cover something in the public domain, so valid claims do not remove matter from the public domain. *See Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1573 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Because the claims at issue were adjudged valid in the *Ford* case, and because Chrysler agreed to be bound by that judgment, Chrysler's assertion that something has been improperly taken away from the public is nonsensical. Chrysler's argument is nothing more than a semantic effort to avoid the issue preclusion arising from its own stipulation.

Chrysler's petition similarly asserts that Chrysler was wrongfully "precluded from showing that its accused windshield wiper system was identical to the prior art in every detail relevant to Kearns' claim of infringement." Pet. 3. As previously observed by the district court, Chrysler's plea of error is long on rhetoric but short on substance. *See* Pet. App. C-55. Although reciting certain prior art references in its Statement Of The Case, Chrysler still has not made any showing as to how those alleged prior art systems would read on Chrysler's accused windshield wiper systems. Moreover, Chrysler misleads this Court by suggesting that it is enough merely to show that the individual features of the patented invention existed in the prior art. *See* Pet. App. C-7 (citing *Environmental Designs Ltd. v. Union Oil Co. of Calif.*, 713 F.2d 693, 698 (Fed. Cir. 1983), *cert. denied,* 464 U.S. 1043 (1984)).

Unlike the situation in *Westinghouse,* the claims of the patents at issue in this case were actually and fully construed in light of the prior art—in the *Ford* case. The 20 days of that trial provided ample opportunity for Ford to introduce abundant prior art references in support of its proffered claim construction and its asserted invalidity, unenforceability, and noninfringement defenses. Moreover, Chrysler's attorneys were in attendance during the entire *Ford* trial and consulted with Ford's counsel prior to and during trial. If there was any prior art that Chrysler has any reason to believe was relevant to the construction of the Kearns patent claims, such art surely was brought to the attention of Ford at that time. Thus, in contrast to the situation in *Westinghouse,* the patents in this case were fully and fairly interpreted in light of the prior art.

To the extent that Chrysler is complaining for the first time to this Court that the jury in this case did not receive sufficient guidance in Judge Cohn's instructions as to the construction given to the claims at issue by the jury in

the *Ford* case, the time for such complaints has long since past.

> No party may assign as error the giving or the failure to give an instruction unless the party objects thereto before the jury retires to consider its verdict, stating distinctly the matter objected to and the grounds of the objection.

Fed. R. Civ. P. 51; *see* Pet. App. C-44. Only Dr. Kearns attempted to provide an instruction for use in this case as to what the jury in the *Ford* case had found to be the proper interpretation of the claims at issue. *See* Pet. App. C-40. Because Chrysler did not object to the lack of a specific jury instruction regarding the claim interpretation reached in the *Ford* case, that basis for attacking the jury's verdict has been lost. *See Springfield v. Kibbe,* 480 U.S. 257, 258 (1987).

Finally, Chrysler makes the outlandish assertion that "[n]either the trial court nor the Federal Circuit expressed any doubt that Chrysler's accused system was identical to the prior art for all purposes relevant to the application of the claims." Pet. 7. That is baseless. Neither court made any statement that even insinuated that Chrysler's accused windshield wiper systems were or could be found in the prior art. Instead, both courts confirmed the jury's verdicts that Chrysler infringed the asserted claims of Dr. Kearns' patents, which had already been held valid and enforceable over the prior art in the *Ford* case. Chrysler's petition presents no arguable basis for altering that correct and overdue result in this case.

CONCLUSION

For the foregoing reasons, this Court should deny Chrysler's petition for writ of certiorari.

Respectfully submitted,

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FILED
MAR 6 1995

No. 95-1131 (4)

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1994

CHRYSLER CORPORATION, and
AMERICAN MOTORS CORPORATION,

Petitioner,

v.

ROBERT W. KEARNS,

Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENT'S STRONGEST OPPOSITION TO MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT

Robert W. Kearns, Ph.D.
Manufacturing-Inventor:
U.S.Patent 3,351,836
et cetera
"Windshield Wiper System
with Intermittent
Operation."
(410) 827-9337 (Tel/Fax)

Purpose

The purpose of this Opposition is to refute the sanctimonious urgings upon this U.S. Supreme Court by Arnold, White & Durkee Corporation, and, to have the Justices join Dr. Kearns in denying leave for Arnold, White & Durkee Corporation to file brief amicus.

Background

Arnold, White & Durkee Corporation ("AWDC") personnel were knowledgeable that Dr. Kearns found no difference between regulatory review and judicial review. Dr. Kearns knew and William Durkee knew Dr. Kearns knew that Professor Chisum has stated in his book, REMEDIES FOR PATENT INFRINGEMENT, page 393:

> A patent owner's right to monetary and injunctive relief is restricted by the equitable doctrines of laches and estoppel, the statutory six-year damage limitation, and the marking requirements.

Dr. Kearns had met those conditions. Continuing Chisum page 397:

> The possibility of post-expiration equitable relief was raised but not resolved in *Roche Prods., Inc.* v *Bolar Pharmaceutical Co.*, 733 F.2d 858, 221 U.S.P.Q. 937 (Fed. Cir. 1984).

Dr. Kearns' patent litigation troubles began in October, 1963 [32 years ago] and his formal patent trial litigation troubles in March, 1978 [17 years ago]. To continue as a Manufacturing-Inventor, Dr. Kearns needed 35 U.S.Code § 283 equitable injunctive relief against those who infringed his patents. Not against every citizen in the USA - simply against those who infringed his patents.

The culmination of all the inventing, complaint, pleadings, motions, discovery, and depositions occurs in the pre-trial order. Dr. Kearns discharged AWDC for causes the morning that AWDC intended to sign a pre-trial order that did not include § 283 relief.

The role of § 283 relief
to this U.S. Supreme Court

The legal position of this Court has long been

> "[I]t is not the private use but ... the public interest which is dominant in the patent system[1]." *Mercoid Corp.* v. *Mid-Continent Co.*, 320 U.S. 661, 665. In later years, this Court improved its view of the contributions of inventors: *Dawson Chem. Co.* v. *Rohm and Haas Co.*, 448 U.S. 176, 221 (1980), reflects a shift towards recognition that the patent holder's rights and the public interest should be accorded equal weight in deciding patent cases.

But where in the law is the public interest remedy for infringement?

> Title 35 U.S. Code § 281.
> **Remedy for infringement of patent**
>
> "A patentee shall have remedy by civil action for infringement of his patent."

§ 281 proffers a remedy only to the inventor - thus the public interest must be made available through the inventor. What is available to the inventor (and public) from the inventor's trial? The patentee can only receive **§283 Injunction** relief and **§284 Damages** relief. **§284 Damage** relief is money to the inventor. Neglecting taxes, that money to the inventor does not return to the USA public its interest in the USA invented-product.

Where the invented-product is infringed and sold in high volume

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[1] *Pennock* v. *Dialogue*, 2 Pet. 1; *Kendall* v. *Winsor*, 21 How. 322, 329; *Adams* v. *Burke*, 17 Wall. 453; *Motion-Picture Co.* v. *Universal Film Co.* 243 U.S. pp. 510-511; *Morton Salt Co.* v. *G.S. Suppiger Co.*, 314 U.S. 488, 493; *United States* v. *Masonite Corp.*, 316 U.S. 265, 278 ... The patent is a privilege. But it is a privilege which is conditioned by a public purpose ..."

in a market segment controlled by the infringer[2] within the worldwide market, the only place left for the public to gain its rightful interest from the invented-product under 35 U.S.C. is through a §283 Injunction remedy to the inventor.

For AWDC to proffer a Pre-Trial Order that does not include § 283 equitable relief is for AWDC to abandon the public and seek only money for AWDC. Dr. Kearns is not inspired to invent in order to provide money to AWDC. Const. Art I § 8 Cl 8 fails to 'promote' under those conditions. AWDC actions are unConstitutional! Inventors do not invent for money. Dr. Kearns invented to reduce the traffic deaths occurring in wet weather. 55,000 die on our roads each year with more than half of the accidents occurring in wet weather yet the weather is not wet half the time!!

In this new age of General Agreement on Tariffs & Trade ("GATT"), when this Court does not grant such § 283 equitable remedies the economy of the USA will join that of Mexico. An injunction would enable the Dr. Kearns to supply the present markets in the USA with the aid of his foreign patents.

Although the USA infringers could try to sell the invented product to others operating in their own segment of the worldwide market, they do not have the interest, bases for a legal right nor the patent base on which to support the effort. But if Dr. Kearns manufactured and made those sales, as is his Constitutional right, the public would gain the extra jobs income; the benefits of more

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[2] What citizen from the public can meet the needs of Chrysler for 2,250,000 Intermittent Windshield Wiper Systems ("IWWS")? None but Kearns *Engineers*.

balanced/surplus foreign trade; higher purchasing power for each dollar; and, a higher standard-of-living. With each USA and foreign infringer having control of its segment of the worldwide IWWS market, upon expiration of Dr. Kearns' patents, the inequality in favor of 'foreign' countries is locked-in to the permanent trade deficit result. There is no other person than Dr. Kearns with the patent baseg to achieve the USA market. That market, being 50% of the worldwide market, offers economies of scale to supplement Dr. Kearns' foreign patents. Dr. Kearns is the only person who can provide a 4.8% boost in USA trade to the public (A-1). For this Court to be consistent with its pronouncements *supra* it must start allowing § 283 injunctive relief.

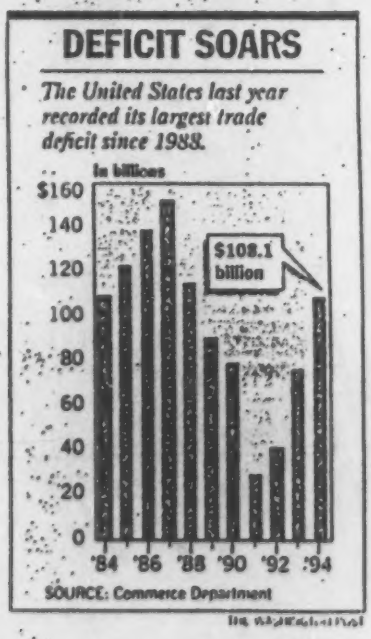
What is the path to § 283 relief? There are more than 100,000 U.S. patents issued each year that represent opportunities for new businesses and jobs. Of those, on average, but 1,019 file a Complaint (that don't include § 283). Of those filing a Complaint but 89 start trial. District Judge Cohn has 19 out of 20 settle (he says he couldn't handle the load otherwise). That leaves 4+ out of 100,000 'exclusive' business opportunities who finish trial to be eligible for § 283 relief. Bob Kearns has completed that path twice for Dr. Kearns and the public - **and has been denied equitable relief both times** in the District Court, seemingly, without the CAFC or U.S. Supreme Court caring about the public! The principles of equity to the public shout for an equitable injunction against Ford, Chrysler, General Motors and American Motors and a denial of AWDC brief amicus. This Supreme Court is responsible to promulgate the Rules and law to aid the public.

The Washington Post

SATURDAY, FEBRUARY 18, 1995

U.S. Trade Deficit Rose Sharply Last Year

$108.1 Billion Is Largest Imbalance Since '88



A-1

CERTIFICATE OF SERVICE

THIS IS TO CERTIFY that a copy of RESPONDENT'S STRONGEST OPPOSITION TO MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF ARNOLD, WHITE & DURKEE IN SUPPORT OF RESPONDENT has been sent by first class mail to

Chrysler Corp. via
Robert P. Taylor
Pillsbury Madison & Sutro
225 Bush Street
San Francisco, CA 94104
(415) 983-1000

AWDC via
William D. Durkee
Arnold, White & Durkee
750 Bering Drive
Suite 400
Houston, Texas 77057

I do solemnly declare and affirm under the penalties of perjury that these are the only service that need be made.

Robert W. Kearns

Robert W. Kearns

Subscribed this 1st day of March 1995.